THE LAW AND PRACTICE UNDER

THE PATENTS, DESIGNS AND TRADE MARKS ACTS, 1883—1888.

THIRD EDITION, ENLARGED.

THE LAW AND PRACTICE

UNDER THE

Patents, Designs & Trade Marks

ACTS, 1883 TO 1888,

WITH

THE PRACTICE IN ACTIONS FOR INFRINGEMENT OF PATENT,

AND AN APPENDIX OF ORDERS MADE IN

PATENT ACTIONS, AND FORMS.

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Third Edition

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PREFACE TO THE THIRD EDITION.

THIS Edition has been revised on the lines mentioned in the Preface to the Second Edition, and the author has endeavoured to include all the important cases affecting the Law of Patents, Designs and Trade Marks, which have been decided since the publication of that Edition in 1889.

The notes on the Complete and Provisional Specifications, and on Claims, have been re-arranged and enlarged, and it is hoped that they now contain a fairly full statement of the law on those subjects as laid down, or restated, in recent decisions.

An alteration has been made in the manner of printing the Rules. Many of the Patents Rules are repeated in the Designs and Trade Marks Rules. Where this is the case they have not been reprinted in the latter Rules, but a reference is made in the proper place to the corresponding enactment in the Patents Rules.

Further, inasmuch as most of the Forms relate merely to office proceedings, and all can be purchased

for a few pence, it has been thought sufficient to print only those Forms which appear to involve some question of principle, the names of the others being in the Schedule at the end of each set of Rules. These changes have set free a considerable number of pages which have been utilised for the new matter of this Edition.

New Rules, governing the practice of the Judicial Committee of the Privy Council in Prolongation cases, have recently been made, and will be found in their proper place.

Additions have been made to the orders and forms in the Appendix; and by the kind permission of the officials of the Board of Trade the Author has been able to include a form of order under section 22 for compulsory licence, with the form of licence ordered, and a scheme of procedure under the section which has been adopted in some recent cases.

The Author has also to acknowledge, with many thanks, the courtesy of the Attorney-General, Sir Richard Webster, in furnishing the note, at pages 611 and 612, on the practice of obtaining the fiat on petitions for revocation of patents. In like manner he has to thank Mr. Griffin, the Registrar of Trade Marks, for the important notes on the

practice of the Trade Marks Branch of the Patent Office as to the proof of user which may be required when it is desired to register old marks (page 386), and as to applications to register marks objected to by the Comptroller as similar to or identical with marks already registered (page 426).

Lastly, the Author desires to express his great obligations to his friend and former pupil, MR. CHARLES SHARP, of the Chancery Bar, and his friend, MR. M. D. WARMINGTON. They have rendered him valuable assistance in the preparation of this edition; and they have almost entirely relieved him from the labour of reading and correcting the proof sheets. MR. SHARP also read through very carefully, and revised, nearly the whole of the copy immediately before it was sent to press.

LINCOLN'S INN,
August, 1898.

PREFACE TO THE SECOND EDITION.

THE passing of the Patents, Designs, and Trade Marks Act, 1888, appears to afford a convenient opportunity for a New Edition of this Work. This Act has modified the Act of 1883 in many particulars, and has made some important changes in the law.

In the case of patents, the comparison in the Patent Office of rival specifications, and the Examiner's report thereon, with the provisions allowing opposition on the basis of that report, are abolished, and a new ground of opposition is introduced, viz., that the complete specification describes an invention other than that in the provisional, and that such other invention is the subject of an application made by the opponent in the interval between the leaving of the two specifications.

An important change is made in the practice as to the registration of Trade Marks. Hitherto opposed cases have been determined by the Court. Under the new Act the practice in opposed is assimilated to that in unopposed applications, and both will be decided by the Comptroller in the first instance, with an appeal to the Board of Trade, who may refer the appeal to the Court. The new Act (sect. 25) makes provisions for hearing by or for the Board of Trade, but does not appear to confer on the Board, or, except in one very limited case (sect. 13), on the Comptroller, any jurisdiction as to costs.

The practice in actions for infringement of Patents, whereby the plaintiff may, in a second action, obtain, in

certain cases, full costs, charges, and expenses, is now extended to actions for infringement of Trade Marks.

The provisions of the Act of 1883 as to the registration of "fancy words" are now repealed, and instead there is given a right to register "an invented word or words," or "a word or words having no reference to the character or quality of the goods"; and the questions which have been raised as to "geographical names" are settled by a direction that such names shall not be registered.

Under the Act of 1883 permission was given to register certain additions to the essential particulars of the Trade Mark, subject to the condition, where the additions were common to the trade, that the applicant should disclaim any right to their exclusive use. This disclaimer is now required in the case of all added matter, whether common to the trade or not.

Since the publication of the First Edition, a large number of cases have been decided on the Act of 1883, which have settled many important questions as to its construction and effect; and an endeavour has been made in the present Edition to arrange these cases under their proper heads in the notes to the various sections of the Act.

The plan of this Edition is, as a whole, the same as that of the First Edition, but in one respect it has been modified. It was represented to the author that his work would have been more generally useful if it had dealt with the matters of General Patent Law, which were omitted from the First Edition. It is, however, impossible to deal fully with these subjects within the limits necessary to such a work as the present; but the author has attempted to treat shortly some of the salient points of the questions of true and first inventor, novelty, utility, subject-matter, and infringement, and he has also added under its proper heading a note on the subject of claims in specifications. For a complete discussion of these subjects, the reader is still referred to works on the General Law of Patents.

The publication, first by Mr. Griffin, and then by the Board of Trade, of reports of cases before the Law Officers and the Comptroller, has afforded an opportunity of endeavouring to present a much fuller view than has hitherto been possible of the practice in cases of applications for, and oppositions to, the grant of patents and the amendment of specifications.

This Edition also contains the International Convention and the Rules thereunder, and in the Appendix there have been added to the forms of proceedings on applications for extension some forms of accounts which have been actually before the Judicial Committee in cases where extension has been granted, and which, therefore, may be useful as guides in other cases.

* * * * *

LINCOLN'S INN,
June, 1889.

EXTRACT FROM

PREFACE TO THE FIRST EDITION.

THIS work is not a treatise on the Law of Patents generally, nor on the Law of Trade Marks generally. It deals only with so much of the former as may be said to depend on the legislation of the present and preceding reign, and with so much of the latter as arises out of the Registration Acts.

With regard to the Law of Designs the case is somewhat different. This rests entirely on the Statutes of the early years of the present reign; and the new Act, with the decided cases (few in number) on the repealed and re-enacted provisions of the old Acts, comprises all the law on the subject. There seemed, therefore, to the writer no sufficient reason, in the case of Designs, for confining his work merely to the practice of registration, and the following pages contain also a statement of the General Law.

The present Act is virtually, so far as regards Patents, a consolidation, with considerable amendments, of the provisions of all the Acts on the subject since 1835. It includes, therefore, oppositions to the grant, disclaimers, amendments, and extensions, with the provisions as to provisional specifications and registration introduced by the Act of 1852, and the various enactments as to particulars of breaches and objections and costs which are contained in the latter Act.

These subjects are all dealt with in the present volume, and the author has endeavoured to collect the decided cases on the various matters above mentioned and arrange them under the corresponding heads in the Act.

* * * * *

In addition to the special matters above mentioned as comprised in this volume, the following pages contain also a detailed statement of the practice in actions for infringement of patent. The general questions on this subject, such as the commencement of the action, the parties, consolidation of actions, and the nature of the relief to be obtained, are treated of under the heading in the Act "Legal Proceedings"; while, following the order indicated in the Act, the practice as to the mode of trial is dealt with under sect. 28; the questions of statement of claim, particulars of breaches, defence, particulars of objections, evidence, and costs, under sects. 29 and 31; and the practice as to injunctions, inspection, discovery, account, and damages, under sect. 30.

The subject of Trade Marks has been dealt with in the same manner as the Law of Patents. The General Law of Trade Marks has been left untouched, except so far as seemed to be necessary in order to elucidate the practice under the new Act, and the writer has confined himself, apart from the cases on the repealed Acts, to such cases as relate to the definition of trade marks, leaving the question of infringement, and other like questions, to books on the General Law.

The present Act is, as far as it relates to trade marks, a consolidation of the Acts of 1875 and 1876, adopting (with alterations) as part of the Act many provisions of the old Trade Marks Rules; and the cases on those Acts and Rules will, it is conceived, form useful guides to the interpretation of the new Act.

* * * * *

The notes are placed at the end of each section of the Act. . . . The Rules are printed at the end of the Act,

and there is added an Appendix containing certain orders made in patent cases as to consolidation, inspection, and other matters, which have not, it is believed, been published. In the Appendix will be also found extracts from the "Instructions" relative to the registration of trade marks issued by the Patent Office.

* * * * *

LINCOLN'S INN,
January, 1884.

ABBREVIATIONS USED IN THIS WORK.

The Act of	1835	5 & 6 Will. IV. c. 83 (Patents).
"	1842	5 & 6 Vict. c. 100 (Designs).
"	1843	6 & 7 Vict. c. 65 "
"	1850	13 & 14 Vict. c. 104 "
"	1852	15 & 16 Vict. c. 83 (Patents).
"	1853	16 & 17 Vict. c. 115 "
"	1858	21 & 22 Vict. c. 70 (Designs).
"	1861	24 & 25 Vict c. 73 "
"	1875	38 & 39 Vict. c. 91 (Trade Marks Registration).
"	1883	46 & 47 Vict. c. 57 (Patents, Designs, and Trade Marks).
"	1885	48 & 49 Vict. c. 63 " "
"	1886	49 & 50 Vict. c. 37 (Patents and Designs).
"	1888	51 & 52 Vict. c. 50 (Patents, Designs, and Trade Marks).
P. R.		Patents Rules, 1890.
D. R.		Designs Rules, 1890.
T. M. R.		Trade Marks Rules, 1890.
L. O. R.		Law Officers' Rules.
J. C. R.		Judicial Committee Rules.
C. & E.		Cababé and Ellis' Reports.
Eng. Rep.		Notes of Cases reported in the "Engineer," reprinted from the "Engineer," 1881.
R. P. C.		Reports of Patent, Design, and Trade Mark cases, published under the authority of the Board of Trade.
Times R.		The Times Law Reports.
Goodeve		Goodeve's Abstract of Patent Cases, 1884.
Griffin, P. C.		Griffin's Abstract of Patent Cases, 1887.
Griffin, L. O. C.		Griffin's Cases before the Comptroller and Law Officers, 1888.
Higgins		Higgins' Digest of the Law and Practice of Letters Patent for Inventions, 2nd edition.
Macr.		Macrory's Reports of Patent Cases.
Webst. or W. P. C.		Webster's Reports of Patent Cases.
S. C. R.		Supreme Court Rules.
Seton		Seton on Decrees, 5th edition.
Pemberton		Pemberton on Judgments, 4th edition.
Johnson, Pat. Man.		Johnson's Patentees' Manual, 6th edition.
Seb. Dig.		Sebastian's Digest of Cases of Trade Mark, etc.
S. J.		Solicitors' Journal.

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[*46 & 47 Vict. c. 57.*]

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[51 & 52 Vict. c. 50.]

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ADDENDA.

Page 9, note (*e*) *for* c. 86 *read* c. 83.

Page 17, *add* to note (*f*) *Webb* v. *Kynoch*, 15 R. P. C. 269.

Page 25, notes (*e*), (*g*), (*h*), *Maxim Nordenfelt Co.* v. *Anderson*, affirmed by H. L., 15 R. P. C. 421.

Page 26, *add* to note (*q*) *Pneumatic Tyre Co.* v. *Tubeless Pneumatic Tyre, etc. Co.*, 15 R. P. C. 237, 241.

Page 53, *add* to note (*f*). *Tattersall's Patent*, 9 R. P. C. 150.

Page 57, *add* at end of note to sub-s. (2): After an opposition has succeeded before the law officer, the case will not be re-opened on the ground that the opponent withdraws his opposition and desires the patent to be sealed: *Thomas and Prevosts' Application*, 15 R. P. C. 257. There is, however, power to re-open the case under special circumstances such as fraud, serious mistake, or miscarriage, *ibid.*

Page 79, *add* to note (*i*), As to what would be "special circumstances," see *Allison's Patent*, 15 R. P. C. 408, 411.

Page 85, line 9, *for* s. 8, *read* sub-s. (8).

Page 99, line 13, *for* s. 3, *read* s. 2.

Page 108, *add* to note (*k*). *McLean's Patent*, 15 R. P. C. 418.

Page 109, *add* to note (*l*), *Hughes' Patent*, 15 R. P. C. 370.

Page 169, line 8 from bottom, *for* 4 & 5 Will. 4, *read* 5 & 6 Will. 4.

Page 191, *add* to note (*e*), See observations of ROMER, J. in *Miller's Patent*, 15 R. P. C. 205, 213.

Page 200, note (*b*), see also same illustration, *Bailey* v. *Roberton*, 3 App. Cas. 1079.

Page 206, *add* after line 28, Where the combination performs no function not performed by the parts separately, and no new function is performed, there is no subject-matter: *Allen* v. *Oates*, 15 R. P. C. 298.

Page 212. *add* after (*r*), line 14, But evidence offered merely to contradict statements of a witness as to prior users not mentioned in the objections is inadmissible: *Haggenmacher's Patents*, [1898] 2 Ch. 280.

Page 217, *add* after (*q*), line 4, And where the specification claimed the introduction of metallic zinc in a powdered state into steam boilers for a specific purpose, it was held that the sale of powdered zinc with instructions to use it in such a way as to infringe the patent was an infringement: *Innes* v. *Short*, 15 R. P. C. 449. And see *Incandescent Gas Light Co.* v. *New Incandescent, etc. Co.*, 15 R. P. C. 81.

Page 218, *add* to note (*g*), *Murehland* v. *Nicholson*, 10 R. P. C. 417.

Page 237, note (*q*)
Page 239, note (*f*) } add *Hudson* v. *Chatteris Engineering Co.*, 15 R. P. C. 438.

Page 239, *add* to note (*k*), *Hipkins* v. *Plant*, 15 R. P. C. 294.

Page 292, *add* to note (*t*), *Saccharin Corporation* v. *Haines, Ward & Co.*, 15 R. P. C. 344.

Page 307, line 9 from bottom, *for* 2 *read* 42.

Page 309, *add* to note (*o*), *Pneumatic Tyre Co.* v. *Puncture Proof, etc. Co.*, 15 R. P. C. 405.

Page 351, note (*q*)
Page 353, note (*h*)
Page 355, note (*d*)
Page 361, note (*m*)
Page 373, note (*k*) } *Rollason's Design*, affirmed by H. L. on appeal, 15 R. P. C. 441; 14 Times R. 478.

Page 355, *add* after line 8, Mere collaboration between the intended proprietors and the author of the design with a view to its being put in a suitable shape is not publication: *Nevill* v. *Bennett*, 15 R. P. C. 412, 414.

Page 375, *add* to note (*q*), *Nevill* v. *Bennett*, 15 R. P. C. 412.

Page 382, *add* to note (*x*), See also under the present Act, *Eastman Photographic Materials Company's Trade Mark*, 15 R. P. C. 476, 487; and where the decision of the court of first instance and of the Court of Appeal was reversed by the House of Lords the costs paid to the comptroller under the decision of the Court of Appeal, but not those paid to him under the decision of the court of first instance, were returned: *Ibid.* p. 488.

Page 408, *add* to note (*y*) *Gordon and Dilworth's Trade Mark*, 13 R. P. C. 634.

Page 428, *add* to note (*c*) And see *Re Hill's Trade Mark*, 10 R. P. C. 113.
Sphincter Grip, etc. Hose Company's Trade Mark, 10 R. P. C. 84.

Page 428, *add* to note (*e*) See also *Eastman Photographic Materials Co. v. Griffith's Cycle Corporation*, 15 R. P. C. 105.

Page 439, note (*u*) } *Batt & Co.'s Trade Marks*, affirmed by C. A., 14 Times R. 538;
Page 480, note (*o*) } [1898] W. N. 77 (8).

Page 444, line 12, *add* And the injunction may be granted to restrain the use of name of a place without distinguishing defendant's goods from plaintiff's goods bearing same name: *Beulay v. Hughes*, 15 R. P. C. 290.

Page 461, *add* to note (*k*) *Day v. Millbay Engineering Co.*, 15 R. P. C. 233.

Pages 465, 466, parol licence revocable by grantor: *Coppin v. Lloyd*, 15 R. P. C. 377.

Page 469, *add* at line 7 from bottom of page, But where persons having express notice of an agreement by owners of Letters Patent to assign them for value took a licence and registered the licence before the agreement was registered, it was held that they took the licence subject to the agreement: *New Lrion Tyre and Cycle Co. v. Spilsbury*, [1898] 2 Ch. 137; 15 R. P. C. 380; 46 W. R. 567; 78 L. T. (N.S.) 513; affirmed [1898] W. N. 77 (6).

Page 474, note (*g*) *Re Wright, Crossley & Co.*, affirmed on appeal, 15 R. P. C. 377.

Page 501, line 15 from bottom, *for* divided, *read* decided.

Page 503, line 2 from bottom, *for* 53 & 31, *read* 53 & 54.

Page 605, *add* after paragraph numbered 31, The office also refuses to register pictorial representations of goods to which the trade mark is to be applied (see, however, as to this, *James's Trade Mark*, 33 Ch. D. 392); or the names of persons in the possessive case in combination with the names of goods (*Pirie v. Goodall*, [1892] 1 Ch. 35, 43; *Gianaclis' Trade Mark*, 6 R. P. C. 467): see Trade Marks Journal, No. 570, p. 220.

THE

Patents, Designs, and Trade Marks Acts,

1883—1888.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

(46 & 47 Vict. c. 57.)

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th August 1883.]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

PART I.

Preliminary.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883. Short title.

2. This Act is divided into parts, as follows :— Division of Act into parts.

Part I.—Preliminary.
Part II.—Patents.
Part III.—Designs.
Part IV.—Trade Marks.
Part V.—General.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three. Commencement of Act.

Sect. 4.

PART II.

PATENTS.

Application for and Grant of Patent.

Persons entitled to apply for patent.

4.—(1.) Any person, whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

SUB-SECTION (1).

"**Any person.**"—"*Person*" *includes a body corporate.* Section 117, *post*, and see also 52 & 53 Vict. c. 63, s. 19.

"**Whether a British subject or not.**"—A patent might always be granted to an *alien amy* (*a*), even though resident abroad (*b*).

SUB-SECTION (2).

Joint grantees.

Sub-s. (2), so far as it relates to joint *inventors*, is only a statement of the existing law. It has been the common practice in such a case to grant patents to two or more persons jointly (*c*), and the fact that one of the joint grantees is an infant will not affect the validity of the patent (*d*).

In *Mathers* v. *Green* (*e*), it was held by Lord CRANWORTH, C., on the words of the grant in the patent, reversing the decision of Lord ROMILLY, M.R., that each one of three joint grantees might use the invention without the consent of the others, and without liability to account to them for the profits made by such use. In the same case Lord ROMILLY had held (*f*) that one of such grantees was bound to account to the others for royalties received under licences, but this point was left undecided on the appeal.

The decision in *Mathers* v. *Green* has been recently upheld in the House of Lords, and rests upon the true nature of the right conferred by letters patent, which was thus stated by Lord HERSCHELL: "Letters patent do not give the patentee any right to use the invention, they do not confer on him a right to manufacture according to his invention. That is a right which he would have equally effectually if there were no letters patent at all; only in that case all the world would equally have the right. What the letters patent confer is the right to exclude others from manufacturing in a particular way and using a particular invention" (*g*).

(*a*) *Beard* v. *Egerton*, 3 C. B. 130; citing *Chappell* v. *Purday*, 14 M. & W. 318.

(*b*) *Re Wirth's Patent*, 12 Ch. D. 303.

(*c*) See *Mathers* v. *Green*, L. R. 1 Ch. 29.

(*d*) *Per* BACON, V.-C., *Cheavin* v. *Walker*, 5 Ch. D. 858.

(*e*) L. R. 1 Ch. 29.

(*f*) 34 Beav. 170.

(*g*) *Steers* v. *Rogers*, [1893] A. C. 232, 235.

Sect 4.

NOTE.

There is no decision as to the power of one grantee to grant a valid licence without the consent of his co-grantees. It appears, however, to be doubtful whether, except for the authority conferred by the granting and prohibitory clauses of the patent, any licence could be granted at all (*h*), and it will probably be found, therefore, that the question will in all cases turn on the words of the patent itself.

The grant in the patent in *Mathers* v. *Green* was to the grantees, their executors, administrators, and assigns, that they and every of them, by themselves, their servants and agents, *and such others as they may agree with*, and no others, may use the invention.

The form of letters patent now in use in the case of joint grantees is a grant to the patentees (which word by the terms of the patent includes executors, administrators, and assigns) that the "patentees by themselves, their *agents or licencees*, and no other," may use the invention. And the prohibitory clause forbids the use of the invention "without the covenant, licence, or agreement of the said patentees in writing under their hands and seals." It would seem, therefore, that no valid licence can be granted in the case of a joint patent without the concurrence of all the patentees (*i*). See further as to co-owners of a patent, section 87, *post*.

Where two persons are joint applicants for a patent, and lodge a provisional specification in their joint names, the comptroller has no jurisdiction to determine which of the applicants is entitled to file the complete specification (*j*).

Application and specification.

5.—(1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed (*k*); and must be left at, or sent by post to, the Patent Office in the prescribed manner (*l*).

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to

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(*h*) "Hindmarch on Patents," p. 238. See Schedule 1, Form D., *post*.

(*i*) See also judgment of M.R. in *Powell* v. *Head*, 12 Ch. D. 690, a copyright case.

(*j*) *Apostoloff and Freudenberg's Application*, 13 R. P. C. 275.

(*k*) P. R. rr. 5, 6, 8, 9, 10, *post*.

(*l*) P. R. r. 16A.

Sect. 5 (2) obtain a patent; and must be accompanied by either a provisional or complete specification.

(3.) A provisional (*m*) specification must describe the nature of the invention, and be accompanied by drawings, if required (*n*).

(4.) A complete (*o*) specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

(5.) A specification, whether provisional or complete (*p*), must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed (*q*).

SUB-SECTION (1).

Applications must be signed by the applicant: all other documents may be signed by an agent (r. 8), but in that case the applicant must sign an authority to the agent. (P. R., Forms A., A1, note.)

Foreign applications under s. 103 (*post*) are governed by P. R., rr. 24—29.

As to correction of clerical errors in or in connection with an application for a patent, see s. 91 (*a*), and P. R., r. 16.

SUB-SECTION (2).

"**Declaration.**"—By the Stamp Act, 1891 (*r*), a statutory declaration forming part of an application for a patent in conformity with the present Act, is exempted from the stamp duty of 2*s.* 6*d.* charged on statutory declarations; and by s. 2 of the Act of 1885 (*s*), the declaration mentioned in this sub-section may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

The forms of application for patents, A., A1, and A2, now in use, are prescribed by the Patents Rules (*post*), and are declarations not under the Statutory Declarations Act, 1835.

Form A. is not applicable to the case of a British or foreign corporation applying alone as true and first inventor. Form A1 is intended to be

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(*m*) *Post*, p. 8.
(*n*) P. R. rr. 30—33, *post*.
(*o*) *Post*, p. 9.
(*p*) *Post*, p. 11.
(*q*) P.R., Forms B. C., Sched. 2.
(*r*) 54 & 55 Vict. c. 39 (Sched. 1).
(*s*) 48 & 49 Vict. c. 63, *post*.

used in the case of a communication from abroad (see *post*, p. 7), whether the communicator is a corporation or a private person (*t*). Sect. 5 (2). NOTE.

The manner in which and the person before whom declarations are to be taken and made are prescribed by the Patents Rules, rr. 17, 17A (*u*).

As to declarations on behalf of infants or persons under disability, see s. 99, *post*.

"Whereof he . . . claims," etc.—If the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration for the royal grant fails, and the grant consequently becomes void (*v*). And where, in an action for infringement of a patent for improvements in making hats, one of the witnesses of the plaintiffs (the patentees) proved that he had made the improvement while employed in their workshop, the plaintiffs were nonsuited (*w*).

"Or in the case of a joint application, one or more of the applicants claims or claim," etc.—These provisions were introduced by the present Act. Previously, patents could only be granted to the true and first inventor, that is, either the actual inventor or inventors, or the first importer of the invention into this kingdom (*x*).

Doubts having arisen whether under this Act a patent might lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor, it was enacted by the Act of 1885, s. 5 (*post*), that it has been and is lawful under this Act to grant such a patent.

Where the invention included distinct and separate parts invented by separate inventors, it was held before the Act that there should be two patents (*y*). This case does not seem to be touched by the present section or by the Act of 1885.

When the "idea" is communicated by one person to another who works on it, both should be patentees of the resulting invention, otherwise the patent will be void (*z*). And where the actual inventor, before applying for a patent, had verbally agreed to give the benefit of his invention to the applicant, who had taken no part in the invention, and the patent agent, on the joint instructions of the inventor and the applicant, applied for the patent in the name of the applicant only, it was held that no patent could be granted (*a*).

(*t*) *Application of La Societé Anonyme du Generateur du Temple.*, 13 R. P. C. 55.

(*u*) See also 54 & 55 Vict. c. 50, s. 1; 52 & 53 Vict. c. 10, s. 11.

(*v*) *R.* v. *Wheeler*, 2 B. & Ald. 345; *R.* v. *Arkwright*, 1 W.P.C. 64, 72.

(*w*) *Barker* v. *Shaw*, 1 W. P. C. 126, n. See also *Heald's Application*, 8 R. P. C. 429.

(*x*) "Hindmarch on Patents, c. 3, ss. 2, 3.

(*y*) *Craig and Macfarlane's Patent*, Johnson, Pat. Man. 165; Coleridge, S. J.

(*z*) *Elias* v. *Grovesend Tinplate Co.*, 7 R. P. C. 455. See also *Minter* v. *Wells*, 1 Webst. 127; *Bloxam* v. *Elsee*, 1 C. & P. 558; 6 B. & C. 169.

(*a*) *Marshall's Application*, 5 R. P. C. 661.

Sect. 5 (2).

First inventor is he who first discloses to the public.

"The true and first inventor."—These words are taken from the Statute of Monopolies (*x*), and upon them it was observed by Lord LYNDHURST, C., "He is not called the inventor who has in his closet invented it, but who does not communicate it; the first person who discloses that invention to the public is considered as the inventor. The party must be an inventor; you need not say the inventor, because another may have invented it and concealed it" (*y*).

Thus in *Dollond* v. ——— (*z*), where Dollond had obtained a patent for a new method of making the object glasses of telescopes, and it was objected that one Dr. Hall had made the same discovery before him, the patent was upheld, because, "as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered the first inventor."

But in *Kurtz* v. *Spence* (*a*), as between rival patentees, one of whom had applied for his patent on the 10th, and the other on the 11th, August, and where the law officer had directed the patent of the first applicant to bear date August 12th, it was held that, it being proved that the second applicant had, in fact, perfected his invention on August 8th, he was to be considered the first inventor.

And in *Rose's Patents Co.* v. *Braby* (*b*), the complete specification of a patent prior in date to plaintiff's patent was admitted in evidence, though it was not left till one month, nor accepted till two months, after the date of the application for plaintiff's patent.

When the jury found that the alleged invention comprised in a patent was a mere colourable imitation of and an attempt to evade the invention of a previous patentee, and that the second patentee was not the true and first inventor, his patent was revoked (*c*).

Communications from abroad.

First importer is true and first inventor.

The words "true and first inventor" are, by what has been described as "a sort of anomalous decision which has acquired by time and recognition the force of law" (*d*), held to include not merely the actual inventor but also the first importer of the invention into this country from abroad, even though not the actual inventor; and such an importer is entitled to take out a patent, and if not in a confidential relation to the actual inventor, may hold it for his own benefit (*e*). The invention comprised in such a patent is therein described as "communicated from abroad," and it is required that the name, address, and calling of the person by whom the same was communicated

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(*x*) 21 Jac. 1, c. 3, s. 5.
(*y*) *Houschill Co.* v. *Neilson*, 1 Webst. 719.
(*z*) 1 Webst. 43.
(*a*) 5 R. P. C. 161.
(*b*) 11 R. P. C. 198.
(*c*) *Edge* v. *Harrison*, 8 R. P. C. 74.
(*d*) *Per* JESSEL, M.R., *Marsden* v. *Saville Street, etc. Co.*, 3 Ex. D. 203, 205.
(*e*) *Steedman* v. *Marsh*, 2 Jur. (N.S.) 391; *Nickels* v. *Ross*, 8 C. B. 679, 723.

Sect. 5 (2). Note.

should appear in the application (P. R., Form A1). If a person takes out a patent as for an original invention, when, in fact, it was communicated to him from abroad by the inventor in order that he might obtain a patent for the inventor, the patent has been said to be void. (*f*) A declaration by a person applying for a patent that he is the first and true inventor, though, in fact, the invention was communicated to him from abroad, may, however, well be held to be true in point of law, and it may be that a patent honestly obtained under such circumstances may be valid. But the point has not been decided (*g*). The law officer will not, on an application for a patent, entertain an objection that the invention has been obtained from some person abroad (*h*).

It is not necessary that the person taking out the patent should be the *meritorious* importer; he may be the mere clerk or agent of the foreign inventor (*i*), and may himself be an alien resident abroad (*k*).

Patentee may be agent of inventor.

The patent may be (*l*), and generally is, obtained by the agent as trustee for and on behalf of the actual inventor, and the latter is, in the eye of the law, a mere stranger. And so strictly has this distinction been observed, that when it was objected that the inventor, a foreigner, for whom the patent was held by his English patent agent, to whom it had been granted as a communication from him, was possessed of knowledge which it was alleged ought to have been but was not embodied in the specification, and that therefore the patent was bad, it was held that, inasmuch as it was not suggested that this knowledge was possessed by the actual patentee, the objection failed altogether (*m*).

On question of specification, knowledge of the patentee, not of the inventor, is looked to.

So also it was held that the fact that in the specification of a patent for a communication from abroad the patentee had stated all that had been communicated to him was no answer to an objection that the specification did not sufficiently describe the invention (*n*).

Rule as to communication from abroad not extended to communication in this country.

It was, however, held that the privilege thus granted to the importer of a foreign invention could not be extended so as to include a communication made in England from one British subject to another, and that the legal personal representative of an inventor deriving his knowledge only from the inventor's papers could not take out a patent (*o*). (See now, however, s. 34, *post*.) But if a man from abroad

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(*f*) *Milligan* v. *Marsh*, 2 Jur. (N.S.) 1083. The head-note appears incorrect.

(*g*) See *Avery's Patent*, 36 Ch. D. 307, 318, 324.

(*h*) *Edmund's Patent*, Griffin, P. C. 281. See *post* under s. 11.

(*i*) *Beard* v. *Egerton*, 3 C. B. 129.

(*k*) *Re Wirth's Patent*, 12 Ch. D. 303.

(*l*) *Beard* v. *Egerton*, 3 C. B. 97.

(*m*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 582.

(*n*) *Wegmann* v. *Corcoran*, 13 Ch. D. 66; 41 L. T. (N.S.) 357.

(*o*) *Marsden* v. *Saville Street, etc. Co.*, 3 Ex. D. 203. See also *Tennant* v. ———, 1 Webst. 125, n.

Sect. (5) 2. communicates to A., who communicates to B., it seems that B. may take out the patent (*p*); and letters patent can be granted to an alien resident abroad for an invention communicated to him by another alien also resident abroad (*q*). The Patent Office, however, now refuses to grant patents to agents abroad for communications from foreigners also residing abroad (*r*).

NOTE.

In *Renard* v. *Levinstein* (*s*) it was said that when an invention is partly original and partly communicated from abroad, it is an arguable question whether it is or is not incumbent on the patentee to distinguish his own part from the rest of the invention. But in *Moser* v. *Marsden* (*t*), when the invention was described as a communication from abroad, it was held by the Court of Appeal that the fact that the patentee had made improvements on the invention communicated to him without distinguishing such improvements on the face of the specification, was no objection to the patent. "The patentee is the true and first inventor within the meaning of the Patent Law whether he invents himself or whether he simply imports a foreign invention. He is not anything but a true and first inventor if he does both, that is, *if he both imports a foreign invention and improves it himself*" (*u*).

SUB-SECTION (3).

Provisional specification.

The provisional specification need not enter into all the minute details as to the manner in which the invention is to be carried out (*x*). It is only to disclose the invention in the rough state (*y*). It need not describe the manner in which the invention is to be carried into effect (*z*), nor need it describe the nature of the invention otherwise than roughly, but it ought to do so fairly and honestly (*a*). See also under sub-s. (4), *post*.

Insufficiency of provisional specification does not invalidate the patent.

Under the Act of 1852, it was held that the insufficiency of the provisional specification did not invalidate the patent, and that the only use which could be made of such insufficiency would be on the question, whether the patentee really had, at the time of his application, invented the invention which he afterwards claims as within his

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(*p*) *Per* JESSEL, M.R., *Plimpton* v. *Malcolmson*, 3 Ch. D. 552.

(*q*) *Re Wirth's Patent*, 12 Ch. D. 303.

(*r*) See notice of April 21st, 1884 (Patent Office Jonrnal, May 9, 1884).

(*s*) See *per* KNIGHT-BRUCE, L.J., 10 L. T. (N.S.) 177; *Avery's Patent*, 36 Ch. D. 307.

(*t*) 10 R. P. C. 350.

(*u*) See *per* LINDLEY, L.J., *Moser* v. *Marsden*, 10 R. P. C. 359.

(*x*) *Re Newall and Elliot*, 4 C. B. (N.S.) 269; *Penn* v. *Bibby*, L. R. 2 Ch. 127, 132.

(*y*) *Per* JESSEL, M.R., *Stoner* v *Todd*, 4 Ch. D. 58, 60.

(*z*) See *per* COTTON and LINDLEY, L.JJ., *Woodward* v. *Sansum*, 4 R.P.C. 175, 177.

(*a*) *Per* FRY, J., *United Telephone Co.* v. *Harrison*, 21 Ch. D. 747. See also *per* COTTON, L.J., *Woodward* v. *Sansum*, 4 R. P. C. 166, 174; and see *Siddell* v. *Vickers*, 39 Ch. D. 92.

patent (*b*). And this is the case also under the present Act. The real question is not whether the provisional specification is defective, but whether the complete specification is excessive (*c*). See also under s. 9 (1), *post*, p. 32.

Sect. 5 (3). NOTE.

SUB-SECTION (4).

Every patent for a new invention has hitherto, at least since the time of Queen Anne, contained a condition making the same void if a specification were not filed within a definite time, or, in case a complete specification had been filed before the grant of the patent, then avoiding the patent if that specification were insufficient. Such a condition was not required by the common law or the Statute of Monopolies, but it was the practice to insert it in patents, and the practice was expressly recognized in s. 10 of the Act of 1852 (*d*).

Complete specification.

The present sub-section alters the old rule, and makes the leaving a complete specification a condition precedent to the grant of the patent.

The old condition required that the specification should "particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed," and these words have been followed in this sub-section.

"Must particularly describe and ascertain," etc.—It will be observed that the language of the Act (which in this particular is the same as the Act of 1852) (*e*) differs as regards the provisional and complete specification. While the former is required only to *describe the nature* of the invention, the latter must *particularly describe and ascertain* the nature of the invention, *and in what manner it is to be performed.* These are two quite different things. The object of requiring the patentee to state the nature of his invention is to let the public know what is the prohibited ground, and what they are not to do—what the patentee has got his grant for. The object of the requirement that he shall also particularly ascertain the means of performing the invention, is to prevent patentees getting patents for an invention, and keeping to themselves the means of performing it, so that, after they had prohibited the public from using it for fourteen years, and had got the monopoly given to them by the letters patent, they could still keep on using the thing by keeping secret the mode in which they did it (*f*).

Difference of requirements in provisional and complete specification.

(*b*) *Curtis* v. *Platt*, Griffin, L. O. C. 53 ; 5 R. P. C. 87, n.

(*c*) *Siddell* v. *Vickers*, 39 Ch. D. 92, 97. (Judgment of KEKEWICH, J.)

(*d*) See "Hindmarch on Patents," p. 151, and the Schedule to 15 & 16 Vict. c. 83.

(*e*) 15 & 16 Vict. c. 86, s. 6.

(*f*) *Per* GROVE, J., *Philpott* v. *Hanbury*, 2 R. P. C. 38. See also *per* the same learned judge, *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 238. See also *per* LINDLEY, L.J., *Woodward* v. *Sansum*, 4 R. P. C. 176.

Sect. 5 (4).

NOTE.

In complying with the first condition, *i.e.*, in describing the nature of his invention, the patentee does all that is necessary if he makes the nature of his invention plain to persons having a reasonably competent knowledge of the subject, though from want of skill they could not themselves carry out the invention. In complying with the second condition, *i.e.*, in describing in what manner the invention is to be performed, the patentee does all that is necessary if he makes it plain to persons having reasonable skill in doing such things as have to be done in order to work the patent, what they are to do in order to perform his invention. If, as may happen, they are to do something the like of which has never been done before, he must tell them how to do it if a reasonably competent workman would not himself see how to do it on reading the specification or on having it read to him. The principle to be applied to the language used to comply with the two conditions is the same for both, but one class of persons may understand only one part of the specification and another class only the other, and yet the patent may be valid (*g*).

Where there was in the complete specification no separate description of the nature of the invention, which was only described by a reference to the title and by the preliminary words of the description of the mode of carrying the invention into effect, the nature of the invention was held to be sufficiently described (*h*).

To whom specification is addressed.

The specification should be so framed as to enable a workman of ordinary skill and intelligence, conversant with the business, to carry out the invention (*i*). The specification will be a bad specification if only eminent engineers, or managers of great manufactories, or foremen, being men of superior intelligence, would understand it, and if an ordinary workman, using that amount of skill and intelligence which may fairly be expected of him, would not understand it (*k*). But if the specification is framed so as to enable an ordinary workman "possessed of knowledge in the particular industry," to carry out the invention, it is sufficient (*l*). And it is not necessary that such a person should be able to do the work without any trial or experiment, which, when it is new or especially delicate, may frequently be necessary, however clear the description may be (*m*).

(*g*) *Per* LINDLEY, L.J., *Edison, etc. Co.* v. *Holland*, 6 R. P. C. 243, 280.

(*h*) *Shaw* v. *Jones*, 6 R. P. C. 329, 334.

(*i*) *Per* CHITTY, J., *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 253. See also *Morgan* v. *Seward*, 1 Webst. 174; *Philpott* v. *Hanbury*, 2 R. P. C. 43; *Leonhardt* v. *Kalle*, 12 R. P. C. 117.

(*k*) See *per* JESSEL, M.R., *Plimpton* v. *Malcolmson*, 3 Ch. D. 530, 568. See also *Neilson* v. *Harford*, 1 Webst. 314.

(*l*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 12 App. Cas. 710, 713; *British Dynamite Co.* v. *Krebs*, 13 R. P. C. 190, 192.

(*m*) *Per* COTTON, L.J., *Edison, etc., Co.* v. *Holland*, 6 R. P. C. 278.

Sect. 5 (4).

And a mistake in the drawings of the specification, which an ordinary skilled workman would put right, was held not to invalidate the patent(*n*).

NOTE.

How far errors in specification vitiate patent.

When, however, it is said that an error in a specification which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear upon the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture, and the reason is because such errors cannot possibly mislead. But that proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of any erroneous statement in a specification amounting to a false suggestion, even though the error would be *at once observed* by a workman possessed of ordinary knowledge of the subject (*o*).

And, therefore, when a specification for a process for making a dye described the mixing of aniline with dry arsenic acid and allowing the mixture to stand for some time, and added "or I accelerate the operation *by heating it to, or near to, its boiling point*," and it was shown that unless heat was applied the process was ineffective, the patent was held invalid (*p*).

So also, when a specification directed certain materials to be heated in an "autoclave," and it was shown that at the date of the specification iron and enamelled autoclaves were both known, and that the process would *not* produce the desired result if an enamelled autoclave were used, it was held that the specification was insufficient, although it was proved that at the date of the patent the fact that enamelled autoclaves were inapplicable was not known to the patentee or to scientific persons, and was not discovered till late in the progress of the trial (*q*).

In the case of a joint application for a patent, the complete specification need not be signed by both applicants (*r*).

Some observations on the subject of "claims" will be found *post*, p. 13, under sub-s. (5).

"Drawings."—By the Act of 1886, s. 2, this requirement is not to be deemed insufficiently complied with by reason only that, instead of being accompanied by drawings, the complete specification refers to the drawings which accompanied the provisional specification, and this provision is retrospective (*s*). As to the preparation of drawings accompanying provisional or complete specification, see P. R., rr. 30—33.

(*n*) *Otto* v. *Linford*, 46 L.T. 35, 40.

(*o*) *Per* Lord WESTBURY, L.C., *Simpson* v. *Holliday*, 5 N.R. 340, 341. See also *Monnet* v. *Beck*, 14 R.P.C. 777.

(*p*) *Simpson* v. *Holliday*, 5 N. R. 340; L. R. 1 H. L. 315.

(*q*) *Badische Aniline und Soda Fabrik* v. *La Société Chimique des Usines du Rhône*, 15 R. P. C. 359.

(*r*) *Grenfell and McEvoy's Patent*, 7 R. P. C. 151.

(*s*) 49 & 50 Vict. c. 37, s. 2, *post*.

Sect. 5 (5). SUB-SECTION (5).

NOTE. **"Title."**—See *post*, under ss. 6 and 7.

"Distinct statement of the invention claimed."—Prior to the present Act, a "claim," though usual, was not a necessary part of a specification (*t*); its object was not to claim anything which is not mentioned in the specification, but to disclaim something which is in it, and which the patentee does not profess to have invented (*u*).

Meaning of "distinct claim."

In *Smith's Patent* (*v*), it was held by the law officer that if the specification ended with a statement of the invention claimed, distinct from the description of the invention contained in the specification, this sub-section is complied with, and that there is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. But in *Siddell* v. *Vickers*, it was held by FRY and LOPES, L.JJ. (COTTON, L.J., *diss.*), that a "distinct statement" means something more than a separate paragraph, and that it should be a concise statement of the main features of the invention, something to which the reader might readily refer and learn therefrom, without referring to the body of the specification, what the characteristic features of the invention claimed were (*w*).

A claim of "the general construction, adaptation, or application, and the combination and use of the several parts, in the whole constituting improved, more simple, and efficient appliances, or means for working or operating on iron or steel forgings substantially as hereinbefore set forth, and as illustrated on the accompanying drawings," was held by the majority of the Court of Appeal not to be a "distinct" statement within this section (*x*).

Requirements of s. 5 directory only.

This sub-section and the other sub-sections of *s. 5* are merely directory, and non-compliance with them does not, by force of the section, vitiate the patent (*y*). Although there are contained in the section certain requirements the non-observance of which would be fatal to the patent (as for instance those of sub-s. (4)), that result flows not from the section, but either from the nature of the requirements or the other provisions. See s. 26 (3) of the statute (*z*).

The requirement that the complete specification shall end with a "distinct claim," is one of the requirements which are directory only, and the patent is not bad because it has not been complied with (*a*).

(*t*) *Per* WILLIAMS, J., *Lister* v. *Leather*, 8 E. & B. 1004.

(*u*) See judgment of JAMES, L.J., *Plimpton* v. *Spiller*, 6 Ch. D. 426; *Edison Bell Phonograph Co.* v. *Smith*, 11 R. P. C. 148, 389.

(*v*) Griffin, P. C. 268.

(*w*) 39 Ch. D. 92, 109, judgment of LOPES, L.J.

(*x*) *Siddell* v. *Vickers*, 39 Ch. D. 92. See also *per* HERSCHELL, S.G., *Smith's Patent*, Griffin, P. C. 268.

(*y*) *Siddell* v. *Vickers*, 39 Ch. D. 92.

(*z*) *Siddell* v. *Vickers*, *ubi supra* See judgment of FRY, L.J.

(*a*) *Siddell* v. *Vickers*, *ubi supra*: affirmed 15 App. Cas. 426; *Edison Bell, etc. Co.* v. *Smith*, 11 R. P. C. 148, 163, 389.

Claims.

Sect. 5 (5).

NOTE.

Foxwell v. *Bostock.*

In patents for combinations *differentia* of the new combination to be shown.

In *Foxwell* v. *Bostock* (*b*), it was held by Lord WESTBURY, C., that in a patent for an improved arrangement or new combination of machinery (*c*), the specification must describe the improvement and define the novelty otherwise and in a more specific form than by the general description of the entire machine, and that it must assign the *differentia* of the new combination. This decision has been interpreted to mean "that where there is a patent for a combination, there must be a discovery or explanation of the novelty, and that the specification must show what is the novelty." But this view is not correct; and in *Harrison* v. *Anderston Foundry Co.* (*d*), it was held by the House of Lords that if there is a patent for a combination, the combination is *ex necessitate* the novelty; and the claim of the combination is of itself a sufficient description. As explained by this case, the decision in *Foxwell* v. *Bostock* amounts to no more than this: "that when a claim is made for a general combination and arrangement of the different parts of a machine, if the court sees that the whole combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but the patentee must condescend on that which is improved. For example, if a particular improvement, say in the arrangement of a cog, or of some other portion of an old combination which was new and useful, had been made, the general combination remaining the same, then, according to the decision in *Foxwell* v. *Bostock*, by describing it as a new combination you would be misdescribing it, because, indeed, the thing discovered would be a particular improvement upon a particular part of the combination" (*e*). Or, to use an illustration adopted by JAMES, V.-C., in *Parkes* v. *Stevens* (*f*), and quoted with approval by Lord HATHERLEY (*g*) if a man had invented a compensation pendulum, it would not do to patent improvements in clocks in general terms, and give a specification of the whole machinery of a clock, introducing somewhere in the course of description the mode of making a compensation, and then end by claiming the arrangement and combination aforesaid.

True effect of decision in *Foxwell* v. *Bostock.*

In an action on a patent under the old law, it was held that the new improvement might be pointed out either in the body of the specification

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(*b*) 4 D. J. & S. 298, 313.

(*c*) As to patents for combinations, see also *post*, p. 261.

(*d*) 1 App. Cas. 578, 580. See also *Proctor* v. *Bennis*, 36 Ch. D. 740, 752, 762.

(*e*) *Per* Earl SELBORNE, C., *Moore* v. *Bennett*, 1 R. P. C. 129, 143. See also *Cartsburn Sugar, etc., Co.* v. *Sharp*, 1 R. P. C. 181, 185; *Perry* v. *Societé des Lunetiers*, 13 R. P. C. 664.

(*f*) L. R. 8 Eq. 366.

(*g*) *Harrison* v. *Anderston Foundry Co.*, 1 App. Cas. 584.

Sect. 5 (5). NOTE.

or in one of the claims. It need not be pointed out in the claim (*h*). But under the present Act it would seem that the improvement ought to be specified in the claim (*i*).

There can only be an improvement of a combination by having all the elements of the first combination and adding something more. In that case, the proper course is to claim for the improvement, and to point out what the improvement is. If the elements of the combination are altered, a different combination has been made, and there is no question of improvement (*k*).

Form of claim to combination.

If the invention is for the combination only, the specification must make it clear that it is the combination, and not any of the specific parts making up the combination, which is claimed (*l*). Thus a claim for "the construction of framework for spring mattresses substantially as hereinbefore described, and illustrated in the accompanying drawing," or any mere modification of the same (*m*), was held to be insufficient as a claim to a combination. But a claim for "the arrangement and construction of parts herein set forth for cutting clay into brick. I claim particularly cutting the clay into the form of bricks by pressing the clay forward by means of a pushing board, or otherwise, against a series of fixed wires so arranged that the clay is pushed or forced past the wires on to a movable board provided with handles, so that twelve or any other convenient number of bricks may be removed at the same time," was held to be a claim to a combination (*n*). So also claims for "the combination of the guided brake levers A 2 with the diagonal cross-ties G and D, and the brake beds B" (*o*), and for "the application of a tip van or waggon on two or four wheels, by means of the side slot or groove-guards with parts hereinbefore described, and figure 2, and letters A, B, C, and J, or any modification thereof" (*p*), have been held to be good claims for the combination.

"Subordinate integers," as well as entire combination, may be claimed.

A patentee of an improvement in machines may claim not only the whole combination which makes up the machine, but also the subordinate combinations which together as integers make up the entire machine (*q*).

(*h*) *Per* LINDLEY, L.J., and BRETT, M.R., *Nordenfelt* v. *Gardner*, 1 R. P. C. 69, 74.

(*i*) Section 5 (5), *ante*, p. 11; *Siddell* v. *Vickers*, 39 Ch. D. 92.

(*k*) See *per* BRETT, M.R., *Nordenfelt* v. *Gardner*, 1 R. P. C. 69.

(*l*) *Rowcliffe* v. *Morris*, 3 R. P. C. 17. See also *Incandescent Gaslight Co.* v. *De Mare, etc., System*, 13 R. P. C. 301, and, on appeal, 559.

(*m*) *Rowcliffe* v. *Morris*, *ubi supra*.

(*n*) *Murray* v. *Clayton*, L. R. 7 Ch. 570, 578.

(*o*) *Westinghouse* v. *L. & Y. Rail. Co.*, 1 R. P. C. 229, 241.

(*p*) *Watling* v. *Stevens*, 3 R. P. C. 39.

(*q*) *Per* COTTON, L.J., *Cropper* v. *Smith*, 1 R. P. C. 87; *Clarke* v. *Adie*, 2 App. Cas. 315; *Harrison* v. *Anderston Foundry Co.*, 1 App. Cas. 574, 582.

It is often material to determine whether these "subordinate integers" (*r*) are claimed merely as parts of the general combination, or whether they are separately claimed as independent inventions.

Claim of subordinate integer not always read as claiming a separate invention.

When the subordinate integer constitutes something which the patentee was bound to give to the public as a means of working his invention, and which may be considered merely as appendant to the invention, as, for instance, in *The British Dynamite Co.* v. *Krebs* (*s*), where, in the specification of a patent for making dynamite, there was, in addition to a claim for the manufacture, a claim for the means of explosion, the subordinate claim will not be read as claiming a separate invention.

In *The British Dynamite Co.* v. *Krebs*, the subordinate combination was incorporated into and formed part of the first claim in the specification. In *Plimpton* v. *Spiller* (*t*), however, a similar construction was adopted where the subordinate claim formed a distinct head of claim in the specification, and it was held by the Court of Appeal that a mode of securing the runners in certain roller skates, which mode had been included in the general description of the skates, and was claimed in the second claim, was to be read as applicable only to the runners of the particular skate described.

Where subordinate integer read as separately claimed.

But in *Cropper* v. *Smith* (*u*), it was said that *Plimpton* v. *Spiller* was to be taken merely as an authority for the construction to be placed on the specification in that particular case, and that where a claim contains particular sub-divisions, namely, first, second, and third, it was not right to say that when the first was as to a general combination, the second and third were only to be considered as pointing out what the patentee considered material, and accordingly, there being three separate claims, of which the first was for the general combination, and the second and third for subordinate parts, the latter were held to be separate and independent claims to the subordinate combination.

Claim merely subsidiary.

If, however, the principal invention is new and useful and properly described, the patent is not invalidated by the addition of a claim for a further combination with it of something which is not new and useful, and which is not claimed except in that combination (*x*). If, in short, a claim is merely subsidiary, and does not increase the monopoly of the patent, it has no effect, and raises no objection to the patent (*y*).

(*r*) *Clarke* v. *Adie*, 2 App. Cas. 321.

(*s*) Goodeve, 88, 93; *S.C.* 13 R. P. C. 190. See also *United Telephone Co.* v. *Harrison*, 21 Ch. D. 720, 741.

(*t*) 6 Ch. D. 412.

(*u*) 1 R. P. C. 88, 90, 91.

(*x*) *Per* WRIGHT, J., *Edison Bell Phonograph Co.* v. *Smith*, 11 R. P. C. 148, 163; affirmed 11 R.P.C. 389.

(*y*) *Per* BRETT, L.J., *Plimpton* v. *Spiller*, 6 Ch. D. 412, 434. See *United Telephone Co.* v. *Harrison*, judgment of JESSEL, M.R., Goodeve, 481; *Edison Bell Phonograph Co.* v. *Smith*, *ubi supra*; *Pneumatic Tyre Co.* v. *Casswell*, 13 R. P. C. 164; *Adamant Stone Co.* v. *Mayor of Liverpool*, 14 R. P. C. 11.

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Thus, where a specification described a process and a material, and claimed the material as the result of that process, the addition of a claim to a particular user of the material was held to be no ground for vitiating the patent (*z*).

Where the claim is for a combination, and not for subordinate parts included in that combination, then, if the combination is new, it is not necessary to specify the subordinate parts as new, or to show in the combination what is new and what is old (*a*).

Claim for combination of complex parts.

How far there may be a good claim for a combination of complex parts is often a question of considerable difficulty. Thus, where there were three separate arrangements for producing three separate effects in a horse clipper, which were now alleged to be combined for the first time in one clipper, and the claim was for a general arrangement, construction, and combination of parts, whereby certain objects were effected, it was said by JAMES, L.J., in *Clark* v. *Adie* (*b*), that combination "was not a term applicable to such improvements in such an apparatus. The general arrangement, construction, and combination, is not a combination in any sense except that in which every one of several improvements may be said to combine with every other in making the machine a better one. Take a screw steamship, in which the whole locomotive apparatus is one which, by means of fuel set on fire under a boiler at one end, sets in motion a screw at the other end. Improvements may be made in every part of that apparatus, but it would be absurd to talk of a combination of an improved steam generator, of an improved arrangement for economising the steam, and of an improved method of attaching and moving the screw." And when the case came before the House of Lords, Lord CAIRNS, C., said that he desired to leave, without any observation, the question whether such a combination would be a good patent (*c*).

So, also, the mere combination of a known interlocking apparatus of railway signals with a known means of actuating such apparatus (*d*), and an alleged invention of an improved mincing machine, which consisted merely in the combination of an old mincing machine and an old filling machine (*e*), were held not sufficient to support a patent.

(*z*) *Neilson* v. *Betts*, L. R. 5 H. L. C. 21. See also *British Dynamite Co.* v. *Krebs*, Goodeve, 94, *S.C.* 13 R. P. C. 190; *Ehrlich* v. *Ihlee*, 5 R. P. C. 437.

(*a*) *Moore* v. *Bennett*, 1 R. P. C. 129, 143, 149.

(*b*) L. R. 10 Ch. 677.

(*c*) 2 App. Cas. 323.

(*d*) *Saxby* v. *Gloucester Waggon Co.*, 7 Q. B. D. 305; affirmed by the Court of Appeal, June 23rd, 1882, and by the House of Lords, Griffin, L. O. C. 57. See also *Willis* v. *Davison*, 1 N. R. 234.

(*e*) *Williams* v. *Nye*, 7 R. P. C. 37, 62. See also *Gaulard and Gibbs Patent*, judgment of Lord HALSBURY, L.C., 7 R. P. C. 379, 382.

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But a patent may be sustained though each principle or process in it was previously well known, provided the mode of combining those processes is new, and produces a beneficial result, and provided also the specification claims not the old processes or any one of them, but only the combination. And therefore a patent for improvements in glass making, which consisted in adopting and combining some previous improvements, viz., suppressing the fire-pots and placing the materials within the furnace itself in a tank or chamber, and forming the sides of the tank or chamber hollow, so that a refrigerating current of air might circulate, and prevent excessive heating of the sides which enclosed the fused material, was held good (*f*). And a claim of a particular method of weaving wire, the result of which was to produce a new and useful article, was upheld, although the weaving machinery employed was old (*g*).

And in the well-known case of *Crane* v. *Price* (*h*), the combination of the previously-known hot air blast with the previously-known use of anthracite in the manufacture of iron, was held a good subject of a patent.

And a claim for the "manufacture of a new kind of weighing-machine, such as herein described, in which, on a coin or the like being placed in the apparatus, the weight of a person or body being weighed will be indicated on a dial or the like substantially as hereinbefore described," was upheld, although weighing-machines were old, and machines in which a coin could be inserted, so as to produce a certain mechanical effect, were old, it being shown that the two had never been combined before in such a manner as to produce the result mentioned in the claim (*i*).

Where there is a good claim for a particular mechanism, a further claim for the combination of that mechanism with other specified machines may be good, although the method of that combination is not described except by a drawing, if the combination is in fact sufficiently shown by the drawing. Such a claim is not too wide, since the purchaser of the improved mechanism has the right of using it as he thinks fit, and therefore with the specified machine, though he must not so use it unless he has purchased it (*k*).

(*f*) *Cannington* v. *Nuttall*, L. R. 5 H. L. 205. See also *Bovill* v. *Smith*, Griffin, L. O. C. 51; *Fawcett* v. *Homan*, 13 R. P. C. 398, 405.

(*g*) *Dowling* v. *Billington*, 7 R. P. C. 191.

(*h*) 1 Webst. 377, 408. As to this case, see remarks of JAMES, L.J., *Murray* v. *Clayton*, 7 Ch. 584, and of Lord BLACKBURN, *Clark* v. *Adie*, 2 App. Cas. 335.

(*i*) *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 113; affirmed, 6 R. P. C. 297.

(*k*) *Arnold* v. *Bradbury*, L. R. 6 Ch. 706, 715.

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NOTE. Anything not claimed is disclaimed.

Whatever is not claimed is to be treated as disclaimed (*l*), and therefore where a particular device was mentioned in the early part of the specification, but was omitted from the claiming clause, it was held not to be claimed (*m*). So also where a patentee claimed a general combination, and afterwards by separate claims claimed certain subsidiary parts, the claim to those particular parts was held to exclude the possibility of a claim for any other parts (*n*).

Popular meaning sometimes given to technical words.

A specification is to be construed like all written documents, taking the words and seeing what is the meaning of the words when applied to the subject matter (*o*). And on this principle a word may be construed in its popular sense, and the word "parallel," as used in relation to the teeth of a horse-clipping machine, was construed in its popular and not its purely mathematical meaning (*p*).

As to construing claim so as to support patent.

A question sometimes arises as to how far, when of two possible constructions of a claim one would invalidate, and the other support, the patent, the Court is bound to take the latter.

It was held that, as between patentee and licensee, the licensee may, in such a case, and in order to show that he is not within the patent, insist upon that construction which will give validity to the claim (*q*). And, in *Clark* v. *Adie* (No. 2)(*r*), it was urged that, when the specification included matters which were, and which were generally known to be, old at the date of the patent, it should be construed so as not to include them. But it was there held by Lord HATHERLEY and Lord BLACKBURN (*s*) that such a course was contrary to decision and to principle, and would be a simple recipe for saying that no patent could ever be upset on the ground of want of knowledge. *Clark* v. *Adie* was a case of patentee and licensee, but the same rule, notwithstanding expressions apparently to the contrary which may be found in the cases (*t*), applies to actions for infringement, and the argument of absurdity cannot be used when the words of the specification are clear (*u*).

But when the judge sees that there is a real substantial invention of great merit, and the description is fairly made, so that a competent workman can make the invention, it is not the duty of the Court to endeavour to construe the patent so as to make it claim that which it is

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(*l*) See *per* Lord CHELMSFORD, *Harrison* v. *Anderston Foundry Co.* 1 App. Cas. 580. See also *per* JESSEL, M.R., *Hinks* v. *Safety Lighting Co.*, 4 Ch. D. 607, 612; *United Telephone Co.* v. *Harrison*, 21 Ch. D. 721, 741.

(*m*) *Jackson* v. *Wolstenholmes*, 1 R. P. C. 105.

(*n*) *Harrison* v. *Anderston Foundry Co.*, 1 App. Cas. 574, 578.

(*o*) *Per* Lord BLACKBURN, *Clark* v. *Adie* (No. 2), 2 App. Cas. 423, 457.

(*p*) *Clark* v. *Adie* (No. 2), *ubi supra*.

(*q*) *Trotman* v. *Wood*, 16 C. B. (N.S.) 479, 504; *Ashworth* v. *Roberts*, 9 R. P. C. 309, 312.

(*r*) 2 App. Cas. 423.

(*s*) *Ibid.*, pp. 433, 437.

(*t*) *Haworth* v. *Hardcastle*, 1 Webst. 484.

(*u*) *Croppor* v. *Smith*, 1 R. P. C. 81, 90, BOWEN, L.J.

utterly absurd to suppose would be claimed, because it is so well known as a matter of public notoriety that no one would think of claiming it (*x*), and such an absurdity will be avoided if this is possible by any legitimate construction of the words (*y*).

The Letters Patent (see 1st Schedule, *post*), contain a clause directing that they are to "be construed in the most beneficial sense for the advantage of the patentee." These words mean that the Court is to ascertain the real meaning of the specification and construe it so as to uphold the patent if it can be reasonably done (*z*). This appears to be, in effect, all that is meant by the "benevolent construction," which it is said to be the duty of the Court to give to a specification. This, which applies not to specifications only, but to all written documents (*a*), may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention if it can be supported on a reasonable construction (*b*). It is a caution against excessive formalism (*c*). But beyond this it does not go (*d*). It is a guide to help to construe a document; it is not an excuse to justify misconstruction (*e*). It has nothing to do with infringement (*f*).

"Benevolent construction."

"The duty of the Court is fairly and truly to construe the specification, neither favouring the one side nor the other, neither putting an unfair gloss or construction upon the specification for the purpose of saving a patent if it is said that the patent is void, nor putting an unfair gloss or construction upon it in order to extend the patent and make it take in something which you may think was an unhandsome taking of the fruits of his invention from the patentee if it is not really an infringement of the patent" (*g*).

Another question on this subject is, whether the Court, in construing a claim, can look at antecedent specifications. In *Adie* v. *Clark* (*h*), the defendant, a licensee, proposed to put in evidence certain specifications with a view to show that, on one construction, the patent was bad for want of novelty, and that, therefore, another construction, which would make the patent good, ought to be adopted. The Court of Appeal held

How far antecedent specifications can be looked at in construing claims.

(*x*) *Per* JESSEL, M.R., *Plimpton* v. *Spiller*, 6 Ch. D. 412, 423, approved by JAMES, L.J., *ibid.* 427.

(*y*) *Adie* v. *Clark*, 3 Ch. D. 134, 143.

(*z*) See *per* LINDLEY, L.J., *Automatic Co.* v. *Knight*, 6 R. P. C. 307.

(*a*) *Per* BOWEN, L.J., *Cropper* v. *Smith*, 1 R. P. C. 89.

(*b*) *Per* JESSEL, M.R., *Hinks* v. *Safety Lighting Co.*, 4 Ch. D. 612.

(*c*) *Per* BOWEN, L.J., *Cropper* v. *Smith*, *ubi supra*.

(*d*) *Per* JESSEL, M.R., *Hinks* v. *Safety Lighting Co.*, *ubi supra*.

(*e*) *Per* BOWEN, L.J., *Cropper* v. *Smith*, *ubi supra*.

(*f*) *Per* LINDLEY, L.J., *Needham* v. *Johnson*, 1 R. P. C. 58.

(*g*) *Per* Lord BLACKBURN, *Dudgeon* v. *Thomson*, 3 App. Cas. 53. See also *Leadbeater* v. *Kitchin*, 7 R. P. C. 235, 244; *Harrison* v. *Anderston Foundry Co.*, 1 App. Cas. 574, 581; *Parkinson* v. *Simon*, 12 R.P.C. 411.

(*h*) 3 Ch. D. 134.

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In *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.* (*k*), DENMAN, J., said that it was necessary to look at the state of knowledge at the time of the publication of the specification in order to decide whether a particular claim was a claim to a combination or a claim to several distinct inventions. In *Couchman* v. *Greener* (*l*), it was said by BRETT, M.R., that if there be any doubt on the construction of the plaintiff's patent, you may look at former patents for the purpose of seeing what is the proper construction of the plaintiff's patent.

And in *Morris* v. *Young* (*m*), it was held in the House of Lords that in order to interpret the plaintiff's specification the Court may inquire what was the state of public knowledge at the time when he obtained his patent.

But in *Crossthwaite* v. *Steel* (*n*), it was held by MANISTY, J., in an action by a licensor against a licensee, that evidence of the state of public knowledge at the date of the plaintiff's patent is admissible only for the purpose of explaining the specification, and the specification being clear the evidence was not received.

Where a patentee in his specification refers to an earlier patent of his own, he is entitled in an action on the second patent to have both specifications read together (*o*).

When claim limited to specific device claimed. The case of *Seed* v. *Higgins* (*p*) is very important on the question of the extent of a claim. In that case, where the claim had originally claimed the application of centrifugal force for the purpose of producing a hard and evenly-compressed bobbin, and afterwards by disclaimer the patentee disclaimed all application of centrifugal force, except by the particular means described, it was held that the claim was strictly limited to these particular means. This case is to be taken as laying down the rule "*that if you find a specific mechanical improvement* claimed, then you must hold the person strictly to that particular mechanical device which he has claimed for effecting the object in view; and if he says it is to be done in one precise and particular way,

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(*i*) *Clark* v. *Adie* (No. 2), 2 App. Cas. 423, 431.

(*k*) 1 R. P. C. 98, 101. See also *per* FRY, L.J., *Ellington* v. *Clark*, 5 R. P. C. 325.

(*l*) 1 R.P.C. 197, 199. See also *Ashworth* v. *Roberts*, 9 R. P. C. 309, 312.

(*m*) 12 R. P. C. 455, 461. See also *Nobel's Explosives Co.* v. *Anderson*, 11 R. P. C. 519, 523.

(*n*) 6 R. P. C. 190.

(*o*) *Parkes* v. *Stevens*, L. R. 8 Eq. 358, 366.

(*p*) 8 H. L. C. 550.

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to that precise and particular way he must be held, and those who have *bonâ fide* employed a different system and a different way must not be held to have infringed" (*q*).

Thus, where in machines for making screws by rolling, cylindrical dies and also straight dies were known, it was held that a claim for the use in such machines of a cylindrical die having formed on its periphery certain ribs of a peculiar construction was to be confined to cylindrical dies, and that the defendants who used straight dies had not infringed (*r*).

And where a specification claimed an explosive material prepared by mixing certain named substances, "which substances are heated after being mixed together, so that the solid bi- or tri-nitro carburetted hydrogen melts, and after solidifying, completely surrounds the unmelted nitrate substantially as above set forth," and the defendants, though they used the specified substances, did nothing to which the latter words of the claim were applicable, it was held by the House of Lords that there was no infringement (*s*).

But a claim for "the preparation of a tri-sulpho acid of alpha napthol or of such sulpho acids of alpha napthol, which upon treatment with nitric acid will retain one or more of these sulpho groups, and become changed into nitro sulpho acids, and chiefly into the sulpho acids of di-nitro napthol as hereinbefore described," was held to be a claim not only for a particular chemical substance, but a claim for the preparation of that substance (*t*).

The narrow construction of the claim may be applied in favour of a patentee as against an alleged anticipation (*u*).

Claim of mode of manufacture.

Where the patentee claimed "the mode of manufacturing a candle by the application of two or more plaited wicks as described," it was held that the patent was for the mode of making the candle, and not for the candle itself (*x*).

When claims too wide.

A claim may be so wide as of itself to invalidate the patent, as in the American case of *Wyatt* v. *Stone*(*y*), referred to by Lord HATHERLEY, L.C.,

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(*q*) *Per* Sir W. P. WOOD, V.-C., *Curtis* v. *Platt*, 3 Ch. D. 135, n., approved by Lord WESTBURY, C., *ibid.* p. 139. See also *Palmer* v. *Wagstaff*, 9 Ex. 501; *Proctor* v. *Bennis*, 36 Ch. D. 740; *Ehrlich* v. *Ihles*, 5 R. P. C. 437, 453; *Hocking* v. *Hocking*, 6 R. P. C. 69; *Ticket Punch, etc. Co.*, v. *Colley*, 12 R. P. C. 171; *Morris* v. *Young*, 12 R. P. C. 455 (H. L.); *Lancashire Explosives Co.* v. *Roburite, etc. Co.*, 14 R. P. C. 303, 311.

(*r*) *Nettlefolds* v. *Reynolds*, 9 R. P. C. 270.

(*s*) *Lancashire Explosives Co.* v. *Roburite Explosive Co.*, 14 R. P. C. 303, 311. See also *Nobel's Explosives Co.* v. *Anderson*, 11 R. P. C. 115, 519; 12 R. P. C. 164.

(*t*) *Badische Anilin und Soda Fabrik* v. *Dawson*, 6 R. P. C. 387. See also *Nuttall* v. *Hargreaves*, 8 R. P. C. 273, 276.

(*u*) *Daw* v. *Eley*, L. R. 3 Eq. 502, n.; *Morris* v. *Young*, 12 R. P. C. 455, 464.

(*x*) *Palmer* v. *Wagstaff*, 9 Ex. 494.

(*y*) 1 Story, 273.

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in *Arnold* v. *Bradbury* (*z*), where the patentee claimed every method of cutting ice except human power, or where the claim is to a principle to be carried into effect in any way you will (*a*).

But it must be very large and vague indeed to justify the court in saying that it is impossible to sustain a patent based upon it (*b*), and it would seem that exception cannot be taken to a claim on the ground of its being wide or general without evidence to show that it includes something old or useless (*c*).

It is not desirable, and it has not been the rule in more recent times, that specifications should be construed with the same rigour and severity as, perhaps, was formerly done (*d*).

Where the patentee of an invention for "improvements in type or blocks for printing posters and the like" described a certain method of building up geometrical pieces of wood so as to produce the printing surfaces and claimed "the production of printing surfaces, etc., etc., by the combination of type high geometrical squares, curves, angles, etc., with plain or ornamental surfaces for typographical poster printing," it was held that the "etc., etc." meant "or such like or *ejusdem generis*," and did not make the claim too vague (*e*).

Of course, upon the evidence a claim may be too wide; as where iron frames for ships being known the claim was construed to include every ship with an iron frame (*f*); or where the claim was a mere enunciation of a known chemical truth (*g*); or was for the use of a particular solution for preserving meat without any description of the way in which it was to be applied, it having been applied for this purpose before (*h*); or was a claim for making belts for driving machinery of a particular kind of canvas, it being shown that belts thus made would only do for machinery of a particular size (*i*). So also where the claim was for obtaining gold from ores by treating the powdered ore with a solution containing cyanide, and it was shown that, unless the solution was used in a limited manner, it was ineffective, the claim was too wide (*k*).

Every claim must be read and construed with reference to the

(*z*) L. R. 6 Ch. 706, 711.

(*a*) *Per* ALDERSON, B., *Neilson* v. *Harford*, 1 Webst. 355.

(*b*) *Arnold* v. *Bradbury*, *ubi supra*.

(*c*) See *per* WRIGHT, J., *Edison Bell Phonograph Co.* v. *Smith*, 11 R. P. C. 163; affirmed on appeal, *ibid*, 389, 405.

(*d*) *Per* Lord SHAND, *Goddard* v. *Lyon*, 11 R. P. C. 354, 364.

(*e*) *Shaw* v. *Jones*, 6 R. P. C. 328.

(*f*) *Jordan* v. *Moore*, L. R. 1 C. P. 624.

(*g*) *Patterson* v. *Gaslight and Coke Co.*, 2 Ch. D. 812, 833.

(*h*) *Bailey* v. *Roberton*, 3 App. Cas. 1055, 1067.

(*i*) *Gandy* v. *Reddaway*, 2 R. P. C. 49, 52.

(*k*) *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232.

specification, and not as if it was an isolated sentence having no connection with or reference to what precedes it (*l*).

Therefore if the specification as containing the description be sufficiently precise, it is of no consequence that expressions are used in the claim which would be too general if they professed to be part of the description (*m*).

Note. Wide expressions in claims may be cut down by body of specification.

Thus, where a patentee in his specification professed to make by machinery ruffles or frills which had never been before made by machinery, and described the necessary machinery, and then claimed the production of the article by machinery; and where the patentee described an improved ruffle and the machinery by which it was to be made and fastened to a plain fabric by a single series of stitches, and claimed "the production by machinery of ruffles, and the simultaneous attachment of them to a plain fabric by a single series of stitches"; in each case the claim was, upon reading the specification alone and without evidence, held not to be too wide (*n*).

And a claim for a method of preparing the illuminating part of an electric lamp consisting of electrically heating the same while it is surrounded by a "carbon gas or liquid," was held not to be too wide, although the latter words would include carbonic oxide or carbonic acid, which would not answer the purpose, it being clear from the body of the specification that gases such as the two latter were to be avoided (*o*).

And where in the specification of a patent for improvements in waistbands and the method of weaving webs suitable for such uses, the patentee described the method of weaving the waistbands, and claimed (1) the waistband of the formation substantially as set forth, and (2) certain arrangements of machinery; it was held that the claim was not a claim to the waistband alone, but to a waistband made in the way pointed out by the patentee (*p*).

Construction of claim, how far modified by evidence.

And the construction of a claim too wide on the face of it may be modified by evidence. Thus, if the claim on the face of it includes a whole class of articles, yet it could be shown that no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of the class, the true construction of the claim may be held to be only for that part which an ordinary workman might take (*q*).

And if a man is patenting a product it is absolutely necessary to

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(*l*) *Edison, etc. Co.* v. *Woodhouse* (No. 2), 4 R. P. C. 99, 107; *Leadbeater* v. *Kitchin*, 7 R. P. C. 235, 244; *Edison Bell Phonograph Co.* v. *Smith*, 11 R. P. C. 148, 389.

(*m*) *Kay* v. *Marshall*, 2 Webst. 36, 39. See also *Beard* v. *Egerton*, 8 C. B. 215.

(*n*) *Arnold* v. *Bradbury*, L. R. 6 Ch. 706; *Edison Bell Phonograph Co.* v. *Smith*, 11 R. P. C. 148, 389.

(*o*) *Edison, etc. Co.* v. *Woodhouse*, (No. 2), 4 R. P. C. 99, 107.

(*p*) *Vorwerk* v. *Evans*, 7 R. P. C. 265, 271.

(*q*) See *per* BRETT, M.R., *Gandy* v. *Reddaway*, 2 R. P. C. 52; *Edison, etc. Co.* v. *Woodhouse*, *ubi supra*.

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describe in the specification a mode of making that product, otherwise his patent is bad (*r*).

NOTE.
More claim for principle bad.

A mere claim for a principle is bad; the patent must be for a mode of carrying the principle into effect (*s*).

If a patentee has a new principle or a new idea, and then shows a mode of carrying that into practice, he may patent that, though he could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new (*t*). Thus in the hot blast patent (*u*), where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron-ore and fuel would produce economy, it was held sufficient that the patentee stated that the air was to be heated in a closed vessel next the furnace (*v*).

In *Minter* v. *Wells* (*x*), a claim for "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight acted as a counter-balance to the pressure against the back of the chair, as above described," the arrangement being described in detail in the body of the specification, was held to be not a claim for a principle, but of an invention of applying the principle.

And in *Otto* v. *Linford* (*y*), where the patentee claimed in a specification of improvement in gas engines, "admitting to the cylinder a mixture of combustible gas or vapour with air, separate from a charge of air or incombustible gas, so that the development of heat, and the expansion or increase of pressure produced by the combustion, were rendered gradual, substantially as and for the purposes set forth," the specification having elaborately described the arrangements by which this object was effected; an objection that the claim was a mere claim for a principle was not sustained.

And in the *Edison Bell Phonograph Co.* v. *Smith* (*z*), a claim in the following terms: "In a phonograph attaching both the recording point and the reproducing point to the same diaphragm, means being provided whereby either of the points may be brought into operative position on the surface of the "phonogram," was held not to claim a principle, but to be a claim for a particular arrangement of essential parts.

"Substantially as described."

It is very common practice in the claim for a particular arrangement described in the specification to use the words "substantially as

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(*r*) *Per* KAY, L.J., *Nobel's Explosives Co.* v. *Anderson*, 11 R. P. C. 530.

(*s*) *Boulton* v. *Bull*, Dav. P. C. 112; *Jupe* v. *Pratt*, 1 Webst. 145, 146.

(*t*) *Per* JESSEL, M.R., *Otto* v. *Linford*, 46 L. T. (N.S.) 39.

(*u*) *Neilson* v. *Harford*, 1 Webst. 370.

(*v*) See *per* JESSEL, M.R., *Otto* v. *Linford*, *ubi supra*.

(*x*) 1 Webst. 127, 134.

(*y*) 46 L. T. (N.S.) 39.

(*z*) 11 R. P. C. 148, 389, 398.

described." But the word "substantially" is useless, because the law gives it to the patentee without his using it. The law says that if a man, although not literally infringing a patent, yet substantially infringes it, it is an infringement (*a*). So also the addition in a claim of the words "or any mechanical equivalent," is generally useless, and may be mischievous, because, if taken in the largest sense, the claim must be too large (*b*). Sect. 5 (5). NOTE.

A person who takes out a patent for an invention which consists in the use of certain proportions, is not bound to say, "I limit my claim to these precise proportions" (*c*). Nor is it an objection to the specification that the proportions in which certain alternative materials are to be used are not shown, if from the examples given in other materials a chemist could have no difficulty in ascertaining the proportions for the alternative substances (*d*). "Proportions."

But though a specification may be good which describes some out of many kinds of means or sets of proportions, yet if all are claimed, the patent will be invalidated on proof that extended experiments and research are necessary to discover what kind of means or proportions other than those described will produce any useful effect (*e*).

As to the words "may be varied," see observations of Lord HATHERLEY in *Clark* v. *Adie* (No. 2) (*f*). "May be varied."

Where a specification of a patent for a new dye stated that a number of oxidisable substances mentioned could be used, and also others, and gave certain examples of the process as carried out with particular oxidisable substances, and claimed "the process . . . by the action of suitable oxidisable substances and free alkalis . . . substantially as described," it was held to be no objection to the patent that the specification showed no means for ascertaining what oxidisable substances were not suitable (*g*). "Suitable."

Inventors are not required to know or to point out the reasons or causes why beneficial results are produced by the means which they describe and claim as effective, and which are effective in causing them, nor to know or point out all the beneficial effects which may result (*h*). Statement of theory of process.

But where the patentee of a method of obtaining new dyes claimed in effect the creation of a new metallic salt, and the substitution of an

(*a*) *Per* GROVE, J., *Young* v. *Rosenthal*, 1 R. P. C. 29, 33; *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 229, 241.

(*b*) See *per* WOOD, V.-C., *Curtis* v. *Platt*, 3 Ch. D. 137, n.

(*c*) *Per* Sir W. PAGE WOOD, V.-C., *Patent Type Foundry Co.* v. *Richard*, Johnson, 384.

(*d*) *Leonhardt* v. *Kallé*, 12 R. P. C. 103.

(*e*) *Per* WRIGHT, J., *Maxim Nordenfelt Co.* v. *Anderson*, 14 R. P. C. 371, 385; affirmed, *ibid*, 671.

(*f*) 2 App. Cas. 433.

(*g*) *Leonhardt* v. *Kallé*, 12 R. P. C. 103. See also *Maxim Nordenfelt etc. Co.* v. *Anderson*, 14 R. P. C. 671.

(*h*) *Per* WRIGHT, J., *Maxim Nordenfelt, etc. Co.* v. *Anderson*, 14 R. P. C. 371, 385, 386. See also *Leonhardt* v. *Kallé*, 12 R. P. C. 103, 117.

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alcoholic radicle for the metal of that salt, and it was shown that the supposed salt was not only non-existent but impossible, it was held that the patent was bad, on the ground that the claim was for an impossible process, or for a process which was not described (*i*).

In a second action on a patent, the Court of Appeal is bound by the construction placed on the specification in the first action by the Court of Appeal (*k*). But different considerations may apply if the patent is attacked by a petition for revocation (*l*).

Product claims.

The question how far a claim for a new product, apart from the mode of making, can be sustained, has given rise to considerable differences of opinion.

In *Jupe* v. *Pratt* (*m*), it was said by ALDERSON, B., during the argument of counsel, that if a patentee has discovered a principle, and described some mode of carrying the principle into effect, he is entitled to be protected against all other modes of carrying the same principle into effect. This *dictum* was also laid down in the case of *Household Co.* v. *Neilson* (*n*), and, on the authority of these cases, it was held by PEARSON, J., in the *Badische Anilin und Soda Fabrik* v. *Levinstein* (*o*), that when a patent is taken out for a new result not known before, and there is one process described which is effectual for the purpose of arriving at that new result at the time when the patent is taken out, the patentee is entitled to protection against all other processes for the same result, and no person can, without infringing upon his patent, adopt simply a different process for arriving at the same result.

But this view of the law has been lately dissented from in the Court of Appeal. It has been pointed out that ALDERSON, B., in a later case (*p*), used language which showed that his *dictum* above quoted went too far. And in *Automatic Machine Co.* v. *Knight* (*q*), COTTON, L.J., stated the rule to be: "You can prevent anyone from using the same method of carrying that principle into effect, and you can prevent anyone from using only the same thing with a colourable difference." And in *Nobel's Explosives Co.* v. *Anderson* (*r*), the law was said by KAY, L.J., to be clearly settled, that if the result of the patent is entirely new, and one method of arriving at that result is described on the face of the specification, the patentee cannot say "that enables me to treat every other method of arriving at that result as an infringement"; but the question

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(*i*) *Monnet* v. *Beck*, 14 R. P. C. 777.

(*k*) *Edison* v. *Holland*, 6 R. P. C. 243, 276. See also *Otto* v. *Steel*, 2 R. P. C. 109, 114.

(*l*) See *Lewis and Stirokler's Patent*, 14 R. P. C. 24, 35.

(*m*) 1 Webst. 146.

(*n*) 1 Webst. 685. See also *Easterbrook* v. *G. W. Rail. Co.* 2 R. P. C. 207, 208.

(*o*) 24 Ch. D. 171.

(*p*) *Neilson* v. *Harford*, 1 Webst 355. See also 342, n.

(*q*) 6 R. P. C. 297, 304.

(*r*) 11 R. P. C. 519, 527.

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is in every case, whether the method, which he says is an infringement, is so like the method which he has himself described as to be substantially the same, or, in other words, only colourably different (*s*).

In *Vorwerk* v. *Evans* (*t*), where the patented article was a waistband of a peculiar formation, the question was raised whether if the claim were read so as to be a claim for the waistband however made, it would be good. The Court of Appeal decided that the claim was only to the waistband when made in the way pointed out by the specification; but COTTON and BOWEN, L.JJ., intimated an opinion that if the claim had been for the waistband alone, it would have been a good claim.

Reference of application to examiner.

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner (*u*), and the title sufficiently indicates the subject-matter of the invention.

"**Fairly described.**"—See under s. 5 (3), *ante*.

"**Title.**"—See the cases collected in Hindmarch on Patents, pp. 43—47; Johnson Pat. Man., 91—93; Agnew on Patents, pp. 143—149; Higgins' Digest of Patent Cases, (2nd ed.), 559—563; and see *post*, under s. 7 (1).

Power for comptroller to refuse application or require amendment.

7.—(1.) *If the examiner reports that the nature of the invention is not fairly described, or that the application specification or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application specification or drawings be amended before he proceeds with the application.*

(2.) *Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.*

(3.) *The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining*

(*s*) And see judgment of Lord HALSBURY, V.-C., in H. L., 12 R. P. C., at p. 167.

(*t*) 7 R. P. C. 265, 272, 274. See also *Rickman* v. *Thierry*, 14 R. P. C. 105, 116, 121, 122.

(*u*) P. R. *post*, rr. 30—33. The acceptance of an application is to be advertised and notice of acceptance is to be given to the applicant. P. R. r. 21.

Sect. 7 (3). *whether and subject to what conditions, if any, the application shall be accepted.*

(4.) *The comptroller shall, when an application has been accepted, give notice thereof to the applicant.*

(5.) *If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.*

(6.) *Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.*

By the Act of 1888 (*x*), the following is substituted for this section :—

Section 7, as to applications.

"**7.**—(1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer (*y*).

"(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

(*x*) Section 2, *post*.

(*y*) Law Officers Rules, *post*.

"(4.) The comptroller shall, when an application has been accepted (*z*), give notice thereof to the applicant. Sect. 7 (4).

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

SUB-SECTION (1).

"The comptroller may . . . require that the application, specification, or drawings be amended." — The report of the examiner is not to fetter the judgment of the comptroller, but to assist him, and if upon the face of the specification, the comptroller saw, apart from the report of the examiner, that the specification was insufficient, it would be in his power to require an amendment . . . The amendment to be required is to be determined by the judicial act of the comptroller with an appeal to the law officer. It is not intended to relegate to the examiner the function of deciding what the amendment is to be, though undoubtedly if the examiner reports that there is a full and fair description, the application goes on (*a*).

Amendment of title.

If in the opinion of the comptroller the title does not sufficiently indicate the invention described in the provisional specification, the comptroller may, under this section, require the title to be amended (*b*).

But on an application for a patent for "improvements in casks and tubs," with a complete specification filed in the first instance, in which, though it was stated that the invention was applicable to barrels or other casks, and also to tubs and analogous vessels in which the staves are formed with a croze or groove for receiving the head or bottom," the claims were specific, and did not relate to the vessels themselves, but to a mode of fastening in the heads or bottoms of the vessels, it was held that the title was sufficient and that the Patent Office could not

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(*z*) Whether with a provisional or complete specification (P. R., *post*, r. 21), and the acceptance is to be advertised. *Ibid.*

(*a*) *Per* Sir R. WEBSTER, Att.-Gen., *C.'s Application*, 7 R. P. C. 250.

(*b*) *Dart's Patent*, Griffin, P. C. 307.

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require the title to be amended by the addition, after the word "tubs," of the words "and analogous vessels" (*c*).

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Course where applicant desires to omit part of the invention covered by the title.

If, prior to the time when the complete specification has been accepted, the applicant merely desires to omit part of the invention as covered by the original title and provisional specification, no amendment of the title and provisional specification is of necessity required. The applicant may either leave the title untouched, and insert a disclaiming clause in the complete specification, indicting that part only of the invention originally covered by the latter was intended to be claimed, or, if he prefers it, he may lodge a complete specification, omitting the part desired to be left out, and the Patent Office may then, under the powers of this section and s. 9, permit the original title and provisional specification to be amended. Such an amendment must, however, be confined to excision only, and to such excision as does not extend the scope of the title (*d*).

"And in the latter case the application shall . . . bear date," etc.—This provision is an addition to the corresponding parts of the repealed section.

SUB-SECTION (2).

"When the comptroller refuses to accept an application . . . the applicant may appeal," etc.—This is an addition to the corresponding part of the repealed section.

SUB-SECTION (5).

Sub-section (5) differs entirely from the provisions in the 5th and 6th sub-sections of the repealed section. The comparison in the Patent Office of rival provisional specifications, and the examiner's report thereon, are abolished, and the corresponding provision in s. 11, *post*, p. 39, allowing opposition on the basis of the examiner's report, is repealed.

Time for leaving complete specification.

8.—(1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

"Nine months."—By the Act of 1885 (*e*), the comptroller may extend this time by one month.

(*c*) *Brown's Application*, Griffin, L. O. C. I.

(*d*) *Dart's Patent*, Griffin, P. C. 307.

(*e*) 48 & 49 Vict. c. 63, s. 3, *post*.

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NOTE.

The time is to be reckoned exclusively of the day of the date of the application. The usual course in recent times has been to "construe the day (of the date) exclusively, wherever anything was to be done in a certain event after a given event or date" (*f*); and see note to First Schedule, P. R., *post*, and s. 98.

Month means calendar month (*g*).

Abandoned provisional specification not made public by abandonment so as to vitiate subsequent patent for same invention.

A provisional specification which has been abandoned does not become public by abandonment; and therefore, when an applicant on April 10th obtained, under the Act of 1852, provisional protection for four heads of invention, one of which formed the subject of a provisional specification lodged on the previous March 17th, which latter he thereupon abandoned and completed his patent on the provisional specification of April 10th, before that of March 17th was made public by the Office, it was held that there was no publication of the invention sufficient to invalidate the patent (*h*). And if a provisional specification contain an incomplete description which is omitted in the complete specification, the publication of the provisional specification is not necessarily such a publication as will invalidate a subsequent patent for the omitted part (*i*).

Incomplete description in a provisional specification of part omitted in final.

By the Act of 1885, s. 4, *post*, where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanied or left in connection with such application, are not to be open to public inspection or be published by the comptroller.

But the court can order the production of the specification for the purposes of justice (*k*).

Comparison of provisional and complete specification.

9.—(1.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and

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(*f*) *Per* PARKE, B. *Russell* v. *Ledsam*, 14 M. & W. 582; *Williams* v. *Nash*, 28 Beav. 93.

(*g*) 52 & 53 Vict. c. 63, s. 3.

(*h*) *Oxley* v. *Holden*, 8 C. B. (N.S.) 666.

(*i*) *Stoner* v. *Todd*, 4 C. L. D. 58.

(*k*) *Pneumatic Tyre Co.* v. *English Cycle Co.*, 14 R. P. C. 851.

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(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4.) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months (*l*), become void.

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceedings, *other than an appeal to the law officer under this Act*, unless the court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed (*m*).

SUB-SECTION (1).

"Whether the invention . . . in the complete specification is substantially the same as that . . . in the provisional specification."—The object of the provisional specification, which was first introduced by the Act of 1852, was to ascertain the identity of the invention, and to make it certain that the patentee should ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance (*n*). This being so, it was held that the provisional and complete specification of a patent ought not so to differ as that the nature of the invention as described in the one shall be materially different from the nature of the invention as described in the other (*o*); and an objection that there is a material variation between

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(*l*) See Act of 1885, s. 3, *post*.

(*m*) This section is amended by the Act of 1888, s. 3 of which provides that the words "*other than an appeal to the law officer under this Act*," shall be omitted in sub-s. (5).

(*n*) *Per* POLLOCK, C.B., *Newall* v. *Elliott*, 10 Jur. (N.S.) 955.

(*o*) *Foxwell* v. *Bostock*, 4 D. J. & S. 298.

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the provisional and complete specification was, and (notwithstanding the new machinery of thissection) still is (*p*) a good objection to the validity of a patent. *It has, however, been said, that having regard to the provisions of the present section the court ought not to decide against the validity of a patent on this ground unless the two inventions are unmistakably different, and that if a case is on the border line, the patent ought to be held good rather than bad* (*q*).

The general rule is thus stated by Lord ESHER, M.R. (*r*): "If the complete specification sets out and claims an invention independent of that which is in the provisional specification, besides also describing that invention which is in the provisional specification, then the complete specification is bad. It would be equally bad if the invention described in the complete specification were a wholly different invention from that described in the provisional specification, because, as has been said, the patent is not given then for the invention which is described in the provisional specification. Therefore, if there were only one invention described in the provisional application, and only one in the complete specification, but those two inventions were wholly and substantially different, the patent would be bad. So if an invention is described in the provisional specification, which invention is also described in the complete specification, but in the complete specification another and distinct invention is described and claimed, then it is bad, because, with regard to the second invention so described and claimed in the complete specification, there would be no provisional specification to cover it."

Therefore, where a provisional specification of an invention of "improvements in preserving animal substances" described the use for this purpose of gelatine mixed with bisulphite of lime, and in the complete specification described and claimed several solutions, one being a solution of bisulphite of lime alone, as to which no directions for using were given, it was held in an action to restrain the use of bisulphite of lime alone, that if the complete specification were construed so as to include the use of bisulphite of lime alone, the claim was larger than, and different from, that disclosed in the provisional specification, and the patent would be invalid (*s*).

And where the complete specification for an invention of an electrical telephone included an invention of a phonograph which was not

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(*p*) See *per* Lord HALSBURY, C., *Vickers* v. *Siddell*, 15 App. Cas. 499; *Nuttall* v. *Hargreaves*, [1892] 1 Ch. 23.

(*q*) *Per* LINDLEY, L.J., *Gadd* v. *Mayor, etc., of Manchester*, 9 R. P. C. 527. And see *Chadburn* v. *Mechan*, 12 R. P. C. 120, 134. *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, 257; *Shoe Machinery* v. *Cutlan*, 12 R. P. C., 342, 357.

(*r*) *Watling* v. *Stevens*, 3 R. P. C. 151.

(*s*) *Bailey* v. *Roberton*, 3 App. Cas. 1055.

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sufficiently described in the provisional, the patent was held void (*t*). So, also, where the provisional specification described a process of treating oils and fats in a particular manner for the purpose of oxidising or thickening them, and the complete specification claimed this process, and also claimed the combining of oxidised or thickened oils with mineral oils, it was held this latter claim was for a different invention from that disclosed in the provisional specification, and that the patent was invalid (*u*).

And where in a patent for an improved method of tapping barrels the only feature distinguishing the plaintiff's tap from others was the substitution of a gauze for a perforated metal strainer and this was not in the provisional specification, the patent was held invalid (*x*).

But where a patentee of improvements in apparatus for laying down telegraph wires described in his provisional specification a cable passed round a cone so that the cable in being drawn off the coil was prevented from kinking by means of the cone, and also described a cylinder outside which prevented the coil shifting, and the complete specification mentioned and claimed in addition certain rings placed round the cone with the object of preventing the bight of the rope from flying out when going at a rapid speed, and so preventing kinking, it was held that the omission of the rings from the provisional specification did not invalidate the patent (*y*).

And again, where a provisional specification of an invention of "an improvement in the bearings and bushes of the shafts of screw and submerged propellers," described the invention as consisting in employing wood for such bearings and bushes, and the complete specification gave a detailed description showing how the wood was to be arranged in the bearings, and included the application of wood to the shaft so as to revolve therewith, there was held to be no material variance between the provisional and complete specification (*z*).

So also where a provisional specification described an arrangement which was claimed in the first claim of the complete specification, it was held that the addition to the latter of a second claim for an arrangement which was substantially equivalent to that in the first claim, and which, though differing from it in the arrangement of parts, resembled

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(*t*) *United Telephone Co.* v. *Harrison*, 21 Ch. D. 746. See also *Crossley* v. *Potter*, Macr. P. C. 240, 255; *Horrocks* v. *Stubbs*, 3 R. P. C. 221.

(*u*) *Hutchison* v. *Pattullo*, 5 R. P. C. 351. See also *King* v. *Anglo-American Brush Corporation*, 6 R. P. C. 414; *Lane Fox* v. *Kensington, etc., Co.*, [1892] 2 Ch. 66; 3 Ch. 424.

(*x*) *Nuttall* v. *Hargreaves*, [1892] 1 Ch. 23.

(*y*) *Re Newall and Elliott*, 4 C. B. (N.S.) 269.

(*z*) *Penn* v. *Bibby*, L. R. 2 Ch. 127, 135.

it in that the mechanical parts were equivalent in each, did not make the complete go beyond the provisional specification (*a*).

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And where a provisional specification described printing "in colours on the surface of a farina coated fabric by suitable means" as part of a process for producing designs on waterproof fabrics, and the complete specification described certain special media as "suitable media" for printing the colours, it was held that the omission of the suitable media from the provisional specification was no ground for upsetting the patent (*b*).

Where after amendment the specification was held to describe an invention different from that in the provisional specification the patent was held bad and was revoked (*c*).

Patent not bad because complete specification describes a different way of carrying invention from that in provisional.

If the provisional specification describes a way of carrying the *invention into effect*, the *patent is not bad because a different way* is described in the complete specification if both are really within the same invention (*d*).

This arises from the rule laid down in *Crossley* v. *Beverley* (*e*), that it is not only the duty of the inventor to state what he knew at the time of the patent, but the public have a right to be put in possession of all that he knows at the time of the specification. "A patentee putting in a provisional specification shewing the nature of his invention is not bound to describe the way in which that can be carried into effect and operation, but if he does describe the way of doing it, and, before he files his complete specification, he either finds out improvements in that way or a different way of carrying into effect that which is described as his invention in the provisional specification, he is bound to give the public the benefit of what he has discovered as regards the mode of carrying the invention, the nature of which must be described in the provisional specification, into effect, even although there may be improvement, and even invention which was not known to him at the time" (*f*).

Patentee bound to disclose his latest knowledge at time of complete specification.

A patentee is not bound in his provisional specification to detail the advantages of his invention, and in stating at the beginning of the

(*a*) *Watling* v. *Stevens*, 3 R. P. C. 33, 42. See also *Gadd* v. *Mayor, etc., of Manchester*, 9 R. P. C. 516.

(*b*) *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241.

(*c*) *Re Gaulard and Gibb's Patent*, 6 R. P. C. 215; *Lane Fox* v. *Kensington, etc. Co.*, [1892] 2 Ch. 67; 3 Ch. 424.

(*d*) *Woodward* v. *Sansum*, 4 R. P. C. 166, 175.

(*e*) 1 Webst. 117.

(*f*) *Per* COTTON, L.J., *Woodward* v. *Sansum*, 4 R. P. C. 175. See also *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241; *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 580; *Siddell* v. *Vickers*, 39 Ch. D. 92, 105; *Gadd* v. *Mayor, etc., of Manchester*, 9 R. P. C. 516, 526; *Miller* v. *Scarle Barker & Co.*, 10 R. P. C. 106, and *per* FRY, J., *United Telephone Co.* v. *Harrison*, 21 Ch. D. 720, 747.

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specification his chief objects, he cannot be held to have implied that he obtains all those objects in every part of his invention or that some parts may not have other advantages (*g*).

What may be added to provisional in complete specification.

And generally when something is found out during the period of provisional protection "to make the invention work better, or with respect to the mode in which the operation is performed, a thing which is very likely to happen, when in carrying out his invention the inventor finds that some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it, still the nature of his invention remains the same, and it is no objection that in the complete specification which comes afterwards the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made and so as to make the invention which he has described in the provisional specification really workable. If nothing more is done than that," the patent is good (*h*).

Therefore, "improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts, with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification are allowable, and cannot be successfully relied on for the purpose of invalidating a patent for disconformity" (*i*)

Details invented after provisional specification.

Thus where the provisional specification described a bicycle lamp as consisting of certain parts, and an additional detail having been invented before the complete specification was filed, the patentee in his complete specification claimed a combination consisting of the parts described in the provisional with the additional detail, it was held that there was no variance between the provisional and complete specification which would invalidate the patent (*k*).

Development of original invention.

So also where the provisional specification of an improved clip for mounting lamps of velocipedes described only one clip and one action, and the final specification added two clips and a double action, it was held by BOWEN, L.J., that the addition was a development which the patentee was bound to disclose to the public, and that the patent was good (*l*).

(*g*) *Pneumatic Cycle Co.* v. *East London Rubber Co.* 14 R. P. C. 77, 99.

(*h*) *Per* Lord BLACKBURN, *Bailey* v. *Roberton*, 3 App. Cas. 1055, 1075. See also *Crampton* v. *Patents Investments Co.*, 5 R. P. C. 382, 397; 6 R. P. C. 287.

(*i*) *Per* LOPES, L.J., *Woodward* v. *Sansum*, 4 R. P. C. 178.

(*k*) *Lucas* v. *Miller*, 2 R. P. C. 155.

(*l*) *Miller* v. *Searle Barker & Co.*, 10 R. P. C. 106, 111.

Sect. 9 (1).

NOTE.
Addition of a new process for carrying out invention

And where the complete specification of an invention for producing ornamental and other designs upon waterproof fabrics described as part of the process a certain method of vulcanization called the cold vapour process, as well as another method called the cold roller process, the only method described in the provisional specification having been there called the "well-known cold vulcanizing process," if was held that, even assuming that the latter expression only referred to the cold roller process and did not include the cold vapour process, the addition of the latter in the complete specification did not cause such a difference from the provisional as to vitiate the patent (*m*).

A patented invention may, owing to subsequent discoveries of others, prove more valuable and have a wider field of usefulness than what was contemplated by the patentee at the time of his invention, and yet the patentee is entitled to the full benefit of the use of his invention if taken and applied for the purpose of those subsequent discoveries, and if the subsequent discoveries take place after the provisional and before the final specification, there would be nothing improper in referring to them in the final, and there showing the manner in which the invention could best be applied to them (*n*).

Rule in *Crossley* v. *Beverley* held not to apply.

Where between the provisional and final specification of an invention of an electric lamp with a carbon filament made in a particular manner, the patentee lodged a provisional specification of an invention for another method of making the carbon filament, it was held that it was no objection to the validity of the patent for the first invention, that the patentee did not in the complete specification filed in respect of it disclose the method of making the filament (*o*).

Test of disconformity between provisional and final specification.

It may be a fair test of the difference between the provisional and complete specifications to inquire whether, in the opinion of practical men, one mode of manufacture is or is not the natural outcome of the other, so that a competent workman having the one before him might, without any process of invention, produce the other (*p*).

Complete specification may omit from provisional.

A complete specification may omit something which is described in its provisional specification if there is no fraud, and the effect of the remainder is not altered (*q*). But if there is such an omission, the provisional specification cannot afterwards be read for the purpose of supplying a defect in the complete specification (*r*).

(*m*) *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241; See also *Morgan* v. *Windover*, 4 R. P. C. 422, on appeal, 5 R. P. C. 295.

(*n*) *Pneumatic Tyre Co.* v. *East London Rubber Co.*, 14 R. P. C. 77, 101.

(*o*) *Edison & Swan, etc., Co.* v. *Woodhouse*, 32 Ch. D. 520.

(*p*) *Per* KEKEWICH, J., *Morgan* v. *Windover*, 4 R. P. C. 423.

(*q*) *Thomas* v. *Welch*, L. R. 1 C. P. 192; *Penn* v. *Bibby*, L. R. 2 Ch. 127, 134; *Pneumatic Tyre Co.* v. *East London Rubber Co.*, 14 R. P. C. 77 98.

(*r*) *Mackelcan* v. *Rennie*, 13 C. B. (N.S.) 52.

Sect. 9 (1). NOTE.

In *Everitt's Patent*, No. 8403, of 1886 (*t*), the application was for a patent for "an apparatus for the delivery of a given quantity of liquid in exchange for an equivalent in coin or the like," and the provisional specification stated that the inventor adapted to any suitable measuring tap an arrangement whereby in its normal condition the tap was locked, but on insertion of the coin the tap was unlocked and delivered a definite quantity of liquid, the tap automatically closing when that definite quantity had run out; the complete specification, however, described special apparatus, and claimed "the combination with a suitably constructed measuring tap of mechanism, such as is herein described and illustrated in the accompanying drawings." The Patent Office refused to accept the complete specification on the ground that the invention described in the provisional specification was a general principle, while the invention in the complete was simply special means for carrying the principle into effect, not described in the provisional. On appeal, however, Sir R. WEBSTER, Att.-Gen., without expressing any opinion as to the validity of the patent, held that the provisional specification sufficiently described the nature of the invention, and ordered the complete specification to be accepted.

If the additions to provisional specification are not inventor's own, the complete specification will not be allowed.

In the above case, there was no opponent other than the Patent Office, but it was intimated, in the judgment of the law officer, that if it had been shown that the person filing the complete specification had had access to other persons' inventions, or had made use of other persons' specifications, or had made use of any invention derived from any source not his own, the complete specification would not be allowed.

There is nothing in the Act which makes the acceptance of the complete specification conclusive as to its sufficiency in point of law. Objections to the validity of a patent on the ground of insufficiency of specification may be taken as before the Act by way of defence to an action for infringement. This was one of the grounds of *scire facias*, and is therefore a ground of defence under s. 26 (3), *post* (*x*). See also under s. 29 (2), *post*.

SUB-SECTION (4).

"Within twelve months."—The time may be extended by three months. See Act of 1885, s. 3, *post*.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application

(*t*) Griffin, L. O. C. 27.

(*x*) See *Siddell* v. *Vickers*, 39 Ch. D. 92; judgments of COTTON and FRY, L.JJ.

and specification or specifications with the drawings (if any) shall be open to public inspection (*z*). Sect. 10.

11.—(1.) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, *or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application*, but on no other ground (*a*). Opposition to grant of patent.

(2.) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

This section is amended by the Act of 1888, by s. 4 of which it is provided in the above sub-s. (1), the words from "or on the ground of an examiner" to "a previous application," both inclusive shall be

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(*z*) P. R. rr. 21, 22, *post*.

(*a*) Proceedings on oppositions are regulated by the Patent Rules (*post*, rr. 34—44), and Law Officers' Rules, *post*.

Sect. 11. NOTE.

omitted, and there shall be added in lieu thereof the following words, namely—

"Or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification" (*b*).

SUB-SECTION (1).

Opposer must have an interest.

"**Any person.**"—Section 12 of the Act of 1852 limited opposition to persons "having an interest in opposing the grant of letters patent." In the present section, the first and third grounds of opposition imply of necessity an interest in the opposer; but the second ground is, on the face of it, available to any one of the outside public. Sub-s. (3), however, limits this right to persons "being in the opinion of the law officer entitled to be heard in opposition to the grant." The old rule requiring an interest in the opposer, therefore, in substance still prevails. See notes to sub-s. (3), *post*, p. 57.

There is a similar limitation in the case of opposition to amendment of the specification, s. 18 (4), but there is no such limitation on opposition to extension of the term of a patent, s. 25.

Prior user—non-utility—no subject-matter, not now grounds of opposition.

Prior public user (*c*)—want of utility (*d*)—or an objection that the invention is not subject-matter of a patent (*e*), were formerly, but are not now, grounds of opposition to the grant, which can now be opposed only on the three grounds mentioned in this section. And since the Act, it has been expressly decided that the law officer has no jurisdiction to determine whether the applicant's invention is or is not good subject-matter for a patent (*f*). But it may still be necessary for him to consider the point indirectly. See *post*, p. 49.

Under the new practice, the comptroller fills very much the same position in regard to the grant of patents as that formerly occupied by the law officer, while the law officer performs the duties formerly belonging to the Lord Chancellor, whose jurisdiction as to patents,

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(*b*) *Post*, p. 55.

(*c*) *Re Adamson's Patent*, 6 D. M. G. 420; *Re Samuda and Griffiths*, cited Hindmarch on Patents, p. 534; *Re Tolhausen's Patent*, 14 W. R. 551.

(*d*) *Re Cutler's Patent*, 1 Webst. 426.

(*e*) *Re Spence's Patent*, 3 De G. & J. 523.

(*f*) *Jones' Patent*, Griffin, L. O. C. 34.

specially reserved by s. 15 of the Act of 1852, is not mentioned in the present Act, and appears no longer to exist, unless, perhaps, under s. 116, *post*. **Sect. 11 (1).** NOTE.

It may be, therefore, useful to examine the principles which appear to have guided the decisions on oppositions under the old practice, but it must be remembered, in considering these cases, that some of them are cases in which the patent had not been opposed before the law officer, and was opposed for the first time at the Great Seal, and in such cases opposition was in the discretion of the Lord Chancellor(*g*) and a matter of indulgence (*h*), whereas, by the present Act, there is a distinct right of appeal from the comptroller to the law officer. Cases under old practice.

Several cases under the old practice before the law officers not elsewhere reported will be found in Johnson's Patentee's Manual, 6th ed., pp. 159—169.

When the law officer had, after hearing the parties, allowed his warrant to issue, the Lord Chancellor would not interfere with his decision unless a case were made of surprise or fraud, or unless some material fact which, if brought before the law officer, would probably have led him to decide differently, had subsequently come to the knowledge of the party appealing (*i*); nor would the Lord Chancellor interfere on the ground that some fact which was in the knowledge of the opponent at the time was not brought before the law officer (*k*); nor was the opponent allowed to adduce before the Lord Chancellor evidence which he might have brought before the law officer, or to raise before the Lord Chancellor an argument on those facts which he did not raise before the law officer (*l*). Lord Chancellor would not interfere with law officer's decision unless in special cases.

In *Re Russell's Patent*(*m*), Lord CRANWORTH, C., said that, as a general rule, when the matter was in much doubt it was better to run the risk of putting the party opposing to the costs of making out his case in some ulterior proceedings that to withhold the Great Seal from the patent in the first instance, for the obvious reason that the one course would create a remediable and the other an irremediable injury. And this rule was approved and acted on by Lord CHELMSFORD, C., in *Re Spence's Patent* (*n*), where it was objected that there was no novelty in In doubtful cases rule was to seal patent.

(*g*) *Ex parte Henson*, 1 Webst. 432.

(*h*) *Ex parte Manceaux*, L. R. 5 Ch. 518; *Re Mitchell's Patent*, L. R. 2 Ch. 343.

(*i*) *Re Vincent's Patent*, L. R. 2 Ch. 341; see also *Re Daines' Patent*, 26 L. J. Ch. 298; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*k*) *Re Vincent's Patent*, cited above.

(*l*) *Ex parte Sheffield*, L. R. 8 Ch. 237; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*m*) 2 De G. & J. 130, 132. See also *Re Simpson and Isaacs' Patent*, 21 L. T. 81; *Re Spence's Patent*, 3 De G. & J. 523; *Dance's Patent*, Johnson, Pat. Man. 161.

(*n*) 3 De G. & J. 523. Not now a ground of opposition.

Sect. 11 (1). the alleged invention, and that it consisted merely in the application of a well-known process to an equally well-known manufacture; and in *Ex parte Sheffield* (*o*), Lord SELBORNE, C., said that the burden lies on the opponent of showing that the proposed grant is wrong. The question is not whether the proposed patent will be good, but merely whether the applicant can be allowed to proceed.

NOTE.

On this principle letters patent have been sealed even where on the evidence there appeared to be considerable similarity between the alleged invention and one already patented (*p*); and where the evidence of prior user was contained in only one affidavit proving a sale, which was not corroborated by the person alleged to have sold the goods (*q*).

The above rule has been fully recognized under the new practice (*r*).

Viva voce evidence.

The Lord Chancellor would sometimes hear *viva voce* evidence on an application for the Great Seal (*s*), but in general the evidence was taken by affidavit, though declarations were used before the law officer. The evidence is now to be by declaration (P. R., rr. 37, 38). Power is given to the law officer to examine witnesses on oath (s. 38), and they may be cross examined (Law Officers' Rules, *post*, r. IX.).

Mere formal objections not admitted.

Upon the hearing of a petition for the Great Seal the Lord Chancellor would not give effect to an objection founded on a mere matter of form, such as an objection to the jurat to a declaration (*t*). The Lord Chancellor could impose terms on the parties applying for a patent (*u*).

As to costs in opposition cases, see notes to s. 38, *post*,

Grounds of Opposition.

Grounds of opposition under this Act.

(i.) "**That the applicant obtained the invention from the person giving notice of opposition, or from a person of whom he is the legal representative.**"

"**Obtained the invention.**"—These words refer to the identity of the invention, not the right of the person from whom it was obtained to be regarded as first and true inventor. And effect may be given to an opposition under this sub-section, without considering whether the person

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(*o*) L. R. 8 Ch. 237.

(*p*) *Re Tolson's Patent*, 6 D. M. & G. 422.

(*q*) *Re Tolhausen's Patent*, 14 W. R. 551. This is not now a ground of opposition.

(*r*) *Chandler's Patent*, Griffin, P.C. 274; *Cumming's Patent*, Griffin, P. C. 277; *Welch's Patent*, Griffin, P. C. 300; *Jones' Patent*, Griffin, L. O. C. 34.

(*s*) *Re Gething*, L. R. 9 Ch. 633.

(*t*) *Re Wirth's Patent*, 12 Ch. D. 303.

(*u*) *Re Daines' Patent*, 26 L. J. (N.S.) 296; *Re Russell's Patent*, 2 De G. & J. 130.

giving notice of opposition is, as between himself and a third person, entitled to take out letters patent for the invention (*v*). Sect. 11 (1).

NOTE.

The question under this sub-section is not whether there is a balance of evidence on one side or the other. If there is any evidence on either side to be considered and adjudicated upon, it is not the duty of the law officer to stop the issue of the patent. The law officer is only entitled to stop the patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept it, and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence (*w*).

Where on cross applications for a patent it appeared that the inventions were substantially the same, but that one applicant had obtained the invention from the other, the Lord Chancellor refused to seal a patent to the former (*x*).

Where the grant of a patent was opposed on the ground that the invention was only an improvement on a previously-patented invention, not the invention of the applicant, but in which he was interested, and which he and the patentee had assigned to the opponent, who had thereupon granted a licence to the applicant to use the patented invention,—the new patent was ordered to be sealed, but (the Lord Chancellor being of opinion that the applicant had obtained his knowledge while working the original patent) only on the terms that it should be assigned to the owner of the first patent, to be subject, however, to the same arrangement as to licence and otherwise in favour of the applicant; the cost of obtaining the second patent to be considered as part of the costs of working the first patent (*y*).

Where opponent and applicant are in effect joint inventors.

Where it appeared that the opponent and applicant were really joint inventors, the law officer allowed the grant upon both parties filing an agreement at the Patent Office giving the opponent the rights of a joint patentee, the opponent undertaking not to take proceedings to revoke the patent when granted. If the applicant refused these terms, the grant was not to be made, and the appeal was to be dismissed with costs. If the opponent refused, the grant was to be made, and he was to pay the costs of the appeal (*z*).

In *Garthwaite's Patent* (*a*), a similar case, separate patents were granted

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(*v*) *Thwaite's Application*, 9 R. P. C. 515.

(*w*) *Stuart's Application*, 9 R.P.C. 452. See also *Thwaite's Application*, 9 R. P. C. 515.

(*x*) *Hadden's and Lott's Applications*, Johnson, Pat. Man. 168. See also *Marshall's Application*, 5 R. P. C. 661. *Griffin's Application*, 6 R. P. C. 296.

(*y*) *Re Daines' Patent*, 26 L. J. (N.S.) 298.

(*z*) *Lukes' Patent*, Griffin, P. C. 294.

(*a*) Griffin, P. C. 284.

Sect. 11 (1). upon each application, but on condition that each party assigned half his patent to the other, and paid half the fees for keeping it in force. In this case the comptroller offered to grant a joint patent, but the parties preferred separate patents.

NOTE.

Where it was proved that a material part of the invention had been obtained from the opponent, the patent was granted to the applicant and the opponent jointly (*b*).

In *Evans and Otway's Patent* (*c*), where the opponent had already obtained letters patent for an invention substantially the same as that for which the applicant sought letters patent, and it appeared that the applicant and opponent had known each other for some time, and had been jointly experimenting in the invention, the applicant's patent was refused, but on the condition that the opponent executed an assignment to the applicant of half the opponent's patent. In this case, provision was to be made in the assignment that each party should pay half the fees for keeping up the patent, and that in default of either party paying such fees the other party might pay them, and the patent should become the property of the party paying the whole fees. A like provision was made in the case of *Garthwaite's Patent* (*d*).

Master and servant.

Master and servant. — If a servant discovers the invention while in the employ of his master, the servant and not the master is the person to take out the patent, and a patent granted to the master will be void (*e*); if the servant suggests the principle he is the inventor. If, on the other hand, the master suggests the principle, and the servant is employed to perfect the details, or carry into execution the original design of the master, that which the servant suggests, while so employed, is in law the invention of the master (*f*).

Where a master and his foreman had both invented improvements, for which the master sought letters patent, they were granted only on the terms of the master and foreman being treated as joint grantees, the letters patent being vested in two trustees for their joint benefit, and each party to have a free licence for himself and his partners (*g*).

Master has no right to invention of servant.

The mere fact of relationship of master and servant gives no right to the master to the invention of the servant (*h*). But where a workman is employed by an inventor to make a model for the inventor, and he

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(*b*) *Eadie's Patent*, Griffin, P. C. 279.

(*c*) Griffin, P. C. 279.

(*d*) *Ubi supra.*

(*e*) *Barker* v. *Shaw*, 1 Webst. 126; *Minter* v. *Wells*, 1 Webst. 127, 132.

(*f*) *Minter* v. *Wills*, *ubi supra.* See also note 1 Webst. p. 126, under *Barker* v. *Shaw*, and *Bloxam* v. *Elsee*, 1 C. & P. 558, and Hindmarch on Patents, p. 26.

(*g*) *Re Russell's Patent*, 2 De G. & J. 130.

(*h*) *Saxby* v. *Gloucester Wagon Co.*, Griffin, L. O. C. 56, judgment of JESSEL, M.R.; *Heald's Application*, 8 R. P. C. 429.

Sect. 11 (1). NOTE.

suggests improvements in details of the machine, which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them (*i*). So, also, where the invention sought to be patented resulted from investigations or experiments directed and paid for by the employers, and on their instructions, and with their assistance, and in their laboratory, and with their materials (*j*).

But when the invention was based on suggestions made by two persons employed by a company, which had been experimented upon in the company's works under the superintendence of their manager, an application by the manager for a patent was refused (*k*).

Where a man is trying experiments for the purpose of himself taking out a patent, all that he and his servants do together is confidential, and if when he has made his invention complete he takes out a patent, all that he has done confidentially does not affect his patent (*l*). But the question whether the relation between the parties was such as to make the communication confidential, must depend on the whole circumstances of the case (*m*).

This confidence of the servant is, however, a confidence only as regards the secrets of the master, and not as regards the secrets of the fellow-servants; and therefore, where a superintendent in the employ of the London and North-Western Railway Co. invented, but did not patent, a signalling apparatus, the drawings for which were openly prepared in the office of the company, and were seen by several of their draughtsmen, it was held that there was no confidentiality existing between the company and its servants, and that the facts above mentioned were publication sufficient to avoid a subsequent patent obtained by another person for the invention (*n*).

The fact that another person has been making experiments and working towards the same invention as the applicant is no ground for refusing the Seal (*o*).

Section 11 does not apply to communications made abroad.

This section applies only to communications between persons in the United Kingdom and the Isle of Man, and not to communications made abroad, and in the case of an imported invention the comptroller has no

(*i*) *David and Woodley's Patent*, Griffin, L. O. C. 26; *Minter* v. *Wells*, 1 Webst. 132.

(*j*) *Kurtz* v. *Spence*, 5 R. P. C. 181; *Healey's Application*, Johnson, Pat. Man. 165.

(*k*) *Macfarlane's Patent*, Johnson Pat. Man. 168.

(*l*) See *per* Lord BLACKBURN, *Saxby* v. *Gloucester Wagon Co.*, Griffin, L. O. C. 57; *Homan's Patent*, 6 R. P. C. 104.

(*m*) *Humpherson* v. *Syer*, 4 R. P. C. 407, 413.

(*n*) *Saxby* v. *Gloucester Wagon Co.*, Griffin, L. O. C. 56.

(*o*) *Ex parte Henry*, L. R. 8 Ch. 167. See also *Saxby* v. *Gloucester Wagon Co.*, judgment of Lord BLACKBURN, Griffith, L. O. C. 57.

Sect. 11 (1). jurisdiction to inquire into the circumstances under which the invention was obtained by the importer (*p*).

NOTE. And, therefore, where an application for a patent for an invention partly communicated to the applicant by A., and partly the applicant's own invention, was opposed on the ground that A. had in fact obtained the invention, wholly, or in part, from B., who was the actual inventor abroad; the opposition was not allowed, and the patent was sealed (*q*). And the rule applies equally where the applicant alleges that the whole invention for which he seeks a patent was communicated to him from abroad (*r*). And it makes no difference whether the applicant is the person against whom the fraud is alleged, or is the innocent communicatee from such person (*s*).

But where the importer was not applying for a patent as inventor but as a communication from abroad by A., and it appeared that the invention was not in fact communicated by A., and that the applicant had no authority from A. to apply for the patent, A. having instructed some one else to apply, the patent was refused (*t*).

"**Legal representative.**"—These words mean executors and administrators of a deceased person, and do not include a person holding a power of attorney (*u*); nor a person claiming to be entitled by virtue of an assignment of a patented invention and improvements thereon to the particular improvement for which the applicant is seeking a patent (*v*).

(ii.) "**That the invention has been patented in this country on an application of prior date.**"

Old practice Under the old practice, if the opponent could show that the proposed patent was for an invention, part of which was clearly identical with the subject of an existing patent, the Great Seal would not (*w*), at all events where both parties were *bonâ fide* inventors and there was no fraud (*x*), be affixed to a patent for that part, even though the validity of the original patent was disputed (*y*). And in *Ex parte Bates and Redgate* (*z*) this principle was applied where the owner of the existing

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(*p*) *Edmund's Patent*, Griffin, P. C. 281; *Adolph Spiel's Patent*, 5 R. P. C. 281; *Bairstow's Patent*, 5 R. P. C. 287; *Higgins' Patent*, 9 R. P. C. 74. See also *Abel's Application*, reported Johnson, Pat. Man. p. 169, a case under the old law.

(*q*) *Edmund's Patent, ubi supra.*

(*r*) *Lake's Patent*, 5 R. P. C. 415.

(*s*) *Higgins Patent*, 9 R. P. C. 74; *Bairstow's Patent*, 5 R. P. C. 287.

(*t*) *Fiechter's Patent*, Griffin, P. C. 284.

(*u*) *Edmund's Patent*, Griffin, P. C. 281.

(*v*) *Adolph Spiel's Patent*, 5 R. P. C. 281.

(*w*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 577; comp. *Ex parte Scott and Young*, L. R. 6 Ch. 274.

(*x*) *Ex parte Manceaux*, L. R. 6 Ch. 272.

(*y*) *Ibid.*

(*z*) L. R. 4 Ch. 577.

patent was, in fact, the second applicant for the patent, but had first obtained the Great Seal (*a*). See notes under s. 13, *post*.

NOTE.

But in *Re Vincent's Patent* (*b*), where the opposer brought forward a prior patent of his own, and the applicant alleged that he was the real inventor, and had confidentially communicated the invention to the opposer, who had applied for and obtained a patent in fraud of the applicant's rights, it was held that the case being thus within s. 10 of the Act of 1852 (s. 35 of the present Act), the applicant's patent ought to be sealed in order that he might have the opportunity of trying the question before a jury.

And on this principle the patent was sealed when the only ground of opposition was that the invention was borrowed from an existing patented invention, it being an improvement thereon (*c*).

But where, in a case of rival applicants, each opposed the other, and it appeared that the alleged invention was the subject of a previous patent, both applications were refused (*d*).

Where the law officer certified against an application, which was objected to on the ground that the invention was a mere colourable limitation of an invention comprised in an existing patent, the application was refused, with costs (*e*).

Not a question of infringement.

New practice.—The question under this branch of the section is whether the invention has been already patented, not whether it is an infringement of an existing patent (*f*). A patent for an improvement on an invention, already the subject of a patent, may be a good patent if confined to the improvement, though the use of the improvement during the existence of the former (or, as it has been called, the substratum (*g*) patent) without licence would be an infringement (*h*).

Patent not stopped unless inventions identical.

A patent will not be stopped on the ground that the invention for which it is sought has been previously patented, unless it is shown that the inventions are identical (*i*); and notices of opposition, alleging that the invention was the same, or *substantially the same*, as the

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(*a*) See also *Ex parte Bailey*, L. R. 8 Ch. 61; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*b*) L. R. 2 Ch. 341. See, however, as to this, *Stuart's Application*, 9 R. P. C. 452.

(*c*) *Ex parte Fox*, 1 Webst. 431; 1 V. & B. 67.

(*d*) *Re Samuda and Griffiths*, Hindmarch on Patents, p. 534.

(*e*) *Ex parte Yates*, L. R. 5 Ch. 1. See also *Re Stoll's Patent*, 21 L. T. 233.

(*f*) See *Jones's Patent*, Griffin, L. O. C. 34; *Sielaff's Application*, 5 R. P. C. 486.

(*g*) *Ex parte Fox*, 1 Webst. 431.

(*h*) See *per* Lord CAMPBELL, C.J., *Lister* v. *Leather*, 8 E. & B. 1017; *Fox* v. *Dellestable*, 15 W. R. 195. See also *Crane* v. *Price*, 4 M. & G. 580.

(*i*) *Stubbs' Patent*, Griffin, P. C. 298; *Jones's Patent*, Griffin, L. O. C. 34; *Newman's Patent*, 5 R. P. C. 271, *S.C.* Griffin, L. O. C. 40.

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NOTE.

invention patented by the opponent (*k*), or that the invention or *material parts thereof* have been patented or application of prior date (*l*) have been held to be wrong in form (*k*). So, also, a notice of opposition on the ground that the invention is "a direct infringement of the opponent's patent," is informal (*m*).

Differences immaterial, patent refused.

But where, though the inventions are not actually identical, the difference between them is immaterial, the patent will be refused.

Thus, where on on application for a patent for an invention of "an improved method of blasting and shot-firing in mines," it appeared that the only difference between the applicant's and the opponent's invention was, that the latter inserted the explosive in a case, and surrounded it completely with water in an outer case, and the former dispensed with the case, and surrounded the explosive itself with water contained in a waterproof bag, it was held that there was not a sufficient difference between the two inventions to entitle the applicant to a patent (*n*).

So, also, where, in an application for a patent for an invention of an improved screw stopper, the only alleged difference between the inventions was the position of a washer in a groove in the stopper, the patent was refused (*o*).

And where, in an application for a patent for an apparatus for enriching gas by admixture of hydro-carbon vapour, it appeared that in the opponent's invention certain tubes conveying gas to a heating chamber were placed inside the carburetting apparatus, and the heating chamber had partitions, and in the applicant's invention the conveying pipes were outside the carburetter, but might be protected by a shield, and the heating chamber had no internal partition, the difference was considered immaterial, and the law officer declined to grant the patent (*p*).

And where a previous specification claimed the use of any soluble salts of chromium and iron, an application for a patent for an invention, selecting for the same purpose one particular salt of each of these classes of salts, no special advantage being shown, was refused (*q*).

It is a question whether the patent can be stopped if the allegation that the invention has been previously patented can only be supported

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(*k*) *Jones's Patent*, Griffin, L.O.C. 34; *Re Welch*, Goodeve, Patent Practice, 10.

(*l*) *Re Faucett*, Goodeve, Patent Practice, 10.

(*m*) *Daniels' Application*, 5 R.P.C. 413.

(*n*) *Heath and Frost's Patent*, Griffin, P. C. 311.

(*o*) *Aire and Calder, etc. Works and Walker's Application*, 5 R.P.C. 345. See also *Daniel's Application*, 5 R. P. R. 413; *Whittakers' Application*, 13 R. P. C. 580.

(*p*) *Wallis and Ratcliff's Application*, 5 R. P. C. 347. See also *A. H. Smith's Application*, 13 R.P.C. 200,

(*q*) *Wylie and Morton's Patent*, 13 R. P. C. 97.

by combining the claims of the prior specifications, but assuming that such an opposition could be entertained, it would require a very strong case to stop a patent on such a ground (*r*). Sect. 11 (1). NOTE.

That, however, only is patented which an inventor claims in his specification (*s*. 5), and, therefore, the fact that certain arrangements are described in a prior specification is not, if they are not claimed therein, any ground for refusing a subsequent patent for the same arrangement (*s*). Only that is patented which is claimed in prior specification.

Inventions which have only received provisional protection have not been patented within the meaning of this section (*t*). But if the provisionally protected invention is the subject of a pending application for a patent, and the complete specification has been accepted, the person whose specification has been so accepted is by s. 15 entitled to oppose under this sub-section as if he had already obtained his patent (*u*). *Provisionally* protected inventions are not "patented."

The law officer, on an opposition under this sub-section, will not consider whether the opponent's complete specification does or does not go beyond his provisional specification (*v*). But when the opposition was based on a patent in which the provisional specification was filed before and the complete specification after the date of the application by the applicant, and it was not clear that the invention alleged to have been patented by the opponent, which was said to be similar to that of the applicant, was in the opponent's provisional specification, it was held that it would not be just to the applicant to refuse his application (*x*).

Although the law officer has not, under the present law, to consider whether there is or is not subject-matter for a patent, yet where there is a previous anticipatory patent, it is necessary to consider indirectly the differences, and, without saying whether those differences form subject-matter or not, to decide whether the differences are sufficient to differentiate that which has gone before from that which is now claimed (*y*). How far the law officer can consider subject-matter.

And a patent was refused where after eliminating matters which were mere repetitions of matters claimed in the opponent's specification nothing remained which could properly form the subject-matter of a patent (*z*).

(*r*) *Ross' Patent*, 8 R. P. C. 477.

(*s*) *Von Buch's Application*, Griffin, L. O. C. 40.

(*t*) *Bailey's Patent*, Griffin, P. C. 269.

(*u*) *L'Oiseau and Pierrard's Patent*, Griffin, L. O. C. 36.

(*v*) *Haythornthwaite's Application*, 7 R. P. C. 70.

(*x*) *Bartlett's Application*, 9 R. P. C. 511.

(*y*) *Todd's Application*, 9 R. P. C. 487, 488; *McHardy's Patent*, 8 R. P. C. 431. See also *Boult's Application*, 10 R. P. C. 275.

(*z*) *Hedge's Application*, 12 R. P. C. 136.

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NOTE.

Disclaiming clauses.

Although there may be no ground for refusing the patent altogether, the law officer has always recognized that where there is an existing patent, and he sees ground for supposing that the later specification might interfere with the rights under the existing patent, the existing patentee is entitled to protection, and this is commonly done by a disclaiming clause inserted in the applicant's specification (*a*). Similarly, the law officer is bound to protect the public, so that they may not be misled by specification which, on the face of it, might be held to have a wider scope or include a wider kind of invention than that to which the patentee is on the evidence entitled (*b*). And these clauses are equally in the interest of the applicant (*c*).

The principles on which the law officers act in allowing disclaiming clauses are—first, if it appears clear that upon the invention claimed by the prior patentee there will be repetition of the claim to the earlier invention in the later patent; and, secondly, if it is clear that the public would be misled by the later specification without disclaimer (*d*).

But the law officer will not interfere with the applicant's specification where there is no ground for supposing that the owners of the prior patent will be prejudiced or the public misled by the specification as framed by the applicant (*e*). And, therefore, where it was held that no one reading the applicant's claim fairly and referring to his specification could assume that he intended to claim certain mechanism which was comprised in a prior patent (*f*); and where there were substantial differences in the arrangement of the parts of the applicant's and opponent's machines (*g*), a disclaiming clause was refused. In all cases, however, the applicant frames his specification at his peril (*h*).

It is not every prior patentee who has a right to have a disclaiming clause inserted in the applicant's specification; and, therefore, where the law officer considered that it was not absolutely necessary for the opponent for his own protection to insist on such a clause, but the law officer inserted it to protect the public and prevent the applicant's patent from covering more ground than it really ought to cover, an appeal from the comptroller, who had decided to make the patent without any disclaimer, was allowed but without costs (*i*).

And where the comptroller had ordered the insertion of a disclaiming clause, referring to a prior patent which would have had the effect of

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(*a*) *Newman's Patent*, 5 R. P. C. 271, 277; *S.C*, Griffin, L. O. C. 40; *Lake's Patent*, 6 R. P. C. 548.

(*b*) *Lorrain's Patents*, 5 R. P. C. 142; *Guest and Barrow's Patent*, 5 R. P. C. 315.

(*c*) *Hoskin's Patent*, Griffin P. C. 292; *Newman's Patent* (No. 2), 5 R. P. C. 280.

(*d*) *Stell's Patent*, 8 R. P. C. 235.

(*e*) See *Lorrain's Patents*, 5 R. P. C. 142.

(*f*) *Ibid.*

(*g*) *Anderson and McKinnell's Patent*, Griffin, L. O. C. 23.

(*h*) *Lorrain's Patents*, *ubi supra.*

(*i*) *Newman's Patent* (No. 2), 5 R. P. C. 279, 281.

indicating that the applicant's claims might be construed so as to include something covered by the prior patent, and this might under the circumstances prejudice the applicant, the law officer disallowed the disclaimer and directed the insertion in the specification of a simple reference to the fact that the prior patent covered a similar type of machine (*k*). Sect. 11 (1). NOTE.

A prior patentee is not, because he has made a broad claim, entitled to have limiting words inserted in the applicant's specification, unless he can show upon the fair view of the evidence that such words are really necessary to protect him (*l*), and the onus of proving such necessity is on the prior patentee (*m*).

The law officer has nothing to do with the question of infringement in deciding on the propriety or impropriety of inserting a disclaiming clause (*n*).

Although the comptroller may be of opinion that the invention embodied in the particular construction of the apparatus described in the applicant's specification has not been patented by the opponent, he may nevertheless require the insertion of a clause disclaiming the principle underlying this construction (*o*). And if an applicant by his specification discloses a new element and then proceeds to use that in an old way without indicating any invention in the mode of use, he may be compelled, on the opposition of a person interested in a patent for the old way, to strike out from the specification a claim for the use (*p*). But the comptroller has no authority to strike out a claim because it invites people to infringe, or because it claims more than the patentee is entitled to (*q*).

Where in a specification for an invention of smokeless gunpowder the applicant stated his discovery to be a mixture of the soluble and insoluble varieties of nitrated cotton with nitro-glycerine, and it was not clear that the words of the claim would not be satisfied by the use of one variety alone, and the specification of a prior patent claimed for a like purpose the combination of the insoluble variety with nitro-glycerine with or without the soluble variety, it was held that the claim must be modified or a disclaiming clause added (*r*).

When prior specification ought to be

The question often arises whether the disclaiming clause should refer to the prior specification by name and number. Such a mode of

(*k*) *Van Gelder's Patent*, 9 R.P.C. 325.

(*l*) *Guest and Barrow's Patent*, 5 R. P. C. 312, 315; *Newman's Patent* (No. 2), 5 R. P. C. 279, 281; *Adam's Application*, 13 R. P. C. 548.

(*m*) *Stell's Patent*, 8 R. P. C 235.

(*n*) *Stell's Patent*, 8 R. P. C. 235

(*o*) *C. K. Welch's Patent*, 8 R.P.C. 443.

(*p*) *Webster's Patent*, 6 R. P. C. 165.

(*q*) *Webster's Patent*, *ubi supra*.

(*r*) *Curtis and André's Application*, 9 R. P. C. 495.

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NOTE.

referred to by name and number.

reference has been said to be undesirable (*s*), and was refused where the applicant had, in compliance with the decision of the comptroller, inserted a disclaimer of certain specific parts of his description, which sufficiently covered the matter alleged to have been infringed by the applicant's specification (*t*). And it has been held that a prior patentee, opposing the grant of a patent under this sub-section, has no right to be specially named in a disclaiming clause in the applicant's specification, unless the applicant is willing to name him, and unless it is clear there is no other prior publication than the specification of the opponent (*u*).

A special reference to a particular prior patent ought not to be inserted unless there is, practically speaking, no question that the earlier patent is what may be called a "master patent" (*x*), or unless it is practically admitted by the applicant that the governing principle was for the first time discovered or disclosed in the opponent's specification (*y*). And to be entitled to such a disclaiming clause the opponent must show that the description in the applicant's specification in terms includes and purports to claim a part of the invention described in the prior specification (*z*).

And speaking generally, a special reference to a prior patent ought not to be directed unless the law officer or the comptroller comes to the conclusion that without such a reference the patent ought not to be sealed at all (*a*).

If the applicant's and opponent's patents are practically concurrent, a disclaiming reference will not be inserted except by mutual consent (*b*).

Other specifications besides those of the opponent's may be referred to for the purpose of showing that the opponent's patent is not a master patent (*c*).

A disclaiming reference to a prior patent as being the master patent may be inserted, even though under a decision of the Court of Appeal this could no longer be so considered, the time for appealing to the House of Lords against the decision of the Court of Appeal not having expired (*d*).

(*s*) *Per* Sir E. CLARKE, Sol.-Gen., *Anderson and McKinnell's Patent*, Griffin, L. O. C. 25; *Wallace's Patent*, 6 R. P. C. 134.

(*t*) *Cooper and Ford's Patent*, Griffin, P. C. 275.

(*u*) *Guest and Barrow's Patent*, 5 R. P. C. 312, 315; *Teague's Patent*, Griffin, P. C. 298; *Brownhill's Patent*, 6 R. P. C. 135.

(*x*) *Hill's Application*, 5 R. P. C. 601.

(*y*) *C. K. Welch's Patent*, 8 R. P. C. 443.

(*z*) *Hill's Application*, *ubi supra*.

(*a*) *Marsden's Patent*, 13 R. P. C. 87; *Marsden's Patent* (No. 2), 14 R. P. C. 174.

(*b*) *Gaunt's and Greenhalgh's Applications*, 14 R. P. C. 387.

(*c*) *C. K. Welch's Patent*, 8 R. P. C. 413.

(*d*) *Hoffman's Patent*, 7 R. P. C. 92.

Where the applicant had in his specification described but not claimed certain parts, which were described in the specification of a previous patent granted to the opponent, the patent was only sealed upon the terms that the applicant should, at his option, specifically, and by reference to number and date of the prior specification, disclaim the parts therein described or omit from his specification the description of those parts (*e*). Sect. 11 (1). NOTE.

And where the applicant's specification claimed his invention in general terms, but it was in fact only an improvement on the invention comprised in the opponent's previous patent, the law officer required a disclaimer to be inserted in the applicant's specification referring specifically by name and number to the prior patent, and stating explicitly that the applicant only claimed his invention as an improvement (*f*).

And where a provisional specification includes an invention which is within a prior specification of the opponent's, it seems that the latter may require the applicant to insert in his complete specification a formal disclaimer of the prior invention (*g*).

Where the previous patent is referred to by name in a disclaiming clause inserted in the applicant's specification, it would seem that the latter ought not to refer to or point out defects in the prior patented invention, though it is otherwise if the earlier invention is only mentioned in general terms (*h*). And the applicant ought not to put his own construction on the particular specification referred to. He may give his own statement of the prior knowledge, and say that he refers in support to the prior specification (*i*). Disclaiming clause not to point out defects in or put construction on prior specification.

Where in the specification of a former patent granted to the applicant there had been a reference by name and number to a previous patent of the opponent, and in the specification of the applicant's proposed new patent his former specification was referred to, it was held that the protecting reference must be repeated in the specification of the new patent (*k*).

Where the prior patent is referred to, the disclaiming clause should not merely disclaim the mechanism *described* in the previous specification, but should disclaim the mechanism therein *described and claimed* (*l*). Form of disclaiming reference.

(*e*) *Teague's Patent*, Griffin P. C. 298. See also *Newman's Patent*, 5 R. P. C. 271 ; *S. C.*, Griffin, L. O. C. 40 ; *Adam's Application*, 13 R. P. C. 548.

(*f*) *Hoskins' Patent*, Griffin, P.C. 291 ; *Newman's Patent* (No. 2), 5 R. P. C. 279; *Welch's Patent*, Griffin, P. C. 300. *Thornborough and Wilks' Patent*, 13 R. P. C. 115.

(*g*) *Hookham's Application*, Griffin, L. O. C. 32.

(*h*) *Guest and Barrow's Patent*, 6 R. P. C. 313, 316.

(*i*) *Atherton's Patent*, 6 R. P. C. 547. And see *Van Gelder's Patent*, 9 R. P. C. 325.

(*k*) *Wallace's Patent*, 6 R. P. C. 134.

(*l*) *Gozney's Application*, 5 R. P. C. 597.

Sect. 11 (1). NOTE.

Forms of reference to prior patents will be found in *Hoskins' Patent* (*m*), *Newman's Patent* (*n*), *Welch's Patent* (*o*), *Airey's Application* (*p*), *Lynde's Patent* (*q*), and *Wallace's Patent* (*r*).

An appeal lies to the law officer against the comptroller's decision refusing to require a reference to a prior specification, even though the appellants do not appeal against the allowance of the patent (*s*).

Amendment not always allowed at hearing.

Where the applicant's invention is similar to an invention comprised in a prior patent he may be allowed, at the hearing of the opposition, to amend his specification by inserting words more clearly defining his own invention (*t*). But this is not a matter of course (*u*). And where the applicant's specification made a claim manifestly the subject of previous patents, he was not allowed to amend so as to limit his claim to the improvement which was alleged to be the real subject of the invention, and the patent was refused (*x*).

Where a particular construction of the complete specification, limiting the invention to something not within the opponent's patent, was agreed upon by the applicant and opponent before the law officer, the patent was allowed, the agreed construction being placed upon record (*y*).

Where the parties had come to an arrangement before the comptroller as to the form of the disclaiming clause, and the applicants not having adhered to this arrangement, the opponent appealed to the law officer against the clause as inserted by the applicants, but was unsuccessful, the law officer, in the absence of explanation from the applicants as to their departing from the arrangement, dismissed the appeal without costs (*z*).

It is no ground for granting a patent which will comprise matter described and claimed in the specification of a prior patent that this matter was not included in the provisional specification of the prior patent (*a*).

If there is a prior patent for the invention it is sufficient ground for opposition, whether it has expired or not (*b*), and a reference to the expired patent by name and number may be required (*c*).

(*m*) Griffin, P. C. 292.
(*n*) 5 R. P. C. 281.
(*o*) Griffin, P. C. 302.
(*p*) 5 R. P. C. 350.
(*q*) 5 R. P. C. 663.
(*r*) 6 R. P. C. 134.
(*s*) *Brownhill's Patent*, 6 R. P. C. 135.
(*t*) *Fletcher's Application*, Griffin, L. O. C. 30.
(*u*) *Whittaker's Application*, 13 R. P. C. 580.
(*x*) *Lupton and Place's Application*, 14 R. P. C. 261.
(*y*) *Anderton's Patent*, Griffin, L. O. C. 25.
(*z*) *Guest and Barrow's Patent*, 5 R. P. C. 312, 316.
(*a*) *Green's Patent*, Griffin, P. C. 286.
(*b*) *Lancaster's Patent*, Griffin, P. C. 293; *Glossop's Patent*, Griffin, P. C. 285; *Stewart's Application*, 13 R. P. C. 627.
(*c*) *Hall and Hall's Patent*, 5 R. P. C. 283.

Sect. 11 (1). Note.

The only persons who can oppose, under this part of the section, are those who have made an application in the United Kingdom of prior date to the applicant's patent. And, therefore, although two foreigners, who had patented an invention in France, and had applied in England for a patent subsequently to an Englishman's application for a patent for the same invention, were held entitled (under s. 103, *post*) to have an English patent granted to them as of the date of their French application, they were not allowed to oppose the grant of the patent to the Englishman (*d*).

Foreigners having patents ante-dated under s. 103 cannot oppose later patent.

The state of knowledge prior to and at the date of the opponent's patent is material on the question of what is the opponent's invention, and for this purpose prior specifications may be admitted in evidence (*e*). And where in his specification a patentee refers to an earlier specification of his own, he is entitled to have the two specifications read together (*f*).

On an opposition the law officer may take into consideration the question of mechanical equivalents (*g*).

(iii.) **"That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification."**

This ground of opposition is introduced by the amending Act of 1888. Under the Act of 1883 there was no jurisdiction to stop a patent at the instigation of an opponent, merely on the ground of disconformity between the complete and provisional specification (*h*).

In this respect there is no alteration in the practice. The objection of disconformity cannot be taken by itself (*i*). It is, however, now made available when it concurs with the fact that the invention which gives rise to it is the subject of an application made by the opponent under the particular circumstances mentioned in the new sub-section. As to the question of disconformity, see *ante*, p. 32.

The sub-section does not refer to a mere development of the invention comprised in the provisional specification, and a fair development may

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(*d*) *Everitt's Patent*, *No.* 10,680 *of* 1886, Griffin, L. O. C. 28.

(*e*) *Jones' Patent*, Griffin, L. O. C. 34. See also observations of Lord CAIRNS, C., *Clark* v. *Adie* (No. 2), 2 App. Cas. 431.

(*f*) *Parkes* v. *Stevens*, L. R. 8 Eq. 358, 366.

(*g*) *Haythornthwaite's Application*, 7 R. P. C. 70; *A. H. Smith's Patent*, 13 R. P. C. 200; *Whittaker's Application*, 13 R. P. C. 580.

(*h*) *Newman's Application*, Griffin, L. O. C. 40; *S. C.*, 5 R. P. C. 271.

(*i*) *Haythornthwaite's Application*, 7 R. P. C. 70.

Sect. 11 (1). still be made by the applicant in the interval between the leaving of the provisional and complete specifications (*k*).

NOTE.

The duty of the law officer is to ascertain what is the real and proper construction of the language of the provisional specification, and not to allow the applicant to construe his provisional specification as meaning something which he did not mean. And therefore where the law officer was not satisfied that the applicant at the date of his application contemplated the arrangement which he contended was in his provisional specification the applicant was allowed to produce evidence on the point subject to cross-examination (*l*).

"And that such other invention forms the subject of an application," etc.—Under the Act of 1852, where two parties applied for a patent, and each opposed the other on the ground that he alone was the inventor, and the evidence on this point was conflicting, the patent of the first applicant was sealed (*m*).

Where there were concurrent applications for the same invention, and the first application having been delayed, the second applicant was in a position to seal his patent first, Lord ELDON, C., held that the applicant who first obtained the Great Seal was to be preferred, and said, "I can see no other mode of deciding than by awarding the patent to him who runs the quickest through the process" (*n*). And this rule was subsequently recognized by Lord CRANWORTH (*o*).

As to applications on the same day in respect of the same invention, see *In re Dering's Patent* (*p*), *post*, p. 63.

SUB-SECTION (2).

The comptroller may in certain cases refuse to seal a patent unless the specification be previously amended. Thus, if the provisional specification contains any reasonably direct indication of the actual improvement which it is ultimately desired to protect by the patent, then any amendment which will put the particular description of the invention absolutely beyond doubt is within the comptroller's power (*q*).

And on a cross opposition the comptroller, if satisfied that part of the invention is the sole invention of one of the applicants, has required

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(*k*) *Edwards' Patent*, 11 R. P. C. 461.

(*l*) *Birt's Application*, 9 R. P. C. 489.

(*m*) *Re Lowe's Patent*, 25 L.J.Ch. (N.S.) 454.

(*n*) *Ex parte Dyer*, Hindmarch on Patents, p. 535.

(*o*) *Re Simpson and Isaac's Patent*, 21 L. T. 81.

(*p*) 13 Ch. D. 393.

(*q*) *Chandler's Patent*, Griffin, P. C. 270, 274.

the other applicant, as a condition of obtaining the grant, to amend his specification so as to confine it to the part actually invented by him (*r*). Sect. 11 (2).

But the comptroller cannot require the claim to be amended merely to make it conform to the description of the invention contained in the specification, provided the claim is a real statement of the invention claimed, and not a mere colourable compliance with the statute (*s*). NOTE.

Under the old practice it was the duty of the law officer to hear and determine which of two rival applicants was entitled to a patent, and the question was not to be remitted to the Lord Chancellor by directing warrants upon both patents (*t*). Law officer was bound to decide between rival applicants.

But in a case under the present Act, where the grant of a patent to the applicant was opposed on the ground that he had obtained the invention from the opponent, and the evidence was conflicting, and the comptroller not being able to have the declarants cross-examined was unable to decide which side was speaking the truth, the patent was sealed in order that the matter might go before the law officer, and the witnesses be examined *viva voce* and cross-examined (*u*). And in a similar case the comptroller, at the request of the parties, allowed the patent to be sealed without prejudice to the opponent's appeal to the law officer (*x*).

Where the opponent did not appear, and the comptroller heard the case and decided in favour of the applicant, and the opponent subsequently explained that he had not received notice of the appointment for hearing, and asked to be heard, the comptroller refused to re-open the case; but on the suggestion of the comptroller the opponent appealed with a view to the case being sent back to the comptroller for rehearing, and this course was adopted by the law officer (*y*).

On an opposition before the comptroller the applicant begins.

But in a case of opposition on the ground of fraud, the law officer directed the evidence of the opponent to be taken first, the *onus probandi* being on him (*z*).

As to the evidence before the law officer, see *post*, p. 76, under s. 18 (4).

SUB-SECTION (3).

"Entitled to be heard in opposition."—The only class of persons who are entitled to be heard in opposition before the law officer are Only persons having an

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(*r*) *Paterson's Patent*, Griffin, P. C. 297. See also *Craig and Macfarlane's Application*, Johnson, Pat. Man., p. 165.

(*s*) *Smith's Patent*, Griffin, P. C. 263.

(*t*) *Ex parte Henry*, L. R. 8 Ch. 167.

(*u*) *Hatfield's Patent*, Griffin, P. C. 288. See also *Liddell's Patent*, Johnson, Pat. Man., p. 161, a case under the old practice.

(*x*) *Luke's Patent*, Griffin, P.C. 294.

(*y*) *Warman's Application*, Griffin, L. O. C. 43.

(*z*) *Luke's Patent*, Griffin, P.C. 294.

Sect. 11 (3). persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it (*a*).

NOTE.

interest in the prior patent can oppose.

On this ground the agent of the patentee, under a prior patent, was not allowed to oppose, and leave to amend the notice of opposition by substituting the name of the patentee for that of the agent was refused (*b*).

Where, however, the agent who had signed the notice of opposition died before the hearing, the comptroller allowed the notice of opposition to be amended by inserting the name of the actual opponent, and allowed, upon payment of costs, an adjournment for this purpose (*c*).

It has been also held that prior patentees had a right to oppose on the ground of their own patent, but not on the ground of a patent in which they had no interest (*d*).

A person, however, who is entitled to appear and oppose may rely upon prior specifications other than the particular specification in which he is interested (*e*).

Opposition on expired patent.

The assignee of a prior patent which has lapsed, who has worked the invention under that patent, is entitled to be heard in opposition to the grant of a new patent for what is alleged to be the same invention (*f*). But a person who has merely manufactured under an expired patent, having no interest in it (*g*), or a person who merely alleges that he is about to work the invention, and that it is included in expired patents (*h*), has no right to oppose.

The law officer has no wider jurisdiction than the comptroller in opposition cases, and the words "being in the opinion of the law officer entitled to be heard in opposition to the grant," refer back to the persons allowed to oppose under sub-s. (1) (*i*).

The objection as to *locus standi* can therefore, it seems, be taken before the comptroller as well as the law officer. If, on the opposition before the comptroller of a person whom the law officer afterwards on an appeal by the applicant holds to have no *locus standi*,

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(*a*) *Per* CLARKE, Sol.-Gen., *Heath and Frost's Patent*, Griffin, P. C. 290. See also *Glossop's Patent*, Griffin, P. C. 285; *Hookham's Patent*, Griffin, L. O. C. 32; *Hill's Application*, 5 R. P. C. 599 (a case of licenses).

(*b*) *Heath and Frost's Patent*, *ubi supra*.

(*c*) *Lake's Application*, Griffin, L. O. C. 35.

(*d*) *Hookham's Patent*, Griffin, L. O. C. 32.

(*e*) *Stewart's Application*, 13 R. P. C. 627.

(*f*) *Glossop's Patent*, Griffin, P. C. 285.

(*g*) *MacEvoy's Patent*, 5 R. P. C. 285.

(*h*) *Bairstow's Patent*, 5 R. P. C. 286.

(*i*) *Stewart's Application*, 13 R. P. C. 627.

Sect. 11 (3)

NOTE.

the comptroller orders an amendment of the specification, the law officer must still be satisfied that the comptroller's decision is wrong before he interferes with it (*k*).

When the comptroller has allowed the patent, the law officer ought not to interfere with the decision unless it is clearly wrong (*l*).

And therefore where in a difficult chemical case the comptroller had come to a conclusion in favour of the applicant as the result of conflicting chemical evidence, the law officer, having come to the same conclusion on the declarations as the comptroller, declined to hear *viva voce* evidence, and dismissed the appeal with costs (*m*).

Where the applicant who had succeeded before the comptroller did not appear at the hearing of an appeal by the opponent, the law officer allowed the opponent to explain the mechanism, and reserved his decision; and the applicant having subsequently applied *ex parte* to be heard, and having accounted satisfactorily for his previous non-attendance, the law officer directed him to pay the opponent's costs of the adjournment, and upon this being done another hearing was fixed (*n*).

Where the opponent had applied for a patent, but his application had not reached the opposition stage, and it was agreed that if the opponent withdrew his opposition the applicant would not oppose the other application, the law officer, without sanctioning the terms, adjourned the hearing in order to enable the arrangement to be carried out, and stated that in sealing the applicant's patent it was to be understood that he did not decide in his favour (*o*).

The appeal to the law officer is a rehearing (*p*).

Models which are not made exhibits are not evidence, but may be used by the law officer to enable him to understand the drawings and specifications (*q*).

SUB-SECTION (4).

"May . . . . obtain the assistance of an expert."—Where there was a strongly controverted question of scientific anticipation, such that the law officer, even if advised by an expert, would refuse to stop the patent, but could leave the question to be discussed elsewhere, the law officer refused to act under this sub-section (r).

(*k*) *Heath and Frost's Patent*, Griffin, P. C. 290.

(*l*) *Glossop's Patent*, Griffin, P. C. 286.

(*m*) *Pitt's Patent*, 5 R. P. C. 343.

(*n*) *Ainsworth's Patent*, Griffin, P. C. 269.

(*o*) *Hatfield's Patent*, Griffin, P. C. 288; and see *Re Gething*, L. R. 9 Ch. 633.

(*p*) *Stubb's Patent*, Griffin, P. C. 298. See however, *Bairstow's Patent*, 5 R. P. C. 286; *Hill's Application*, 5 R. P. C. 599.

(*q*) *Lancaster's Patent*, Griffin, P. C. 294. And see *Boyd* v. *Horrocks*, 6 R. P. C. 152, 154.

(*r*) *Lake's Patent*, 6 R. P. C. 548.

Sect. 12 (1). Sealing of patent.

12.—(1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases herein-after mentioned, that is to say—

(a.) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b.) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

"As if it were sealed with the Great Seal of the United Kingdom."—That is, it will prove itself and cannot be denied (*s*).

"Fifteen months."—By s. 3 of the Act of 1885 (*post*), the term may now be extended four months.

Under s. 20 of the Act of 1852 it was held that when the delay was caused by opposition, the patent might be sealed, even though the hearing took place after the expiration of the provisional protection, and the additional month allowed by s. 6 of the Act of 1853 (*t*).

On the analogy of this case it would seem that under similar circumstances the patent may be sealed though the hearing does not take place till after the fifteen months.

Sub-s. (3)(b) is a re-enactment with modifications of s. 21 of the Act of 1852.

"Where the sealing is delayed," etc.—Under special circumstances, and when a complete specification had been filed with the application, the patent was sealed, although the applicant had not filed his declaration

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(*s*) Hindmarch on Patents, pp. 37, 264, 438.

(*t*) *Re Johnson's Patent*, 13 Ch. D. 398, n.; *Re Somerset and Walker's Patent*, *Ibid.* 397.

in reply till nearly eight months after the last extension of time given to him for that purpose (*u*). Sect. 12.

NOTE.

"**Delayed.**"—*Delay in complying with the requisition of the* comptroller requiring the insertion of a disclaimer in the specification is not delay caused "by opposition to the grant of a patent" within this sub-section (*x*).

13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application. Date of patent.

"**Dated and sealed as of the day of the application.**"—This provision was introduced by this Act. Under the Act of 1852, s. 23, the Lord Chancellor or the law officer had a limited discretion as to the date of the patent. And under this section it was sometimes made a condition of sealing the patent that it should bear a particular date (*y*).

But where, in a case of rival applicants, the law officer had granted a patent to the first applicant on condition that it bore date after the patent granted to the second applicant, it was held in a subsequent action between the two patentees that the Court was not bound by this condition, and could, as against the patentee, under the first dated patent, go into the question whether, in fact, he or the patentee under the second dated patent were the first and true inventor (*z*).

The patent will, subject to the first proviso of the section, take effect as *from the day of application, whatever be the day when the seal is* actually affixed (*a*).

Where under the International Convention a patent is granted for any invention in respect of which a foreign application has been made, the patent is to be entered in the register of patents as dated of the date on which the first foreign application was made (*b*).

"**Provided that no proceedings,**" **etc.**—The result of this and the proviso at the end of s. 15, appears to be that until the patent is actually

(*u*) *Kitson's Patent*, 7 R. P. C. 388.
(*x*) *A. and B.'s Application*, 13 R. P. C. 63.
(*y*) *In re Johnson's Patent*, 13 Ch. D. 398, n.; *Ex parte Bailey*, L. R. 8 Ch. 60; *In re Harrison*, L. R. 9 Ch. 631.
(*z*) *Kurtz* v. *Spence*, 5 R. P. C. 161, 178.
(*a*) See *Saxby* v. *Hennett*, L. R. 8 Ex. 210; *Holste* v. *Robertson*, 4 Ch. D. 9.
(*b*) P. R. r. 29, *post*.

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granted, no proceedings for infringement can be instituted at all, nor even then in respect of infringements committed before the publication of the complete specification (see s. 10), but that in an action brought after the grant of the patent, relief may be had in respect of infringements committed between the date of the publication of the complete specification and the time of the grant, as well as in respect of infringements after the grant.

Rival applications at different dates for same invention.

"Provided also that in case," etc.—Certain expressions in the judgment of Lord HATHERLEY, C., in *Ex parte Bates and Redgate* (*c*), and of Lord SELBORNE, C., in commenting on that case in *Ex parte Bailey* (*d*) and *Ex parte Henry* (*e*), appear to throw doubt on the power of the Crown, in the case of rival applications on different dates for patents for the same invention, to seal both patents. On the other hand, in *Saxby* v. *Hennett* (*f*), KELLY, C.B., said that in such case of the competency of the Crown to seal both patents there could be no doubt, and this appears also to have been the view of Lord CAIRNS, C., in *Re Dering's Patent* (*g*). The doubt is now removed as to the case mentioned in this proviso. But the proviso is only permissive and not obligatory, and it is therefore necessary to consider what was the old practice on this point.

Rule in *Ex parte Bates and Redgate.*

It was at one time considered that under the Act of 1852 the provisional specification secured the invention for six months, and that the letters patent would be dated as of the date of the provisional specification; and the ordinary practice was to wait until the expiration of four months (*h*) before giving notice of intention to proceed with the patent, and then to wait two months more before obtaining the Great Seal (*i*).

But in *Ex parte Bates and Redgate* (*k*) it was held by Lord HATHERLEY, C., that leaving a provisional specification and obtaining provisional protection did not prevent a second applicant from leaving a provisional specification of a similar invention, and obtaining valid letters patent for his invention before the expiration of the first provisional protection, and that in such a case letters patent would not be granted to the first applicant for any part of his invention which was covered by the letters patent already obtained by the second applicant.

The ground of this decision was that a person could not, by filing a provisional specification only, not choosing to file a complete

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(*c*) L. R. 4 Ch. 580.
(*d*) L. R. 8 Ch. 63.
(*e*) L. R. 8 Ch. 169.
(*f*) L. R. 8 Ex. 213.
(*g*) 13 Ch. D. 395.
(*h*) The period allowed by the Rules of December 12th, 1853.
(*i*) *Lee* v. *Walker*, L. R. 7 C. P. 121, 126. Judgment of BRETT, J.
(*k*) L. R. 4 Ch. 577.

specification, obtain anything more than a right to be protected against the consequences of his own publication, and did not obtain a right to priority over any other person who had independently and originally hit upon the same idea, and, in anticipation of the other, first gave the world the benefit of it (*l*). Sect. 13 NOTE.

In *Ex parte Manceaux* (*m*), Lord HATHERLEY, C., again acted on this principle, and refused to seal the patent of a first applicant when the law officer had reported that part of the invention for which the patent was sought was comprised in a patent which had, before the expiration of the first applicant's provisional protection, been granted to a second applicant. His lordship pointed out the inconvenience of granting two patents for the same invention arising from the fact that the question is not between the patentees only, but affects the public, who will be at a loss to know with whom to deal. In this last case the circumstances that the invention had been previously published abroad, so that neither of the parties was in the position of an original inventor, and that there was no case of fraud, nor was the first patentee a servant of the applicant, were considered as bearing on the question of affixing the Seal.

In *Ex parte Scott and Young* (*n*), however, a case where servants had filed a provisional specification, after which the master filed a provisional specification of a similar invention, and before the servants had obtained their patent, filed a complete specification, and had his patent sealed, and the evidence disclosed grounds for serious suspicion that the master had derived his knowledge from the servants, the same learned judge held that *Ex parte Bates and Redgate* did not apply, and ordered the servants' patent to be sealed and dated as of the date of their provisional specification.

But in *Ex parte Bailey* (*o*) Lord SELBORNE, C., treated the case of *Ex parte Bates and Redgate* as laying down the rule that if an application to seal a patent is made after the sealing of another, care shall be taken that the new patent does not cover the ground which is covered by the earlier patent, and when a second applicant had first obtained the Great Seal, refused to ante-date the patent of the first applicant, and ordered it to be dated as of the day of his application for the Seal, and this notwithstanding the conduct of the first applicant was alleged to be fraudulent.

Where, however, rival applicants had applied on the same day for patents for inventions alleged to be identical, and had afterwards Rival applications on same day.

(*l*) *Per* Lord HATHERLEY, C., *Ex parte Scott and Young*, L. R. 6 Ch. 274.

(*m*) L. R. 6 Ch. 274. See also *Ex parte Yates*, L. R. 5 Ch. 1; *Re Stoll's Patent*, 21 L. T. 233.

(*n*) L. R. 6 Ch. 274.

(*o*) L. R. 8 Ch. 60.

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mutually agreed to withdraw opposition, and one of the applicants having obtained his patent, opposed the other at the Great Seal, and stated that the agreement only extended to proceedings before the law officer, Lord CAIRNS, C., being of opinion that the parties had agreed to withdraw opposition at all stages, treated both patents as having been unopposed, and sealed the second patent, dating it also the day of application (*p*).

And in similar circumstances, where, however, there had been no mutual agreement, the same learned judge sealed both patents as of the day of the date of their respective applications; and after holding that the case was distinguishable from *Ex parte Bates and Redgate*, thus stated his objection to that case: "It has always seemed to me that if Parliament held out to inventors the advantage they should get from provisional protection, the inventor should have the enjoyment of that advantage for the six months given to him. Parliament intended the six months to be for the completion of the invention, and for the perfecting the specification, and never said that the applicant should be deprived of that advantage by want of any due diligence on his part." And again: "*Primâ facie* the Crown ought to seal both patents. The contract with each of them on provisional protection was that he should have six months' protection. Now, if it is true that both have acted in good faith, what right have I to confiscate the invention of one, because it happens to be identical with the invention of the other? . . . . Why should they not have become joint proprietors of this invention by agreement between themselves? I cannot see any reason why they should not, and if so, why cannot they in effect be made co-proprietors by the grant of separate letters patent?" (*q*).

Effect of the rule in *Ex parte Bates and Redgate*.

After the decision in *Ex parte Bates and Redgate* it was necessary to get a patent sealed as soon as possible in order to prevent a rival inventor from stepping in and obtaining a patent, and in a case where a patent agent retained to obtain a patent for an applicant had, in ignorance of this decision, followed the old practice, and the result had been that a rival inventor had first obtained the Great Seal, and the applicant was refused a patent, the agent was held liable in an action for negligence (*r*).

Infringement when two patents for same invention.

If two patents have been sealed for the same invention, acts done by virtue of the patent dated last are infringements of the first-dated patent (*s*).

(*p*) *Re Gething*, L. R. 9 Ch. 633.

(*q*) *In re Dering's Patent*, 13 Ch. D. 393.

(*r*) *Lee* v. *Walker*, L. R. 7 C. P. 121.

(*s*) *Saxby* v. *Hennett*, L. R. 6 Ex. 210.

Provisional Protection. Sect. 14.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection. Provisional protection.

This provision is substantially the same as the corresponding provision in the Act of 1852, s. 8, except as to the time of duration of the provisional protection.

The effect of provisional protection was thus stated by Lord HATHERLEY, C. (*l*) (referring to the Act of 1852) :— Provisional protection.

"Under section 8," the patentee "may use his invention for six months (*u*) without prejudice to his patent by that user, but he obtains no rights against the public until his patent has been sealed, and even then the patent will not relate back to acts done in the interval. He is only protected against the consequences of his own publication, and thus may employ workmen and obtain machinery without the risk of being betrayed. But that is all, and he has no right or privilege against any other person."

When a provisional specification under the Act of 1852 was abandoned, and the applicant, before six months from the date of that provisional specification, lodged another provisional specification for the same invention, it was held that public user of the invention between the dates of the two provisional specifications did not invalidate a patent granted as of the date of the second provisional specification (*x*). Public user between abandonment of one provisional specification, and the lodging of another for same invention.

Protection by Complete Specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete Effect of acceptance of complete specification

(*l*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 578.

(*u*) Now, for the period between date of application and date of sealing.

(*x*) *Lister* v. *Norton*, 3 R.P.C. 199.

Sect. 15. specification : Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

The first clause of this section is a re-enactment with modifications of part of s. 9 of the Act of 1852, which authorized the filing of a complete specification with the petition for letters patent.

Under that section it was held that the principle of *Ex parte Bates and Redgate* could not be applied to enable an applicant who lodged a complete specification to acquire the rights of a patentee so as during the term of protection to prevent any other person who had previously applied for a patent for a similar invention from obtaining a patent (*y*).

Under the present section a person whose complete specification has been accepted is, for the purpose of opposition to a grant of patent, in the same position as a person who has already got a patent upon which he can oppose (*z*).

"Provided that an applicant," etc.—A re-enactment with modifications of the last clause of s. 24 of the Act of 1852. See note under s. 13, *ante*.

Patent.

Extent of patent.

16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

The Channel Islands, which under the Act of 1852, s. 18, were included in letters patent, are omitted from the patents granted under the present Act. See First Schedule, Form D.

Term of patent.

17.—(1.) The term limited in every patent for the duration thereof shall be fourteen years from its date.

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3.) If, nevertheless, in any case, by accident mistake or inadvertence, a patentee fails to make any prescribed payment

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(*y*) *Ex parte Henry*, L. R. 8 Ch. 167.

(*z*) *L'Oiseau and Pierrard's Patent*, Griffin, L. O. C. 36.

within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment (*a*). Sect. 17 (3).

(4.) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(a.) The time for making any payment shall not in any case be enlarged for more than three months.

(b.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

"The term limited," etc.—The term includes the day of the date, therefore the patent will expire at midnight of the 14th anniversary of the day before the date of the patent (*b*).

"Within the prescribed times."—See notes to s. 8 (1), and First Schedule, Patents Rules, *post*. Sub-ss. (3) and (4) were introduced by this Act.

Amendment of Specification.

18.—(1.) An applicant or a patentee may, from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same (*c*). Amendment of specification.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner (*d*), and at

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(*a*) P. R., *post*, rr. 49, 50, 51. By r. 51, the time for doing any act or taking any proceeding under the Rules may be enlarged, and by r. 16 irregularities in procedure may be corrected.

(*b*) *Russell* v. *Ledsam*, 14 M. & W. 574.

(*c*) P. R. *post*, rr. 52—59.

(*d*) P. R. r. 52.

Sect. 18 (2). any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment (*e*).

(3.) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer (*f*).

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opiniou of the law officer entitled to be heard in opposition to the request, and shali determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5.) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

(*e*) The notice is to state the grounds of opposition. P. R., r. 52, 53.

(*f*) The evidence is to be by declaration (*Ibid*, 55), and before the law officer witnesses may be cross-examined. L. O. R. *post*, r. ix.

(10.) *The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.* Sect. 18 (10)

By the Act of 1888, s. 5, *post*, the following is substituted for sub-s. (10) of this section.

"(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending."

SUB-SECTION (1).

"**An applicant.**"—If the patent has not been sealed, the proceedings under this section should be the only proceedings taken by any one asking for amendment within the section (*h*).

The section applies to the amendment of specifications after they have become public property. Any other amendment must be dealt with under ss. 7 and 9 (*i*). Therefore, where a complete specification was filed after a provisional, the full time allowed by the Act for so doing being taken by the applicant, and subsequently, and before acceptance of the complete specification by the Patent Office, the applicant applied to amend, it was held by the law officer that the proceedings under this section must be taken (*k*).

But if, before the complete specification has been accepted, the applicant desires to omit a part of his invention as covered by his original title, it is open to him to lodge a complete specification omitting the part desired to be left out, and open to the Patent Office, under the powers of ss. 7 and 9, to permit the original application and provisional to be amended by striking out the part which it is no longer desired to retain (*l*). Such an amendment, however, must be confined to excision only, and not to amendment or other explanation, and the excision must be such as does not extend the scope of the title (*m*).

Where s. 18 applies to any proposed amendment of the specification before the grant of the patent, it is immaterial whether the Patent Office has or has not signified its acceptance of the complete specification as lodged (*n*).

"**Or a patentee.**"—The word "patentee" means the person for the time being entitled to the benefit of a patent. (Section 46, *post*). An assignee of the whole patent may, therefore, apply to amend.

(*h*) *Gare's Patent*, 23 Ch. D. 105.
(*i*) *Jones' Patent*, Griffin, P. C. 313.
(*k*) *Jones' Patent, ubi supra.*
(*l*) *Dart's Patent*, Griffin, P. C. 308.
(*m*) *Dart's Patent, ubi supra.*
(*n*) *Jones' Patent*, Griffin, P.C. 313.

Sect. 18 (1).

NOTE.

Under the old law, the grantee of a patent could disclaim even after wholly (*o*) or partially assigning his interest (*p*), but now it would seem, in order to satisfy the definition in s. 46, the assignee, in such a case, must also be a party to the application to amend.

It has been held that the mortgagee of a patent ought, as the legal owner, to be a party to a petition by the beneficial owners for extension (*q*), and it would seem, in like manner, that the mortgagee should be a party to an application by the beneficial owner to amend.

By analogy to the above, it would appear that a mortgagee alone could not apply to amend without making the beneficial owner a party.

It requires a stronger case to amend a specification late in the life of a patent than when the application is made earlier (*r*).

"From time to time."—A second disclaimer might, under the old law, be entered after a portion of the specification had been previously disclaimed, and, under these words, this may still be done. Second disclaimers are, however, not to be encouraged if they can possibly be avoided (*s*); and, therefore, where the comptroller had allowed a second disclaimer, and his decision was affirmed on appeal, the law officer, instead of following the usual practice of awarding costs against the unsuccessful party, made no order as to costs (*t*).

Where an application to amend was refused by the comptroller, and there was no appeal from his decision, the law officer, not being satisfied that any sufficient reason existed why proceedings were not taken to question the comptroller's decision, refused to entertain an application two years later for substantially the same amendment (*u*).

Disclaimers under old law.

"Disclaimer, correction, or explanation."—The power to amend a specification or drawings by way of correction or explanation was first introduced by the present Act. The only amendment previously allowed, except in the case of clerical errors, was under the Act of 1835 (*x*), s. 1, which gave power to file, with the leave of the law officer, "a disclaimer of any part of the title of the invention or of the specification," or to enter with the like leave "a memorandum of any alteration in the said title or specification not being such disclaimer

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(*o*) *Wallington* v. *Dale*, 7 Ex. 888.

(*p*) *Spilsbury* v. *Clough*, 1 Webst. 255.

(*q*) *Church's Patents*, 3 R. P. C. 95, 100.

(*r*) *Johnson's Patents*, 13 R. P. C. 659, 663. See also *Beck and Justice's Patent*, Griffin, L. O. C. 10; *Morgan's Patent*, Griffin, L. O. C. 18; *Nordenfelt's Patent*, Griffin. L. O. C. 19, 20.

(*s*) *Haddan's Patent*, Griffin, L. O. C. 12.

(*t*) *Haddan's Patent*, *ubi supra*.

(*u*) *Arnold's Patent*, Griffin, L. O. C. 5.

(*x*) 5 & 6 Will. 4, c. 83.

or such alteration as should extend the exclusive right granted" by the letters patent.

NOTE.

Under this Act the only authority conferred on the patentee was "the power of rejecting" (*y*). The invention might be "reduced or diminished, but it must not be extended or enlarged" (*z*). But slight additions, required to render intelligible what remains after something had been cut out of the specification, were always admissible in a disclaimer (*a*): such, for instance, as the addition or transfer from a disclaimed part of the specification of the words "herein described" (*b*).

From the case of *Re Pullan's Patent* (*c*), it seems that drawings *omitted by inadvertence from, and which were not described in the* filed specification, could not be added to it afterwards; and it may be a question whether the words of the present section are wide enough to include such an amendment. But under the present section the comptroller may allow any amendment whether of the letterpress of the specification, or of the drawings, or by way of adding drawings, if drawings have not been appended in the first instance to the specification, necessary to define the disclaimer which it is desired to make (*d*).

New law

The function of an explanation under this section is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. It was not intended that he should put in subsequently-ascertained knowledge (*e*), or simply turn an insufficient into a sufficient description (*f*).

Therefore, where a patent was for improvement in nozzles for the escape of steam or gases under pressure, and the patentee proposed to amend his specification by adding a rider containing certain detailed measurements relating to gas engines, and there was no mention of gas engines in the original specifications, leave to add the rider was refused (*g*).

The defect in the specification which can be remedied by amendment is one which must be consistent with the patentee intending to fulfil the condition of the grant by properly describing his invention; and therefore, where in a specification of improvements in the manufacture of castings of wrought iron and steel, which consisted in adding aluminium to the molten metal, the patentee proposed to

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(*y*) *Per* LORD WESTBURY, C., in *Ralston* v. *Smith*, 11 H. L. C. 245.

(*z*) *Foxwell* v. *Bostock*, 4 D. F. J. 298, 306.

(*a*) *Per* LORD WESTBURY, C., *Ralston* v. *Smith*, 11 H. L. C. 245.

(*b*) *Thomas* v. *Welch*, L. R. 1 C. P. 192, 195.

(*c*) Reported Johnson, Pat. Man., p. 107.

(*d*) *Per* Sir E. CLARKE, Sol.-Gen., *Lang's Patent*, 7 R P. C. 469, 471.

(*e*) *Beck and Justice's Patent*, Griffin, L. O. C. 10.

(*f*) *Johnson's Patent*, 13 R. P. C. 659, 661.

(*g*) *Beck and Justice's Patent*, *ubi supra*.

Sect. 18 (1).

NOTE.

amend by stating certain proportions, and by adding statements as to the character of an alloy in which the aluminium might be introduced if not introduced pure, were not allowed (*h*).

And when a patentee has described and claimed an improved method apart from particular means he will not be allowed to re-write his specification by inserting all the particular means (*i*).

The fact that a complete specification has been left with the application for a patent will have weight with the law officer in considering whether he will allow an amendment based upon an allegation that the patentee desires his invention to be fully understood (*k*). So also the law officer will take into consideration the fact that the application is made late in the life of the patent when the object is to correct what is alleged to have been inserted in error at the time of filing the specification (*l*).

But where the claim without the context, and without reference to other parts of the specification, is ambiguous, it may be amended, so as to make clear what, upon the true construction of the claim, read with the context and drawings, appears to have been the real meaning of the patentee. Thus, where the claim was "the manufacture of the dents or teeth of cards from a continuous length of *hardened and tempered steel wire*, as set forth and indicated hereinbefore and in the accompanying drawings," and it appeared by the context and from the drawings that the construction intended by the patentee was steel wire hardened and tempered in the manner set forth, he was allowed to amend his claim, so as to read "the manufacture of the dents, etc., from a continuous length of steel wire *hardened and tempered in the manner substantially as* set forth, etc." (*m*).

And where the specification is capable of more than one construction, it is open to the applicant to satisfy the law officer, or the comptroller, on the face of the specification, that he desires to limit the claim to one or more constructions to which the specification is open (*n*).

And where there were in form three claims to separate parts in a specification, but looking at the three together and to the whole specification it was clear that the patentee had intended to claim the combination of the parts as amendments, striking out the three claims and

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(*h*) *Nordenfelt's Patent*, Griffin, L. O. C. 18.

(*i*) *Nairn's Patent*, 8 R. P. C. 444.

(*k*) *Nordenfelt's Patent*, Griffin, L. O. C. 18, 20.

(*l*) *Johnson's Patent*, 13 R. P. C. 659, 663. See also *Beck and Justice's Patent*, Griffin, L. O. C. 10; *Morgan's Patent*, Griffin, L. O. C. 17; *Nordenfelt's Patent*, Griffin, L. O. C. 18, 20.

(*m*) *Ashworth's Patent*, Griffin, L. O. C. 6. See also *Johnson's Patent*, 13 R. P. C. 659, 662.

(*n*) *Ryland's Patent*, 5 R. P. C. 668.

inserting a claim for the combination, is held to be a valid correction or explanation within the Act (*o*). Sect. 18 (1).

In the case of a patent coming from abroad, if the real inventor satisfies the comptroller or the law officer that there has been a mistake in writing out his description at the time, that is one of the matters which were intended to be dealt with by this section (*p*). NOTE.

An amendment which is in its language vague and indefinite will not be allowed (*q*).

Mere clerical errors in a specification could be corrected on application to the Master of the Rolls, as Keeper of the Records, on obtaining the consent of the law officer (*r*). See the cases collected in 1 Webst. p. 647, in a note to *Re Sharp's Patent*, and Hindmarch on Patents, c. viii. s. 3. Clerical errors.

In *Dixon's Patent* (*s*), where the errors were said to be material, the order for correction was only made on the undertaking of the petitioner not to sue any person in respect of infringements committed previously to the date of the order. But this undertaking was not required in the subsequent case of *Re Johnson's Patent* (*t*).

In the case of *Abel's Specification*, A.D. 1876, No. 2081, where it was proved on the trial of the action of *Otto* v. *Linford* (*u*), that the drawing filed with the specification contained draughtsman's errors, and that in the parts where these errors occurred the drawing was not in conformity with the description, but that a competent workman following the description could easily find out the errors and put them right; Sir George JESSEL, M.R., on the petition of the agents for the patentee praying that they might be permitted to substitute for the drawing filed with the specification a new drawing in which the errors were corrected, allowed the new drawing to be filed in addition to the original drawing. (6 Mar. 1883.)

In *Re Blamond's Patent* (*x*), an application to amend a clerical error was refused on the ground of delay.

The Master of the Rolls has always required evidence that the error is really "clerical," and for this purpose it has been usual to produce, where possible, the original draft of the specification, and to explain, as far as possible, the manner in which the mistake in the filed copy has

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(*o*) *Kelly* v. *Heathman*, 45 Ch. D. 256.

(*p*) *Per* Sir R. WEBSTER, Att.-Gen., *Johnson's Patent*, 13 R. P. C. 659, 662.

(*q*) *Parkinson and Another's* Patent, 13 R. P. C. 509, 514.

(*r*) *Johnson's Patent*, L. R. 5 Ch. D. 503; *Sharp's Patent*, 1 Webst. 641, and cases cited in the notes to that case.

(*s*) Eng. Rep. Jan. to Mar. 1881, xvi.

(*t*) Eng. Rep. Ap. to June, 1881, xiii.

(*u*) 46 L. T. (N.S.) 39; Goodeve's Abstract of Patent Cases, pp. 343 347.

(*x*) 3 L. T. (N.S.) 808.

Sect. 18 (1). arisen. In all cases notice of the correction was required to be given to the Commissioners of Patents (*y*).

NOTE. The above jurisdiction of the Master of the Rolls was not transferred to the High Court of Justice (*z*), and has not been affected by the present Act (*a*); and it would seem that recourse to it will still be necessary if the amendment of a clerical error would bring the specification within the mischief of sub-s. (8). Except in such a case a clerical error in a specification can be corrected under this section, or by the comptroller under s. 91 (a), and the P. R. r. 16, (see Second Schedule, Form P.).

The above-mentioned jurisdiction of the Master of the Rolls applies to specifications which are to be considered as records under his authority. So long as the specification is in the Patent Office and before the patent is sealed, the proceedings under s. 18 should be the only proceedings taken by any one asking for amendment within that section (*b*).

"Reasons for the same."—An amendment will not be disallowed merely because the reasons given for it are insufficient (*c*). The reasons form no part of the specification as amended (*d*).

A statement that the patentee desires the principle on which his invention is based to be fully understood, is not a proper reason for amendment. If the condition of the grant requiring the patentee properly to describe his invention has been fulfilled, no such amendment is required (*e*).

SUB-SECTION (2).

This and the following two sub-sections relate to opposed applications; unopposed cases are dealt with in sub-ss. (5), (6), and (7).

"Any person."—It is not stated in the sub-section whether the applicant for leave to amend can object before the comptroller, that the opposer is not a person entitled to be heard in opposition. But in *Bell's Patent* (*f*), the comptroller dealt with the question of interest in the opponent. And see *Stewart's Application*, cited *ante*, p. 58, on the corresponding words in s. 11 (3).

(*y*) *Re Dixon's Patent*; *Re Johnson's Patent*, *ubi supra*; see also *Sharp's Patent*, 1 Webst. 649.

(*z*) Jud. Act, 1873, s. 17 (6). And see *Re Morgan's Patent*, 24 W. R. 245.

(*a*) *Re Gare's Patent*, 26 Ch. D. 105.

(*b*) *Gare's Patent*, *ubi supra*.

(*c*) *Ashworth's Patent*, Griffin, L. O. C. 7.

(*d*) *Cannington* v. *Nuttall*, L.R.5 H. L. C. 205, 228.

(*e*) *Nordenfelt's Patent*, Griffin, L. O. C. 18, 21.

(*f*) Griffin, L. O. C. 11.

SUB-SECTION (3).

Sect. 18 (3).

NOTE.

"Hear and decide."—The comptroller has power to impose conditions in giving liberty to amend (*g*), and can impose such conditions as the law officer on appeal could impose (*h*).

When after notice of opposition to the grant of a patent, and before the opposition was heard, the applicant applied for leave to amend, which was opposed by the opponent of the grant, and the two oppositions came on for hearing together, the hearing of the opposition to the grant was postponed till after the decision on the amendment (*i*).

"Subject to an appeal," etc.—Under the Act of 1835 there was no appeal on the question of leave to file a disclaimer (*k*). Under this sub-section either party may appeal from the comptroller to the law officer. An appeal from the comptroller in unopposed cases is given by sub-s. (6). There is no provision, however, for any appeal from the law officer, and his decision, it would seem, is final.

Under the Act of 1835 the circumstance that the disclaimer had been suggested by the court before which an action had been tried, and that the law officer's decision was final, was considered by Sir R. BETHELL, in a case of difficulty, as being in favour of allowing the disclaimer (*l*).

SUB-SECTION (4).

Opposition.

The limitation of opposition in this sub-section was introduced by the present Act. See the Act of 1835, s. 1.

Where one of the grounds of opposition was that the specification if amended as proposed would make it the same invention as was described in the specifications of certain prior patents which had expired, and in which the opponent had no interest, it was held that they were not entitled to be heard with regard to those patents (*m*).

Law officers may examine witnesses.

The law officers may now examine witnesses on oath (see s. 38, *post*, and Law Officers' Rules, IX., X., *post*). For the practice under Rule IX., when it is desired to obtain an order for the attendance of declarants for cross-examination, see Griffin, P. C., p. 319.

Appeals to the law officer are re-hearings (*n*).

(*g*) *Hearson's Patent*, 1 R. P. C. 213, 214; Griffin, P. C. 309; *Andrew* v. *Crossley*, [1892] 1 Ch. 492, 497.

(*h*) *Pietschmann's Patent*, Griffin, P. C. 314.

(*i*) *Cochrane's Patent*, Griffin, P. C. 304.

(*k*) *Medlock's Patent*, Johnson, Pat. Man. p. 187. (4th ed).

(*l*) *Bateman and Moore's Disclaimer*, Macr. P. C. 116.

(*m*) *Bell's Patent*, Griffin, L. O. C. 10.

(*n*) *Stubb's Patent*, Griffin, P. C. 298.

Sect. 18 (4).

NOTE.

Evidence before law officer.

The evidence before the law officer is to be the same as that before the comptroller, and no further evidence is to be given save as to matters which have occurred or come to the knowledge of either party since the date of the decision appealed against, except with the leave of the law officer (*d*).

Where an application to amend, which included four amendments, was allowed by the comptroller with the exception of a part of one amendment, and this decision was accepted by the applicants, they were not, on an appeal by the opponent, allowed to introduce fresh evidence (*e*).

Where certain words in the title to a specification, the omission of which was not asked by the application to amend, were, on the opponent's objecting to their retention, struck out by the comptroller, the opponents were not allowed before the law officer to object to their omission as making the amendment different from what had been advertised (*f*).

A prior patentee may oppose the allowance of certain proposed amendments on the ground that they will have a prejudicial effect upon his rights under his patent (*g*).

A later patentee will not be allowed to state by way of amendment to his specification that an invention for which a prior patent exists has certain disadvantages (*h*). Nor will the later patentee be required to insert in his amendment any acknowledgment of a prior patent (*i*).

Doubtful cases.

It has been the rule in doubtful cases that the amendment should be allowed, since the decision of the law officer against the application is final, and the consequences may be very serious to the patentee: whereas, if the fiat is wrongly granted, the public have other remedies (*j*). But it may be a question whether since the decision in *Moser* v. *Marsden* (*k*) (see *post*, under sub.-s. (9)) this rule will continue to prevail (*l*).

Law officer may now give costs.

There was, under the Act of 1835, no power to give costs in disclaimer cases (*m*), but now, by s. 38, *post*, the law officer is empowered to order payment of costs.

Where the original specification was loosely framed and an amendment was opposed, the law officer, although allowing the amendment, refused to give any costs (*n*).

(*d*) L. O. R. r. viii. *post*.

(*e*) *Hampton and Facer's Patent*, Griffin, L. O. C. 13.

(*f*) *Cheesebrough's Patent*, Griffin, P. C. 303.

(*g*) *Hampton and Facer's Patent*, Griffin, L. O. C. 15.

(*h*) *Hampton and Facer's Patent*, Griffin, L. O. C. 15.

(*i*) *Ibid.*

(*j*) *Bateman and Moore's Disclaimer*, Macr. P. C. 116; *Lake's Patent*, Griffin, L. O. C. 16.

(*k*) 13 R. P. C. 24.

(*l*) See *per* FINLAY, Sol.-Gen., *Parkinson and Another's Patent*, 13 R. P. C. 509, 512.

(*m*) *Kynock* v. *National Small Arms Co. Limited*, 37 L. T. (N.S.) 31.

(*n*) *Ashworth's Patent*, Griffin L. O. C. 9.

Where after leave had been obtained under s. 19, in a pending action, the patentees applied to amend, and afterwards discontinued the action and made a fresh application to amend, and subsequently withdrew their first application, the comptroller, while allowing the amendment, refused to impose any condition as to payment of costs incurred by the opponents in respect of the first application (*o*).

Sect. 18 (4). — Note.

The comptroller has no power as to costs. It was at one time considered that, indirectly, the comptroller might give costs by making the payment of costs a condition of the allowance of the amendment (*p*); but in *Pietschmann's Patent* (*q*), it was held that the comptroller has no jurisdiction to impose such a condition.

Conditions limiting retrospective effect of amendment.

"Subject to what conditions, if any."—Under the Act of 1852, it was provided (s. 39) that no action should be brought on any letters patent in which a disclaimer had been filed in respect of any infringement prior to the disclaimer, without the leave of the law officer certified in his fiat. Under this section the law officers were accustomed to impose conditions as to the user by opponents of apparatus in use before the disclaimer. The above provision is not contained in the present Act, but is replaced by s. 20, *post*. It appears, however (see note to sub-s. (9), *post*, p. 85), that, subject to ss. 19 and 20, amendments will have a retrospective effect.

Conditions under old practice.

Under the old practice it was said by Sir A. E. COCKBURN, Att.-Gen., that the cases where the disclaimer should be made retrospective and give the patentee power to proceed against those who have infringed before the disclaimer was filed, are the exception and not the rule, and that it lies on the party applying for a certificate giving a disclaimer that retrospective power, to make out a case entitling him to that certificate (*r*).

The law officer has also imposed terms preventing a patentee from suing in respect of continued infringements by the use of certain specified machines actually in use before the disclaimer (*s*); and in one case this principle was extended so as to prohibit suits in respect of new infringements committed by particular persons by the continued use of a process employed by them at the date of the disclaimer (*t*).

(*o*) *Bell's Patent*, Griffin, L. O. C. 11.

(*p*) *Cadd's Patent*, Griffin, P. C. 305.

(*q*) Griffin, P. C. 314.

(*r*) *Per* Sir A. J. E. COCKBURN, Att.-Gen., *Lucas's Patent*, Macr. Pat. Cas. 234, 239.

(*s*) *Harrison's Patent*, Macr. Pat. Cas. 31; *Crabtree's Patent*, Eng. Rep. Jan. to March, 1881; *Westinghouse's Patent*, Griffin, P. C. 315; *Fox's Patent*. A.D. 1878, No. 3988 (Queen's printer's copy of disclaimer of Anglo-American Brush Electric Light Company).

(*t*) *Re Medlock's Patent*, Newton's "London Journal." vol. 22 (N.S.) p. 69. See, however, the earlier case of *Lucas's Patent*, cited above, where Sir A. E. COCKBURN, Att.-Gen., said he ought not to impose a condition that the opponent should have a licence to continue his manufacture.

Sect. 18 (4).

NOTE.

And in *Smith's Patent* (*u*), Sir A. E. COCKBURN, Att-Gen., said that the undertaking not to sue in respect of past infringements must be general enough to include not only those who appeared and opposed the allowance of the disclaimer, but every one. However, in the same case he refused to prohibit the patentee from suing in respect of infringement after the disclaimer committed by persons who had previously entered into contracts for the supply of the patented article, and who asked that their immunity from suit should extend up to the termination of those contracts.

Where the patent has been allowed to remain in its imperfect state for a long time, and manufacturers have embarked large capital in the trade, the law officer has imposed conditions for their protection (*x*).

Disclaimers sometimes retrospective.

There are some cases in which it is proper that a disclaimer should be retrospective.

"It is not right that a person should gain his information from a patentee, and, acting on that information, copy and use his invention. He must not presume upon some defect in the specification and infringe upon the valuable part of the patent" (*y*). And where this appeared to have been done, and the opponent had worked in secret, and had otherwise acted unfairly, the Attorney-General considered it right that the opponent should pay for his past infringement, and imposed on him the payment of a definite sum as a condition of the patentee not being allowed to bring an action for infringements prior to the disclaimer (*z*).

Where the law officer imposed as a condition that actions should not be brought in respect of certain specified apparatus of railway brakes, the opponents were ordered to file statements of the locomotives and vehicles fitted with the protected apparatus, with numbers and other distinguishing marks, and to give notice from time to time of any change in the apparatus so fitted (*a*).

Sometimes the condition extended to permit the use of machines made under specified contracts (*b*). And the instruments allowed to be used have been ordered to be marked with identifying marks (*c*).

The method of identifying the protected machines will of course vary in each particular case. The parties should agree upon a form applicable to the special business, and submit it to the comptroller rather than leave the language to be settled by him (*d*).

(*u*) Macr. Pat. Cas. 232, 234.

(*x*) *Tranter's Patent*, *Jones's Patent*, reported in Johnson, Pat. Man. 181.

(*y*) *Per* COCKBURN, Att.-Gen., *Lucas's Patent*, Macr. P. C. 238.

(*z*) *Lucas's Patent*, *ubi supra*.

(*a*) *Westinghouse's Patent*, Griffin, P. C. 315. See also *Haddan's Patent*, Griffin, L. O. C. 12; *Crabtree's Patent*, *ubi supra*.

(*b*) *Fox's Patent*, A.D. 1878. No. 3988 (HERSCHELL, Sol.-Gen.)

(*c*) *Edison's Patent*. A.D. 1877, No. 2909, JAMES, Att.-Gen.).

(*d*) *Haddan's Patent*, Griffin, L. O. C. 12.

Sect. 18 (4). NOTE.

Under a condition that no action is to be brought for infringements prior to a particular date, the continued use after that date of the alleged infringing articles, and also the sale of those made previously and then unsold, are protected (*e*).

Where, on the allowance of a disclaimer, the Attorney-General exempted in general terms 800 specified instruments from actions for infringement at the suit of the patentee, and it was proved that these instruments also infringed another patent belonging to the patentee, it was held that the patentee was entitled in respect of these instruments to an injunction restraining infringement of this latter patent (*f*).

Conditions under new practice.

Under the present Act it was held by the law officers that, as a general rule, and apart from exceptional circumstances, a condition should, when desired, be imposed that no action should be brought or other proceeding taken in respect of any infringement prior to January 1st, 1884 (the commencement of the Act) (*g*).

The above rule, however, applied only to patents granted under the old law. In the case of patents under the present Act, no condition as to not bringing actions for infringement prior to amendment will be imposed, but the case will be left to be dealt with by the Court under s. 20(*h*). The law officers may impose conditions, but very special circumstances will be required to justify them (*i*).

Where the application to amend was made in a pending action in pursuance of leave obtained under s. 19, and the Court granting the leave had imposed no condition as regarded the use of the amended specification in, or the proceeding with, the action, HERSCHELL, Sol.-Gen., refused to impose any such condition (*k*).

It is a convenient and reasonable course on the part of the Patent Office to obtain an assent in writing from the patentee before making the actual amendment (*l*).

If a patentee is dissatisfied with the condition imposed, he may decline to allow his specification to be amended, and might, by notice to the Patent Office, require that no amendment should be made (*m*).

SUB-SECTION (7).

On an appeal to the law officer from the decision of the comptroller on an unopposed application to amend, the comptroller neither pays

(*e*) *Cheesebrough's Patent*, Griffin, P. C. 303.

(*f*) *United Telephone Co. v. London and Globe Telephone Co.*, 26 Ch. D. 766.

(*g*) *Hearson's Patent*, 1 R. P. C. 213; Griffin P. C. 309. See also *Westinghouse's Patent*, Griffin, P. C. 315; *Ashworth's Patent*, Griffin, L. O. C. 7; *Haddan's Patent*, Griffin, L. O. C. 12.

(*h*) *Allen's Patent*, Griffin, L. O. C. 3.

(*i*) *Ainsworth's Patent*, 13 R. P. C. 76.

(*k*) *Hearson's Patent*, *ubi supra*.

(*l*) *Per* CHITTY, J., *Andrew v. Crossley*, [1892] 1 Ch. 498.

(*m*) *Per* CHITTY, J., *Andrew v. Crossley*, *ubi supra*.

Sect. 18 (7). nor receives costs (*n*). Where, on an unopposed application to amend the specification of a patent which was ten years old, the comptroller refused an amendment which, on appeal, was allowed by the law officer, an application for a return of the stamp on the notice of appeal was refused (*o*).

NOTE.

SUB-SECTION (8).

Amended specification not to claim invention larger than or different from that in original specification.

"Substantially larger than, etc."—These words, it will be observed, are considerably wider than the corresponding words of the Act of 1835, but under that Act it was held that a patentee could not by disclaimer convert a bad specification, in the sense of its containing no description of any useful invention at all, into a good specification by adding words that would convert "a barren and unprofitable generality" into a specific and definite and practical description. Nor, when the original description was wholly bad, and contained no new invention, could it be converted into a description containing a good invention; nor could the patentee by disclaimer make material additions to the original specification, so as, by the aid of the corrected form of words, and the additions so made, to introduce into the specification an accurate and perfect description of an invention which was sought for in vain in the original specification (*p*).

Thus, where a patentee of improvements in embossing fabrics claimed the use of grooved, fluted, or indented rollers of metal, wood, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing action on the fabric, and thereby produce an indefinite variety of pattern, and afterwards disclaimed the use of any pattern rollers except metal rollers with circular grooves, and it appeared that only circular grooves would produce the effect required, and further, that the making the roller and bowl revolve at different speeds was not new, it was held that the disclaimer extended the exclusive right granted by the patent, and that the patent was therefore bad. These rollers not being specifically described in the original specification, but merely involved in the general terms used, the patentee had not sufficiently described his invention; and therefore when by disclaimer he confined his claim to circular grooved rollers as his sole invention, though in one sense he might be said to narrow a right, yet he really extended it, because he thereby described his invention sufficiently to enable him to assert a right which he never

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(*n*) *Lake's Patent*, Griffin, L. O. C. 16.

(*o*) *Morgan's Patent*, Griffin, L. O. C. 17.

(*p*) *Per* Lord WESTBURY, C., *Ralston* v. *Smith*, 11 H. L. C. 243 244.

could have successfully maintained upon the original specification alone (*q*). Sect. 18 (8)

NOTE.

But when a specification of a patent for an improvement in machinery for roving cotton described a particular method of the application of centrifugal force, and claimed the "application of the law or principle of centrifugal force to the particular or special purpose above set forth," and by a disclaimer the patentee declared that he intended to claim only the application of centrifugal force in a particular manner described in the specification, the specification thus amended was held good (*r*).

So under a *patent for "improvements in instruments used for writing* and marking, and in the construction of inkstands," a patentee disclaimed four out of eleven parts of his invention, the parts disclaimed relating to pens and to instruments used for marking with a stamp, the parts which remained untouched by the disclaimer being for improvements relating to penholders, pencil-cases, and in the construction of inkstands; it was held that the specification as amended satisfied the title of the letters patent, and that the patent was good (*s*).

Where patentees had in their specification described and claimed several parts of an apparatus, and there appeared on the face of the specification some evidence that the patentees intended to claim the several parts conjointly, they were allowed to alter the specification by disclaiming the words "firstly," "secondly," and "thirdly," before the claims, and substituting the word "or" for "secondly," and "and" for "thirdly," but they were not allowed to insert the words "in combination with" between the second and third claiming clauses (*t*).

And where the claim was, "the use of pipes of novel form, constructed of earthenware, to form, as herein above stated and described, a connection" with the main drain, it was held that substantially it claimed the arrangement of the pipes, and not the form of the particular pipes, and the patentee was allowed to amend by inserting a statement that he did not claim the pipes as novel, and to alter the claim to "the use of pipes of the *above* form, constructed of earthenware, *etc.*" (*u*).

Where a specification claimed all angular or wedge-shaped slag boxes, and the applicants desired to amend by adding words confining the claim to wedge-shaped boxes having a particular configuration, which was described in the specification, the amendment was allowed, since

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(*q*) *Ralston* v. *Smith*, 11 H. L. C. 223, 254. And see under the present Act, *Gaulard and Gibb's Patent*, 6 R. P. C. 215.

(*r*) *Seed* v. *Higgins*, 8 H. L. C. 550.

(*s*) *R.* v. *Mill*, 10 C. B. 379.

(*t*) *Bateman and Moore's Disclaimer*, Macr. P. C. 116. See also *Kelly* v. *Heathman*, 45 Ch. D. 256.

(*u*) *Allen's Patent*, Griffin, L. O. C. 3.

Sect. 18 (8). the invention was thereby confined to a particular class of slag box, which was included with a number of other slag boxes in the original claim (*x*).

NOTE.

The addition of the words "substantially as set forth and indicated," to a general claim for hardening wire for cards by drawing it through a gas flame, and passing it instantaneously through a bath of oil, was held to restrict the claim, and not to enlarge it or make it different from the original invention (*y*).

So, also, where the specification directed the introduction of aluminium into molten metal shortly before it was to be poured, and stated, "the addition might, however, be made earlier," the omission of these words was held to limit the claim to the putting in the aluminium at the melting point, and the words were allowed to be struck out by amendment (*z*).

Where a specification of a patent for the manufacture of colouring matters was for a range of colours by combining a tetrazo body therein described with two molecules of certain substances, of which a list was given, the patentee was allowed, by way of amendment, to add words showing how the series of colours might be increased by mixing two of them together, or by employing instead of two molecules of one substance one molecule of one and one of the other, both molecules being successively combined with the tetrazo body; but the amendment was considered to be doubtful, and was to be taken at the peril of the patentee (*a*).

Where one of the figures in the drawings to a specification had been misdescribed, and the figure was clearly included in the provisional, and covered by the claim of the complete specification, the patentee was allowed to amend by inserting a proper description of the figure but was not allowed to add anything to his claim (*b*).

But when a patentee claimed in effect a combination of certain devices, and desired to amend by saying that he did not claim broadly the use of those devices, but only when arranged in combination with other parts of the apparatus, it was held that the amendment was for a new combination, and must be refused (*c*).

And where before the grant of the patent the applicant proposed to amend his specification by disclaiming the main part of the invention, so as to claim an obvious alternative, which rested on the part proposed

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(*x*) *Cochrane's Patent*, Griffin, P. C. 304. See also *Ryland's Patent*, 5 R. P. C. 665.

(*y*) *Ashworth's Patent*, Griffin, L. O. C. 6.

(*z*) *Nordenfelt's Patent*, Griffin, L. O. C. 18.

(*a*) *Lake's Patent*, Griffin, L. O. C. 16.

(*b*) *Morgan's Patent*, Griffin, L. O. C. 17.

(*c*) *Parkinson and Another's Patent*, 13 R. P. C. 509, 514.

to be left out of the specification, it was held that the specification so amended would be substantially different from the original specification, and the application was refused (*d*). And where the specification of a patent for improvements in cotton-spinning machinery claimed "the construction and application to the class of machinery referred to of an inclined bearer or bearers to support the top clearing rollers substantially as set forth," an amendment adding the word "*adjustable*" before the term "bearer or bearers," wherever it occurred in the description or claim, was disallowed (*e*).

When the original claim was the method of making wire ropes, "that the strands be laid up into the rope same lay as the wires in strand," and it having been discovered that a rope thus made was old, the patentee sought to amend by claiming "the improvement in the construction of wire ropes such as are made by machinery as at present employed, that the strands be laid up into the rope same lay as the wires in strand" (*f*) leave to amend as proposed was refused.

When the amended specification claimed an invention different from that described in the provisional specification, it was held that the patent was bad (*g*).

So also, when in the specification of an invention relating to electric lighting the original specification claimed a regulator for regulating automatically the dynamo which generated the current, and by another claim claimed the employment of secondary batteries as reservoirs of electricity, and it appeared that at the date of the patent the patentee believed that regulation was required for the purpose of the invention as well as storing, it was held that an amendment which disclaimed the regulator essentially changed the nature of the invention, and that the patent was bad (*h*).

Where in a specification of a patent for making saccharin, words were used which, in the opinion of the law officer, pointed to obtaining the article in a pure state, the patentee was not allowed to amend his specification by inserting corrections showing that the product was in fact a mixture of the pure article with other substances (*i*).

Where there is a distinct claim with no claim to any arrangement of the subordinate parts, the patentee cannot amend by striking out the whole of his claim and inserting an independent claim to a subordinate part (*k*).

(*d*) *Heath and Frost's Patent*, Griffin, P. C. 311.

(*e*) *Walker's Patent*, Griffin, L. O. C. 22.

(*f*) *Lang's Patent*, 7 R. P. C. 469.

(*g*) *Gaulard and Gibb's Patent*, 6 R. P. C. 215. See *S. C.* in H. L. 7 R. P. C. 367; *Lane Fox* v. *Kensington Co.*, [1892] 3 Ch. 424.

(*h*) *Lane Fox* v. *Kensington, etc., Co.*, [1892] 3 Ch. 424.

(*i*) *Johnson's Patent*, 13 R. P. C. 659.

(*k*) *Serrell's Patent*, 6 R. P. C. 101.

Sect. 18 (8). NOTE.

The law officer will, on an application to amend, take into consideration a declaration which has been made by the patentee as to the way in which he drew up his specification, and as to his intention (*l*); and will also, as against the patentee, give weight to the fact that a complete specification was left with the application, so that the invention might then be considered in an advanced stage (*m*).

Claiming clauses might formerly be struck out on disclaimer.

Under the old law all the claiming clauses might be struck out of the specification if there remained in the body of the specification words sufficiently distinguishing what invention the patentee claimed (*n*).

(But it would seem that, having regard to s. 5, sub-s. (5) of the present Act, this could not be done now.)

Jurisdiction of Master of the Rolls as Keeper of Records.

In *Re Sharp's Patent* (*o*) it was held that the Master of the Rolls had no authority as Keeper of the Records to remove from the records of the Court of Chancery a memorandum of alteration which had been enrolled, the application being grounded on an allegation that the memorandum of alteration extended the exclusive right granted by the patent.

But where a disclaimer was filed without the consent of the patentee, it was held that the Master of the Rolls, as Keeper of the Records, had jurisdiction, on the motion of the patentee, without bill filed, to take it off the file (*p*).

Effect of disclaimer.

The effect of a disclaimer is merely to strike out from the specification those parts of the machinery which are disclaimed. It cannot operate by way of a claim of the residue, nor can what remains of the specification be construed by the disclaimer (*q*).

The reasons for the disclaimer form no part of the specification as amended by it, and ought not to be referred to in construing such amended specification (*r*); but, in construing the latter, reference may be made to the original specification (*s*).

The mere fact of entering a disclaimer as to part of a specification does not necessarily import that the patent is bad (*t*).

The law officer is not a court, and no prohibition lies to prevent him allowing an amendment which is forbidden by this sub-section (*u*).

(*l*) *Allen's Patent*, Griffin, L. O. C. 3.

(*m*) *Nordenfelt's Patent*, Griffin, L. O. C. 19.

(*n*) *Thomas* v. *Welch*, L. R. 1 C. P. 192.

(*o*) 1 Webst. 641.

(*p*) *Re Berdan's Patent*, L. R. 20 Eq. 346.

(*q*) *Per* CRESSWELL, J., *Tetley* v. *Easton*, 2 C. B. (N.S.) 730.

(*r*) *Cannington* v. *Nuttall*, L. R. 5 H. L. C. 205, 228.

(*s*) *Dudgeon* v. *Thomson*, 3 App. Cas. 40, 55; *Moser* v. *Marsden*, 13 R. P. C. 24, 31.

(*t*) *Per* TINDAL, C.J., *Stocker* v. *Warner*, 9 Jur. 136, 138; 1 C. B. 148.

(*u*) *Van Gelder's Patent*, 6 R. P. C. 22; reported also as *Ex parte Simon*, 4 Times Rep. 754.

SUB-SECTION (9). Sect. 18 (9).

NOTE.

'Shall be conclusive," etc.—A re-enactment of part of s. 39 of the Act of 1852. Under the former Acts, the fact that the law officer had allowed the disclaimer did not prevent its validity being questioned in subsequent proceedings (*x*). And in *Van Gelder's Patent* (*y*) it was held by the Court of Appeal that although the present sub-section contains the words "and for all purposes," which were not in the corresponding part of the Act of 1852, the law has not been altered, and if the law officer allows an amendment which under s. 8 ought not to be made, it can still be questioned in any future action brought upon the patent.

In *Moser* v. *Marsden* (*z*), however, it was held in the House of Lords that after an amendment has been allowed the court is not now at liberty to entertain an objection based upon an alleged discrepancy between the terms of the amended and original claim, and that the object of the Act is to make an amended claim, when admitted by the proper authorities, a complete substitute to all effects and purposes for the claim originally lodged by the patentee, and that the claim as it stood before amendment cannot be competently referred to except as an aid in the construction of its language after amendment.

After an amendment has been made the court will not entertain an objection that it was not the amendment advertised, or that it was made pending an action for infringement without an application to the court (*a*).

Under the Act of 1835 it was doubted whether, when the disclaimer violated the statutory condition, it was not itself void (*b*). There was no express enactment that the disclaimer, if it transgresses the statutory limit by extending the exclusive right, shall be void to all intents and purposes, but it was said that it might be proper to hold that the disclaimer is inoperative for the excess only (*c*). This would appear to apply also to amendments under the present Act.

"Except in case of fraud."—Such, for instance, as where leave was given to file a disclaimer on certain conditions which the patentee refused to accept, and the disclaimer was afterwards filed without his consent (*d*).

"Shall in all courts and for all purposes," etc.—A re-enactment, with the addition of the words "for all purposes" (as to which, see

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(*x*) See the cases cited under sub-s. (8), and *Dudgeon* v. *Thomson*, 3 App. Cas. 34; *Bateman and Moore's Patent*, Macr. P. C. 118.

(*y*) 6 R. P. C. 22.

(*z*) 13 R. P. C. 24, 31, 32, 33.

(*a*) *Farbenfabriken* v. *Bowker*, 8 R. P. C. 389.

(*b*) *Foxwell* v. *Bostock*, 4 D. F. & J. 298.

(*c*) *Foxwell* v. *Bostock*, *ubi supra*.

(*d*) *Re Berdan's Patent*, L. R. 20 Eq. 346.

Sect. 18 (9). *Moser* v. *Marsden* cited above), of the corresponding part of the Act of 1835. That Act contained a proviso that no disclaimer should be receivable in evidence in any action pending at the time the disclaimer was enrolled.

NOTE.

Amendments retrospective.

Under the Act of 1835 it was held, in *Perry* v. *Skinner*, that a disclaimer was not retrospective, so as to enable an action to be brought in respect of an infringement committed prior to the disclaimer (*e*). But in *R.* v. *Mill* (*f*) the correctness of the decision in *Perry* v. *Skinner* was doubted, and it was held that the disclaimer was to be considered as part of the original specification as from the date of the letters patent, except in pending actions. And one ground of the decision was that otherwise the above-mentioned proviso would be inoperative. This present Act does not contain the above-mentioned proviso as to pending actions, nor the proviso of s. 39 of the Act of 1852, mentioned *ante*, p. 77, nor any restriction on the retrospective effect of amendments, except sub-s. (10), *post*, and ss. 19 and 20. The ground of the decision in *R.* v. *Mill*, above mentioned, appears to apply equally to the last-mentioned sections, and it is therefore submitted that the words at the head of this note will receive the construction given in *R.* v. *Mill* to the corresponding words of the Act of 1835, and that, subject to the provisions of sub-s. (10) and ss. 19 and 20, and in the absence of conditions to the contrary imposed by the law officer or comptroller, actions may be brought in respect of infringements committed prior to the amendment.

SUB-SECTION (10).

This must be read in connection with s. 19, *post*, which applies by way of proviso and mitigation of the general words of the sub-section (*g*). And the effect is that, in a pending action for infringement or proceeding for revocation, the patentee may apply to the comptroller to amend his specification, if leave be given him for that purpose by the court or judge (*h*).

"So long as any action for infringement or proceeding for revocation of a patent is pending."—In *Gaulard* v. *Lindsay* (*i*), where an action for infringement and a petition for revocation were proceeding at the same time, and leave to apply to the Patent Office to amend had been given in the petition, it was suggested in the Court of Appeal, but

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(*e*) 1 Webst. 250; *Stocker* v. *Warner*, 1 C. B. 148.
(*f*) 10 C. B. 379.
(*g*) *Singer* v. *Stansen* 1 R. P. C. 121, 124; *Cropper* v. *Smith* (No. 2), 28 Ch. D. 148, 151.
(*h*) See *Re Hall*, 21 Q. B. D. 137, judgment of A. L. SMITH, J.
(*i*) 5 R. P. C. 192, 196.

Sect. 18 (10).

NOTE.

not decided, that the leave given in the petition would not be effectual unless leave was granted in the action. The practice in the Patent Office had been in accordance with the view here suggested ; and where there were two actions for infringement the comptroller had refused to entertain the application to amend, unless liberty to make the application had been obtained in both actions (*k*). But in *Re Hall* (*l*), where an action for threats under s. 32, and an action for infringement were pending at the same time, and liberty to apply at the Patent Office for leave to amend had been given in the infringement action alone, it was held, without deciding whether the action for threats was "a legal proceeding in relation to a patent" within the words of the sub-section as they stood in the Act of 1883, that the judge in the infringement action had jurisdiction to make the order notwithstanding the pendency of the threats action, and a prohibition to the comptroller to prevent him from hearing the application was refused. This decision appears to overrule the above-mentioned practice in the Patent Office.

The meaning of the sub-section is that the patentee is not to take proceedings for amendment while an action for infringement is pending. It does not say that when before an action is commenced the patentee has got leave to amend, and when everything is done except the actual mechanical amendment of the specification, that mechanical part shall not be done because the action is pending. And therefore where leave to amend had been given on a condition which was verbally accepted, an action for infringement brought two days after the leave was given was held to be properly brought though the applicant (the plaintiff) had not signed a formal undertaking subsequently required by the comptroller accepting the condition, and though the amendment in the specification was not actually made till some time afterwards (*m*).

When the comptroller by his decision imposes a condition, a written assent subsequently given relates back to the decision, and the giving of such assent does not fall within the true meaning of the words "the foregoing provisions of this section," and is not a step which is prohibited while an action for infringement is pending (*n*).

"Proceeding for revocation of a patent."—These words are substituted by the Act of 1888 for the more general words "other legal proceeding in relation to a patent." The latter were held to include proceedings for revocation (*o*), but not proceedings before the

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(*k*) *Codd's Patent*, Griffin, P. C. 305.

(*l*) 21 Q. B. D. 141.

(*m*) *Andrew* v. *Crossley*, [1892] 1 Ch. 492, 502.

(*n*) *Per* CHITTY, J., *Andrew* v. *Crossley* [1892] 1 Ch. 499.

(*o*) *Cropper* v. *Smith* (No. 2), 28 Ch. D. 148.

Sect 18 (10). comptroller (*p*), and the question had been raised, but not decided, whether they included an action for threats under s. 32 (*q*).

NOTE. If a petition for revocation is presented after the commencement of proceedings for amendment, it seems that the latter are suspended, and the leave of the court is necessary before they can be renewed (*r*).

Where in an action for infringement certain claims of a specification were held bad by the judge of first instance, and his decision was affirmed except with regard to the first claim, as to which the Court of Appeal gave no decision, it was held that an application to amend by striking out the claims held bad by the Court of Apreal might be allowed to proceed notwithstanding the pendency of a petition for revocation, the patentee desiring to have an opportunity of taking the opinion of the Court of Appeal as to the first claim (*s*).

"**Pending.**"—This means an action before judgment, and, therefore, the sub-section was held not to apply where final judgment had been given, and the case was under appeal to the House of Lords (*t*). The sub-section applied to actions pending at the commencement of the Act (*u*).

Power to disclaim part of invention during action, &c.

19.—(1.) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed (*v*).

A disclaimer could, under the express terms of the Act of 1835, be received in evidence in an action of *scire facias* commenced before it was filed (*x*), and when after the disclaimer the action failed, the prosecutor had to pay all the costs subsequent to the disclaimer (*y*).

But where a disclaimer had been filed after the commencement of a suit for injunction, it was held (on the words of the Act, s. 1), that the suit could not be continued by amendment of the bill, but a fresh bill must be filed (*z*).

(*p*) *Cochrane's Patent*, Griffin, P. C. 30.

(*q*) *Re Hall*, *ubi supra*.

(*r*) See *Deeley's Patent*, 11 R. P. C. 72, 74, 76.

(*s*) *Deeley's Patent*, *ubi supra*.

(*t*) *Cropper* v. *Smith* (No. 2), *ubi supra*; *Lawrence* v. *Perry*, 2 R. P. C. 177, 188; and see *Haslam Co.* v. *Hall*, 5 R. P. C. 1, 24.

(*u*) *Singer* v. *Stassen*, *ubi supra*.

(*v*) P. R., r. 58.

(*x*) *R.* v. *Mill*, 10 C. B. 379.

(*y*) *R.* v. *Mill*, 14 Beav. 312.

(*z*) *Lister* v. *Leather*, 1 De G. & J. 361; 3 Jur. (N.S.) 433.

Sect. 19 (1).

NOTE.

And a patentee having obtained an injunction and then altered his specification by disclaimer, was held not entitled to enforce the injunction (*a*).

Now, however, all pending proceedings, whether for infringement or for revocation of the patent (*post*, s. 26), will be governed by this and the preceding section (*ante*, p. 86); and in a proper case the court may order the amendment, when made, to be given in evidence. See *post*, p. 91.

This section is by way of proviso to s. 18, sub-s. (10), and applies to the same action (*b*). It applies to actions pending at the commencement of the Act (*c*), and to actions in the Palatine Court of Lancaster (*d*).

In order to obtain the benefit of this section in a pending action the application for leave to apply to the Patent Office must be made before judgment (*e*). Applications under this section may be made in chambers (*f*).

The judge has jurisdiction under this section to give liberty in an infringement action to apply to the Patent Office, notwithstanding the pendency of an action for threats under s. 32, or apparently any other action for infringement (*g*). It will be observed that the court is only authorized to give liberty to apply to amend by way of *disclaimer*. There appears to be no jurisdiction to allow an application to amend by way of "correction or explanation." See s. 18 (1), and s. 20.

Granting or refusing leave under this section is a matter for the judicial discretion of the court (*h*). But this discretion must be exercised on grounds which can be stated and therefore the patentee must show a case (*i*).

The case of *Moser* v. *Marsden*, (cited *ante*, p. 85) has in no way interfered with this discretion nor made it necessary for the court on an application for leave to apply at the Patent Office to go into the question whether the proposed amendments are or are not within the Act (*k*).

(*a*) *Dudgeon* v. *Thomson*, 3 App. Cas. 34.

(*b*) *Singer* v. *Stassen*, 1 R. P. C. 121 (judgment of BRETT, M.R.); *Re Hall*, 21 Q. B. D. 137.

(*c*) *Singer* v. *Stassen*, *ubi supra*; *Winter* v. *Baybut*, 1 R. P. C. 76.

(*d*) *Winter* v. *Baybut*, *ubi supra*.

(*e*) See *ante*, p. 88, under s. 18 (10).

(*f*) *Singer* v. *Stassen*, 50 L. T. (N.S.) 326; W. N. (1884), p. 83.

(*g*) *Re Hall*, 21 Q. B. D. 137.

(*h*) *Deeley's Patent*, 11 R. P. C. 72; *Lang* v. *Whitecross Co.* 7 R. P. C. 389 (H.L.)

(*i*) *Per* CHITTY, L.J., *Armstrong's Patent*, 14 R. P. C. 747, 755.

(*k*) *Dellwick's Patent*, [1896] 2 Ch. 705. See also *Armstrong's Patent*, *ubi supra*, judgment of CHITTY, L.J.

Sect. 19 (1).

NOTE.

Where the judge had refused leave to apply at the Patent Office the Court of Appeal declined to interfere with the exercise of his discretion not being clearly of opinion that the discretion had been wrongly exercised (*l*).

"**The court.**"—That is, by s. 117 (*post*), the High Court of Justice. It would seem, therefore, that the House of Lords has no original jurisdiction under this section (*m*). The court referred to is the judge who tries the action or hears the petition for revocation (*n*).

"***Terms as to costs and otherwise.***"—This section gives the widest discretion to the judge as to the terms to be imposed (*o*).

If leave is given under this section, conditions in favour of the defendant will be imposed as to costs.

Thus in *Winter* v. *Baybut* (*p*), the plaintiff was ordered to pay the costs of the action up to and including the motion for leave.

In *Singer* v. *Stassen* (*q*) it was ordered that the costs of and occasioned by the application should be the defendant's costs in any event; and in *Codd* v. *Brathy* (*r*) it was admitted that the plaintiff must pay the costs of the application and all the costs thrown away in the action.

In *Fusee Vesta Co.* v. *Bryant & May* (*s*), it was ordered that the costs of the defendants of the action up to and including the application for leave and consequent upon the amendment, should be borne by the plaintiffs in any event. In this case very little had been done in the action beyond the writ. But in the case of *Haslam Foundry and Engineering Co.* v. *Goodfellow* (*t*), when the pleadings were completed at the time when the application for leave to apply to the Patent Office was made, the plaintiffs were ordered to pay in any event the costs of the application and the costs of the action up to and occasioned by the disclaimer, except only so far as the proceedings in the action might be utilised for the purpose of the trial under the leave thereby given, all other questions of costs being reserved.

In *Gaulard* v. *Lindsay* (*u*), when the action was founded on several patents, and the plaintiff sought leave to apply at the Patent Office to amend the specification of one patent to which the others were

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(*l*) *Armstrong's Patent*, *ubi supra*. See also *Allen* v. *Doulton*, 4 R. P. C. 377.

(*m*) See *Cropper* v. *Smith* (No. 2.) 28 Ch. D. 148.

(*n*) *Armstrong's Patent*, *ubi supra*, judgment of LINDLEY, L.J.

(*o*) *Lang* v. *Whitecross Co.* 6 R. P. C. 570, 7 R. P. C. 389 (H.L.)

(*p*) 1 R. P. C. 76.

(*q*) 1 R. P. C. 121.

(*r*) 1 R. P. C. 211.

(*s*) 34 Ch. D. 458. The order is printed 37 Ch. D. 120 and 4 R. P. C. 73. See also *Lang* v. *Whitecross Co.*, 6 R. P. C. 570; 7 R. P. C. 389.

(*t*) 37 Ch. D. 118. The order is given on p. 123; and see also *Gaulard* v. *Lindsay*, 38 Ch. D. 38.

(*u*) 38 Ch. D. 38.

subsidiary, the payment of the costs of the action up to the time of the leave being given was imposed as one of the terms on which the leave was granted. In this case it appears, from another report (*x*), that the action was set down for trial at the time the application was made.

NOTE.

The Court of Appeal has refused to direct the taxation upon the higher scale of the costs which the plaintiff is directed to pay as a condition of obtaining leave to amend (*y*).

The court will not give any directions as to the costs before the comptroller of obtaining the disclaimer (*z*).

Where, however, there had been a previous application to the comptroller which had been refused because the action was pending, it was held, on an application to the court, that as a condition of obtaining the leave asked, the plaintiff must pay the costs of the application before the comptroller (*a*).

When there were two actions pending, and an order under this section having been obtained in one only, the application to the comptroller was dismissed, on the ground that the leave of the court should be obtained in both actions; and on this being done in the second action the application was renewed, it was held, that the leave given in the first action was not exhausted, the application not having been dismissed on its merits, but only on a technical point (*b*).

Whether amended specification can be given in evidence in the action.

In an action for infringement instituted before the commencement of this Act it was held by the Court of Appeal that leave to apply to amend should only be given on the terms that the specification, as amended, should not be given in evidence in the action (*c*). And in another similar case it was conceded, in addition to the above condition, that no evidence of infringement prior to the amendment should be given (*d*). But in granting leave under this section the court will not, unless under special circumstances, impose on a plaintiff the condition that he shall not in any way sue the defendants on the amended specification (*e*). A condition, however, preventing any action for infringements committed before the commencement of the Act has, in general, been imposed by the law officers (*f*).

In *Fusee Vesta Co.* v. *Bryant & May* (*g*), it was held in an action commenced since the Act, and where no statement of claim or defence

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(*x*) 5 R. P. C. 194.

(*y*) *Gaulard* v. *Lindsay*, 5 R. P. C. 192, 197.

(*z*) *Fusee Vesta Co.* v. *Bryant & May*, 34 Ch. D. 458, 461.

(*a*) *Codd* v. *Bratby*, cited above.

(*b*) *Codd's Patent*, Griffin, P. C. 305.

(*c*) *Singer* v. *Stasson*, 1 R. P. C. 121. See also *Codd* v. *Bratby*, 1 R. P. C. 210.

(*d*) *Codd* v. *Bratby*, *ubi supra*.

(*e*) *Codd* v. *Bratby*, *ubi supra*.

(*f*) *Hearson's Patent*, 1 R. P. C. 213.

(*g*) 34 Ch. D. 458. See also *Haslam Foundry and Engineering Co.* v. *Goodfellow*, 37 Ch. D. 118.

Sect. 19 (1).

NOTE.

had been delivered, that the proper terms to be imposed on the plaintiff asking leave under this section, in addition to terms as to costs (*h*), were that no further proceedings should be taken till the disclaimer had been properly made, that the plaintiff should undertake forthwith to take proceedings for disclaimer, and then to amend the action by stating the disclaimer, founding the action on the specification as amended ; failing this, the action to be dismissed.

But in *Bray* v. *Gardiner* (*i*), which was also an action commenced since the Act, it was held by the Court of Appeal that under ordinary circumstances, and as a general rule, the condition should be imposed that the amended specification shall not be receivable as evidence in the action. It was said, however, in this case that there is no form of order which is invariably to be followed in all applications under this section, and there may be cases in which the amended specification ought to be allowed to be given in evidence. And in the subsequent case of *Allen* v. *Doulton* (*k*) it was held by the Court of Appeal that *Bray* v. *Gardiner* did not lay down any hard and fast rule with regard to the manner in which the discretion given by s. 19 should be exercised. The condition that the amended specification shall not be given in evidence in the action may, however, be a reasonable one to impose in some cases. Thus, in *Allen* v. *Doulton* (*l*), where very little had been done in the action, and it was clear that the particulars of breaches would require considerable amendment in order to support the action on the amended specification, and there were other special circumstances in the case, the Court of Appeal itself exercised the discretion and imposed this condition as a term on which the leave to apply at the patent office should be granted. And in *Gaulard* v. *Lindsay* (*m*), the plaintiffs were only allowed to give the amended specification in evidence in the pending action upon the terms (in addition to terms as to costs and amendment of pleadings) of their not claiming damages for any infringement prior to the amendment.

In *Allen* v. *Doulton*, the Court of Appeal considered that as the judge at Chambers had thought himself bound by *Bray* v. *Gardiner*, and the Divisional Court was divided in opinion, there had been, in fact, no exercise of judicial discretion. In cases, however, where the judge below has exercised his discretion, the Court of Appeal will not interfere unless they can clearly come to the conclusion that, in their view, the discretion was exercised absolutely wrongly (*n*).

(*h*) *Ante*, p. 90.

(*i*) 34 Ch.D. 668; 4 R.P.C. 40. See also *Gaulard* v. *Lindsay*, 38 Ch.D. 38.

(*k*) 4 R. P. C. 378. See judgment of FRY, L.J. See also *Gaulard* v. *Lindsay*, 5 R. P. C. 192, 197; *Lang* v. *Whitecross, etc., Co.*, 6 R. P. C. 570; 7 R. P. C. 389 (H.L.)

(*l*) 4 R. P. C. 378.

(*m*) 38 Ch. D. 38.

(*n*) *Per* Lord ESHER, M.R., *Allen* v. *Doulton*, 4 R. P. C. 384. See

Sect. 19 (1). Note.

The general principle in these cases is that liberty to amend or disclaim pending the action ought not to be given unless the court can see that no injustice will be done to the defendant in the action (*o*).

In *Haslam Foundry, etc.* v. *Goodfellow* (*p*), where the application was made after the pleadings were closed, and the action was set down for trial, the amendment was allowed upon the terms (in addition to the terms as to costs mentioned, *ante*, p. 90), that the plaintiffs and defendants should have leave to make all necessary amendments in their pleadings after disclaimer, the plaintiffs undertaking forthwith to amend their pleadings, confining the action to the amended specification, or consent to the action being dismissed with costs and the judge reserved the power of dealing with any point which might be raised under ss. 18 or 20.

When the judge at the close of the defendant's case intimated that he was pressed with the point that a certain part of the invention was not patentable, and the trial was then, at the plaintiff's instance, postponed in order that the plaintiff might apply for leave to disclaim, reserving all questions of costs, and the disclaimer having been allowed, the plaintiff subsequently applied to amend his pleadings, it was held that this leave would not be given at that stage of the proceedings, and that the only course was to dismiss the action with costs. This was affirmed in the Court of Appeal, with an intimation that the order should have been with a reservation to the plaintiff of the right to bring a fresh action if so advised (*q*). In this case it appeared that the defendants had not infringed since the trial, and did not intend to make according to the amended specification.

Leave under this section has been given without imposing terms, except as to costs, proceedings in the action being stayed till after the result of the application to the Patent Office (*r*).

Where no terms had been imposed by the court which granted leave under this section, the law officer refused to impose any condition relating to the action (*s*).

As to conditions imposed by the law officer under the old practice, see *ante*, p. 77.

Where the application was made by the patentees pending a petition for revocation of the patent, it was held that the proper terms to be

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also *Lang* v. *Whitecross, etc., Co.*, 7 R. P. C. 389; *Armstrong's Patent*, 14 R. P. C. 747.

(*o*) *Gaulard* v. *Lindsay*, 38 Ch. D. 38; *Bray* v. *Gardiner*, 34 Ch. D. 668. See also *Lang* v. *Whitecross Co.*, 6 R. P. C. 570; 7 R. P. C. 389.

(*p*) 5 R. P. C. 28; 37 Ch. D. 118.

(*q*) *Meyer* v. *Sherwood*, 7 R. P. C. 283.

(*r*) *Winter* v. *Bayhut*, 1 R. P. C. 76. See also *Hearson's Patent*, 1 R. P. C. 213; *Fusee Vesta Co.* v. *Bryant & May*, 34 Ch. D. 458; 4 R. P. C. 71.

(*s*) *Hearson's Patent*, 1 R. P. C. 213.

Sect. 19 (1). imposed on granting leave were, that the patentees should pay all the costs of the petition up to and including the application for the liberty to apply to the Patent Office, and should also undertake to prosecute their application with diligence; and it was further ordered that within fourteen days after the amendment, or after it had been ascertained that no amendment would be made, the petitioner ought to have leave to discontinue by notice, or if he did not do that, to have the same fourteen days to amend the petition and particulars of objections (*t*).

NOTE.

And where the court had revoked a patent, and the order of revocation had been entered on the Register of Patents, and the House of Lords varied the order by directing that the patent should be revoked unless the patentee within a certain time obtained leave to amend, a condition was imposed that no action should be brought in respect of infringements committed before the date of the conclusion of the hearing of the appeal (*u*).

"**By way of disclaimer.**"—The amendment here referred to is by way of disclaimer as distinguished from s. 18, which relates to amendment before the commencement of legal proceedings, and allows a patentee to amend by way of disclaimer, correction, or explanation (*v*).

And where it appeared by the evidence on the trial that the patent could not be improved by disclaimer, leave to apply at the Patent Office for amendment was refused under this section (*x*).

Where leave has been given under this section to apply to the Patent Office, the provisions of s. 18 apply as if that section stood without the words "correction or explanation" (*y*).

Restriction on recovery of damages

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

This provision was first introduced by the present Act. It will probably render it unnecessary on allowance of an amendment of a

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(*t*) *Re Gaulard and Gibbs' Patent*, 5 R. P. C. 189.

(*u*) *Deeley* v. *Perkes*, [1896] A. C. 496, 499.

(*v*) See *per* LINDLEY, L.J., *Armstrong's Patent*, 14 R. P. C. 747, 753.

(*x*) *Armstrong's Patent*, 13 R. P. C. 501; 14 R. P. C. 747.

(*y*) *Per* CLARKE, S.G., *Lang's Patent*, 7 R. P. C. 471.

clerical error in a specification, to require the condition imposed in *Dixon's Patent* (*z*). It does not appear to limit in any way the power of the law officer or the comptroller to impose conditions as to actions in respect of infringements committed before amendment, or to fetter the court as to the terms on which it will grant leave under s. 19 (*a*). Sect. 20. NOTE.

Where the specification claimed substantially a method of joining metal to metal by rivetting or soldering, it was held that as the method was notorious, the specification was not framed with reasonable skill and knowledge, and that under this section no damages could be given after the specification had been amended by striking out this claim (*b*).

For a form of order in an action for infringement on an amended specification when the defendant makes default in delivering a defence, see *Wenham* v. *Carpenter* (*c*).

21. Every amendment of a specification shall be advertised in the prescribed manner (*d*). Advertisement of amendment.

Compulsory Licenses (*e*).

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms— Power for Board to order grant of licences.

(a.) The patent is not being worked in the United Kingdom; or

(b.) The reasonable requirements of the public with respect to the invention cannot be supplied; or

(c.) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Proceedings under this Act by or before the Board of Trade are regulated by s. 102A, added by the Act of 1888, s. 25, *post*.

(*z*) Eng. Rep., Jan. to Mar. 1881, xvi., *ante*, p. 73.

(*a*) See *Lang* v. *Whitecross Co.*, 6 R. P. C. 570; 7 R. P. C. 389 (H. L.).

(*b*) *Meyer* v. *Sherwood*, 7 R. P. C. 283.

(*c*) 5 R. P. C. 69.

(*d*) P. R., *post*, r. 59.

(*e*) See notes under P. R., *post*, rr. 60—66.

Sect. 22.

NOTE.

A new patent granted after the Act by way of extension of the term of an existing patent is subject to the provisions of this section (*e*).

Register of Patents.

Register of patents.

23.—(1.) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed (*f*).

(2.) The register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein.

(3.) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

See *post*, ss. 85, 87, 88, 89, 90, 91, 93.

The Act of 1852 provided (s. 34) for a register of patents, and (s. 35) for a register of proprietors. Under the present Act there is no separate register of proprietors, but all the matters included in that register are entered on the register of patents.

Under the Act of 1852 it was held that the register of proprietors was to contain not merely a register of documents, but any other fact which the court or the commissioners might think it desirable should be entered on the register (*g*).

It was not the practice of the Patent Office to enter on the register of proprietors documents affecting provisional protections only (*h*), and this rule still prevails. It will be observed that this and the other sections of the present Act refer in terms to "patents," that is, by s. 46, "letters patent."

The Patent Office registers mortgagees not as proprietors but only as mortgagees, and this practice is right (*i*).

(*e*) *Wasteney Smith's Patent*, 2 R. P. C. 14.

(*f*) P. R., *post*, rr. 67—79.

(*g*) *Re Morey's Patent*, 25 Beav. 583.

(*h*) Johnson, Patentees Manual 4th ed., p. 221.

(*i*) *Van Gelder* v. *Sowerby, &c. Society*, 44 Ch. D. 374, 389.

Sect. 23.

NOTE.

The office would formerly register deeds of trust (*j*).

When, under the International Convention, a patent is granted for an invention in respect of which a foreign application is made, the patent is to be entered on the register of patents as dated of the date of the first foreign application (*k*).

"**Affecting the validity or proprietorship of patents.**"—Under the present Act the Patent Office refuses to register any document dated before the grant of the patent, but it is not decided, though the question has been raised, whether the office is justified in such refusal (*l*).

But a document signed by two persons proposing to form a syndicate to take up patents for certain countries, including England, *in re* a patent process which was not patented in England but which had been patented in a colony in the name of one of the signatories to the document, and which was by one of the parties presented for registration after a patent for the process had been granted in England, was held not to be a document capable of registration under this section (*m*).

An equitable assignment may be registered as being a document affecting the proprietorship (*n*). But a letter agreeing to grant a licence on payment of royalties to be mutually agreed upon, is not a document capable of registration, even assuming that the royalties were subsequently agreed by parol, as the document itself conferred no legal or equitable interest (*o*).

There is nothing in this section to make the registration notice of the documents registered (*p*).

Fees.

Fees in schedule.

24.—(1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's

(*j*) Johnson, Patentees Manual, 4th ed., p. 221.

(*k*) P. R., r. 29, *post*.

(*l*) *Parnell's Patent*, 5 R. P. C. 127.

(*m*) *Ibid.*

(*n*) *Casey's Patents*, [1892] 1 Ch. 104.

(*o*) *Fletcher's Patent*, 10 R. P. C. 252.

(*p*) *Heap* v. *Hartley*, 5 R. P. C. 603. This point was left undecided on the appeal, 42 Ch. D. 461.

Sect. 24 (1). Exchequer in such manner as the Treasury may from time to time direct (*q*).

(2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

Extension of Term of Patent.

Extension of term of patent on petition to Queen in Council.

25.—(1.) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2.) Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension.

(3.) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6.) It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for

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(*q*) P. R., r. 4, and P. R., 1892, r. 4, *post*.

regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee. Sect. 25 (6).

(7.) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

The powers of the judicial committee to grant extensions were conferred by the repealed Acts, 5 & 6 Will. 4, c. 83, s. 4, and 2 & 3 Vict. c. 67.

By the first of these Acts (s. 3) power was also given to the judicial committee to confirm letters patent in certain cases where the patentee, though a real inventor, was not the first inventor. The jurisdiction was very little exercised, and is not re-enacted in the present Act. The right to apply for a confirmation was, however, a "right accrued" within the meaning of s. 113, and was therefore preserved as to "existing patents" within s. 45, subject, however, to all the liabilities to which the patent was subject before the Act of 1883 (*r*). See s. 113, *post*.

The judicial committee may now call in an assessor in extension cases. See s. 28 (2), *post*, p. 146.

By an Order in Council, dated November 26th, 1897, rules for regulating the practice of the judicial committee under this section have been made, to take effect on and after January 1st, 1898. Hitherto the practice has been regulated by the rules in force at the date of the commencement of the Act which are printed in former editions of this work. The new rules embody substantially the existing practice with some additions. See Judicial Committee Rules, *post*.

SUB-SECTION (1).

"**Patentee.**"—This word (s. 46) includes the person for the time being entitled to the benefit of a patent. An assignee can, therefore, as he could under the old Acts (*s*), obtain an extension. For the considerations affecting applications by assignees, see *post*, p. 112.

(*r*) *Jablochkoff's Patent*, [1891] A. C. 293; see also *Brandon's Patent*, 9 App. Cas. 589.

(*s*) 5 & 6 Will. 4, c. 83; 7 & 8 Vict. c. 69; *Russell* v. *Ledsam*, 14 M. & W. 588; affirmed 1 H. L. C. 687.

Sect. 25 (1).

So, also, a petition may be presented by the administrator of a deceased patentee (*t*).

NOTE.

In *Noble's Patent* (*u*), upon an objection that a person to whom assignees of the patent had agreed to assign it had no *locus standi* on a petition, it was said to be immaterial whether a party had a legal or equitable interest. But in *Church's Patents* (*v*), where the patent had been mortgaged, it was held that the mortgagee, as the legal owner, ought to concur in the petition; and in *Willacy's Patent* (*x*), where it appeared on the face of a petition by a person claiming as equitable owner, who had purchased the patent from the assignee of the trustee in bankruptcy of the patentee, but had not obtained an assignment, that it was possible that the legal personal representative of the patentee might have interest in the patent, the petition was ordered to stand over in order that such legal personal representative might be added as a co-petitioner, and the legal owner of the patent was also joined as a co-petitioner when the petition was amended.

"After advertising," etc.—See Judicial Committee Rules, r. 1, *post*.

Requisites of petitions.

"Petition."—Prolongation is a matter of favour and not of right (*y*), and a petitioner seeking the grace and favour of the Crown is bound to strict truth, to *uberrima fides*, in his statements (*z*); and in *Pitman's Patent* (*a*) the judicial committee stated that for the future they would invariably act on the principle that a petition which failed to state everything belonging to the patent fairly and fully should therefore be dismissed.

What should be stated.

Among the matters which should be thus stated in the petition were the names and dates of, and material facts affecting, any foreign patents obtained by the English patentee. This was mainly in regard to s. 25 of the Patent Act, 1852 (now repealed and not re-enacted in the present Act, see *post*, under s. 45), which made the duration of an English patent depend in certain cases on the date of the foreign patent (*b*). But the petitioner is also bound to state in his petition and accounts the remuneration which the patentee has derived from his foreign patents, as well as from his English patent (*c*).

(*t*) *Dounton's Patent*, 1 Webst. 565; *Heath's Patent*, 2 Webst. 247.

(*u*) 7 Moo. P. C. C. 191.

(*v*) 3 R. P. C. 95.

(*x*) 5 R. P. C. 690.

(*y*) *Adair's Patent*, 6 App. Cas. 178.

(*z*) *Clark's Patent*, L. R. 3 P. C. 421, 426; *Johnson's Patent*, L. R. 4 P. C. 75, 83.

(*a*) L. R. 4 P. C. 86; see also *Adair's Patent*, 6 App. Cas. 178.

(*b*) *Johnson's Patent*, L. R. 4 P. C. 82; *Pitman's Patent*, L. R. 4 P. C. 84; *Adair's Patent*, 6 App. Cas. 178.

(*c*) *Johnson's Patent*; *Adair's Patent*, *ubi supra*; *Bower-Barff Patent*, [1895] A. C. 675.

Sect. 25 (1).

NOTE.

So, also, where the petition was nominally by one company, but really was for the benefit of another company, to whom the shares in the first company had been transferred, and no statement of this fact appeared in the petition, and the real facts were only brought forward by the Attorney-General, the *omission to state the real circumstances* was held sufficient ground for refusing the petition (*d*).

And where on the face of the petition it appeared that the petitioners were a company who had purchased the patent, and it turned out that no company, in a commercial sense, had ever been formed at all, but that the persons really interested were the petitioner and a creditor of his, the requirements of the Companies Acts having been met by giving one share to each of seven persons, and these facts were not stated on the petition, extension was on that ground refused (*e*). And every petition by a company ought to state whether there have been any, and if any, what, dealings with the shares (*f*).

So, also, where one of several joint patentees had by contract with the other patentees carried on business in the patented article, and had carried on its manufacture in combination with the manufacture of other articles, and this fact did not appear on the petition, and there was nothing in the accounts to show that there was any other manufacture except that of the patented article, the petition was dismissed (*g*).

In *Livet's Patent* (*h*), it was said on the part of the Crown, that the patentee ought to show the state of knowledge at the time of his patent. And in the same case, where an earlier specification which had a considerable bearing on this point was known to the patentee, but was not referred to in the petition, the judicial committee, though not dismissing the petition on that ground, stated that it would have been better if it had been brought forward, although the petitioner (the patentee) said that he had considered the claim of the earlier patent to be a futile claim.

Amendment of petition.

In *Hutchinson's Patent* (*i*), a petitioner was allowed to amend his petition, but the rules above stated had not then been expressly laid down. A petitioner, however, who had, in ignorance of their lordships' rule, omitted in his petition to give the proper information as to his foreign patents, was allowed, on application made before the hearing, to add a supplementary paper giving the necessary information (*k*).

(*d*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*e*) *Horsey's Patent*, 1 R. P. C. 225.

(*f*) *Per* Lord WATSON, *Barff's and Bower's Patent*, 12 R. P. C. 383, 385.

(*g*) *Yates and Kellett's Patent*, 12 App. Cas. 147.

(*h*) 9 R. P. C. 327, 331 ; see also *Standfield's Patent*, 15 R. P. C. 17.

(*i*) 14 Moo. P. C. 364.

(*k*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

Sect. 25 (1). Where the patents are cognate patents, or the inventions have been worked together, application for the extension of more than one patent may be included in one petition (*l*).

NOTE.

"Such petition must be presented," etc.—Under the repealed Acts (*m*), the presentation of the petition six months before the expiration of the patent was only required in cases where the petition was not prosecuted with effect during the existence of the patent. The requirement is now general. It did not, however, apply to patents existing at the commencement of the Act, the right to present a petition for extension at any time before the expiration of the patent being "a right or privilege accrued" under the repealed Acts, and therefore saved by s. 113 of this Act (*post*) (*n*). But this right was subject to all the liabilities incurred under the repealed Acts, and therefore, where a petition not in time under the Act of 1883 was presented, asking for an extension of the patent, and it appeared that the case was within s. 25 of the Act of 1852 (see *post*, p. 346), the petition was dismissed (*o*). So also, when the petition was presented so late that the condition of the repealed Acts requiring the petition to be prosecuted with effect before the expiration of the patent could not possibly be complied with (*p*).

SUB-SECTION (2).

Opposition.

"Any person."—There is no requirement of interest in the opponent as in the case of opposition to the grant of patents or the amendment of specifications (s. 11 (3) and s. 18 (4)) (*q*). See *post*, under sub-s. (7), "*Costs.*"

"Caveat."—The caveat must be entered in the name of the actual opposer, not in that of his agent (*r*).

The statutory provisions as to particulars of objections were held not to apply to proceedings for extension under the old Acts, and opponents who had objected on the ground of want of novelty were allowed to give evidence of instances not mentioned in their objections (*s*). The present Act, like the repealed Acts, contains no provision requiring particulars of objections in extension cases. In a case, however, where the opposition succeeded in an instance of prior user not mentioned in the objections no costs were given to the opponents (*t*).

(*l*) *Johnson and Atkinson's Patents*, L. R. 5 P. C. 87; *Clarke's Patent*, L. R. 3 P. C. 421; *Church's Patents*, 3 R. P. C. 95. See also *Erard's Patent*, 1 Webst., 557.

(*m*) 5 & 6 Will. 4, c. 83, s. 4; 2 & 3 Vict. c. 67, s. 2.

(*n*) *Brandon's Patent*, 9 App. Cas. 589.

(*o*) *Jablochkoff's Patent*, [1891] A. C. 293.

(*p*) *Marshall's Patent*, [1891] A. C. 430.

(*q*) *Loue's Patent*, 8 Moo. 1.

(*r*) *Loue's Patent*, *ubi supra*.

(*s*) *Ball's Patent*, L. R. 4 App. Cas. 171.

(*t*) *Stewart's Patent*, 3 R. P. C. 7

SUB-SECTION (3). Sect. 25 (3).

NOTE.

The judicial committee had, under s. 4 of the Act of 1835, jurisdiction to entertain a petition referred to them by the Crown, seeking to revoke an Order in Council made on their recommendation, on an application by patentees for a prolongation of letters patent, and to recall the warrant for sealing (*u*).

"By counsel."—The judicial committee will not hear in opposition more than two counsel in the same interest (*x*). The Attorney-General always appears, whether the extension be opposed or not, to watch the case on behalf of the Crown (*y*), and he so far represents the Government and the public generally that a Government Department who had not entered a caveat in time were not allowed, the Attorney-General being present, to enter a caveat and be heard in opposition (*z*). See also Judicial Committee Rules, under r. VIII., *post*.

The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Lords of the Committee (*a*).

SUB-SECTION (4).

The rules adopted by the judicial committee in extension cases have not been altered by this sub-section (*b*). Those rules have been thus stated: "The general object of the statutable jurisdiction of the committee, in respect to advising an extension of the terms of the letters patent, is the reward of the inventor in cases where there has been extraordinary merit in the invention, but where, from circumstances, he has failed to reap any adequate remuneration for his invention during the currency of the term of the letters patent" (*c*).

"Nature and merits of the invention in relation to the public."—It is, of course, not easy to define the degree of merit which will justify the extension of a patent. Merit of invention.

An invention "may have been the successful result of long and patient labour, and of great and unaided ingenuity, without which, for

(*u*) *In re Schlumberger*, 9 Moo. P. C. 1.

(*x*) *Woodcroft's Patent*, 3 Moo. P. C. 172 n.

(*y*) 1 Webst. 557 n.

(*z*) *Pettit Smith's Patent*, 7 Moo. 133.

(*a*) Judicial Committee Rules, r. viii., and see, under the old rules, *Ball's Patent*, L. R. 4 App. Cas. 171; *Stewart's Patent*, 3 R. P. C 7; *Church's Patents*, 3 R. P. C. 95, 101; *Livet's Patent*, 9 R. P. C. 327.

(*b*) *Newton's Patents*, 9 App. Cas. 592.

(*c*) *Per* Sir J. COLVILE, *Pitman's Patent*, L. R. 4 P. C. 87. See also *Honiball's Patent*, 9 Moo. P. C. 393; *Markwick's Patent*, 13 Moo. P. C. 313; *Derosne's Patent*, 2 Webst. 4; *Norton's Patent*, 1 Moo. P. C. (N.S.) 339; *Beanland's Patent*, 4 R.P.C. 489.

Sect. 25 (4). NOTE.

all that appears, the public would never have had the benefit of the discovery; or it may have been but a happy accident or a fortunate guess; or it may have been very closely led up to by an earlier and, in a true sense, more meritorious but still incomplete experiment. Different degrees of merit must surely be attributed to an inventor under these different circumstances (*d*)."

The smallness of the step made is not to lead to any inference against the merit of the invention (*e*), nor is it any objection that great improvements have been made on the original invention (*f*), or that the invention is an improvement on a former patent taken out by the patentee in consequence of a communication from abroad (*g*), or that some alteration has since the patent been made in the actual working of the invention (*h*).

But if the original invention was a failure, there is no ground for extension, although the defect has since been remedied (*i*).

So, also, where the invention as described in the specification succeeded to a limited extent, but was only rendered a success by improvements introduced from abroad by persons other than the patentee (*k*).

And where the invention was beneficial, but it was not shown that there was any special or peculiar advantage in it in relation to the public, an extension was refused (*l*).

The fact that the patent may tend to fetter the public in the use of known sanitary agents has been considered a reason for refusing extension (*m*).

Utility in relation to merit.

The public utility of the invention is an essential element to be taken into account on the question of extension (*n*).

The utility to be considered is not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit (*o*). In order to obtain an extension there must be in the patented invention merit beyond that ordinary merit which would be sufficient to sustain a patent in the

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(*d*) *Per* COLERIDGE, J., *Hills' Patent*, 1 Moo. P. C. (N.S.) 265.

(*e*) *Soames' Patent*, 1 Webst. 735; *Derosne's Patent*, 4 Moo. P. C. 418; *Hazeland's Patent*, 11 R. P. C. 467, 470.

(*f*) *Galloway's Patent*, 1 Webst. 727.

(*g*) *Bovill's Patent*, 1 Moo. P. C. (N.S.) 348.

(*h*) *Heath's Patent*, 2 Webst. 257.

(*i*) *Bell's Patent*, 2 Webst. 160.

(*k*) *Woodcroft's Patent*, 1 Webst. 740.

(*l*) *Bailey's Patent*, 1 R. P. C. 1, 3; *Beanland's Patent*, 4 R. P. C. 489.

(*m*) *McDougal's Patent*, L. R. 2 P. C. 1; *McInnes' Patent*, L. R. 2 P. C. 54; *Sillar's Patent*, reported Goodeve, Pat. Cas. p. 581.

(*n*) *Woodcroft's Patent*, 2 Webst. 29; *Betts' Patent*, 1 Moo. P. C. (N.S.) 49; *McDougal's Patent*, L. R. 2 P. C. 1.

(*o*) *Saxby's Patent*, L. R. 3 P. C. 294. See also *Betts' Patent*, *ubi supra*.

first instance, that is to say, there must be something beyond that merit which, if there were a plea of invalidity on the ground of the inutility of the invention, would support a patent against such a plea (*p*).

NOTE.

Novelty in relation to merit.

So, also, an invention, whether or not it may have sufficient novelty to sustain a patent, may have been so far anticipated as to deprive it of that degree of novelty which is necessary to justify a prolongation (*q*).

Where, however, there was no evidence that the previous invention (which was patented) had produced a workable machine, or had ever been worked at all, though it resembled the patentee's invention in many respects, and the patentee's invention was undoubtedly useful, the objection on the point of novelty was not allowed to prevail, the other considerations being in favour of the patentee (*r*).

Invention not brought into use.

Where the invention has not been brought into use notwithstanding the efforts of the patentee, there is a very strong presumption against its utility (*s*). But this presumption may be rebutted (*t*), as where the subject of the invention has a limited market (*u*), or is an article which would not be used by the public generally, as a soldier's knapsack (*x*), or was of such a nature as not to be likely to come into immediate use (*y*), or where the article would not be likely to be remunerative within the ordinary term of a patent (*z*),or was an article which the public viewed with distrust (*a*). So, also, where, from circumstances beyond the control of the patentee, the merits of the invention have not been sufficiently appreciated (*b*), or where, from illness extending over several years, the result of an accident, the petitioner has been incapacitated from pushing forward his invention (*c*). And the presumption arising from non-user was held to be rebutted where the invention was one of absolute originality and a high degree of merit, and the non-user had arisen from the conviction of the patentee himself that he had not brought his principle into such practical action as would justify him in offering a machine to the public or to the trade (*d*).

(*p*) *Per* Sir W. GROVE, *Stoney's Patent*, 5 R. P. C. 520.

(*q*) *Stewart's Patent*, 3 R. P. C. 7.

(*r*) *Church's Patents*, 3 R. P. C. 95, 102.

(*s*) *Allan's Patent*, L. R. 1 P. C. 507 ; *Simister's Patent*, 1 Webst. 723 ; *Bakewell's Patent*, 15 Moo. P. C. 385 ; *Hall's Patent*, 12 R. P. C. 401 ; *Dolbear's Patent*, 13 R. P. C. 203.

(*t*) *Allan's Patent*, L. R. 1 P. C. 507 ; *Bakewell's Patent*, 15 Moo. P. C. 385 ; *Hughes' Patent*, 4 App. Cas. 174.

(*u*) *Herbert's Patent*, L. R. 1 P. C. 399 ; *Ruthven's Patent*, Johnson Pat. Man. 213.

(*x*) *Berrington's case*, cited in *Hughes' Patent*, 4 App. Cas. 179, and Higgins' Digest, p. 274.

(*y*) *Southworth's Patent*, 1 Webst. 487 ; *Semet and Solvay's Patent*, [1895] A. C. 78, 81.

(*z*) *Jones' Patent*, 1 Webst. 579.

(*a*) *Payne's Patent*, cited Higgins' Digest, p. 266.

(*b*) *Kollman's Patent*, 1 Webst. 565.

(*c*) *Roper's Patent*, 4 R. P. C. 201.

(*d*) *Southby's Patent*, [1891] A. C. 432.

Sect. 25 (4).

NOTE.

Circumstances in *favour of* extension.

So, also, effect will be given in favour of extension to the circumstance that the invention had been violently resisted in the trade (*e*), that litigation had prevented the patentee and his assignees from receiving remuneration (*f*), or that the patentee had been in embarrassed circumstances (*g*).

And in every case where the invention has not been actually used the question is whether the evidence is sufficient to rebut the presumption arising from its non-use that the invention is one of no practical utility, and where there was strong and unanswered evidence of utility an extension was granted, although the invention had not been used in England during the whole term (*h*).

But it is not enough to rebut the presumption of inutility to allege that the invention can only be carried on by a company, and that existing companies would not adopt it (*i*).

Profits of patent to be shown.

Necessity of accurate accounts.

"**Profits made by the patentee as such.**"—An applicant for prolongation has always been required to produce to the judicial committee accounts showing in the clearest manner the profit and loss of working the patent (*k*), and the *onus* is upon him of satisfying the committee, in a manner which admits of no controversy, what has been the amount of remuneration which, in every point of view, the invention has brought to him, and it is his duty to frame his accounts in such a shape as to leave no doubt on this point (*l*).

For this purpose the patentee should be prepared to give the clearest evidence of everything which has been paid and received on account of the patent, and should keep distinct and separate patent accounts (*m*). And the fact that a patentee has for sufficient reasons destroyed his books will not relieve him from the consequences of being unable to furnish proper accounts (*n*). And where the accounts were not statements which appeared in the books but were only the accountant's corrections of the books, and the books had been so kept that it was impossible without a very long, minute, and laborious investigation to say whether the patentee had or had not been adequately remunerated, the accounts were held insufficient, and the petition was dismissed (*o*).

(*e*) *Roberts' Patent*, 1 Webst. 573; *Stafford's Patent*, 1 Webst. 563.

(*f*) *Pettit Smith's Patent*, 7 Moo. P. C. 133; *Heath's Patent*, 2 Webst. 257.

(*g*) *Wright's Patent*, 1 Webst. 575; *Southworth's Patent*, *ubi supra*.

(*h*) *Hughes' Patent*, 4 App. Cas. 174.

(*i*) *Bakewell's Patent*, 15 Moo. P. C. 385.

(*k*) *Trotman's Patent*, L. R. 1 P. C. 118; *Betts' Patent*, 1 Moo. P. C. (N.S.) 49; *Hills' Patent*, 1 Moo. P. C. (N.S.) 258.

(*l*) *Saxby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, L. R. 3 P. C 421.

(*m*) *Betts' Patent*, 1 Moo. P. C. (N.S.) 61; *Adair's Patent*, 6 App. Cas. 178.

(*n*) *Yates and Kellett's Patent*, 12 App. Cas. 149.

(*o*) *Lake's Patent*, [1891] A. C. 240.

Where the only evidence of utility was as to one part of the invention, and the accounts did not show that the expenditure charged related only to that part, they were considered unsatisfactory, and an extension was refused (*p*). It is a question to be considered in each particular case whether it is or is not justifiable for a patentee to state his items of expense in a lump, or whether it is necessary to disentangle them so that they may be judged of separately (*q*). Sect. 25 (4). — NOTE.

Under the old practice the balance sheet was to be handed over to the Solicitor for the Treasury before the hearing (*r*). By the new rules, three copies of the balance sheet are to be furnished for his use at least fourteen days before the day fixed for hearing, and he is to have facilities for inspecting and taking extracts from the petitioner's books of accounts (*s*).

Profits of licensees to be included.

It must be remembered that the question is not what the patentee has received, but what has been made, or by proper judgment and application might have been made, by the patent, and therefore the profits made by licensees must appear in the accounts (*t*). There may be circumstances under which the petitioner may not be bound to show the profits of licensees who have paid royalties. But the case of persons having a free licence stands on an entirely different footing, and their profit must be shown (*u*).

And of foreign patents.

The applicant must also show what are the profits derived from any foreign patents he may have for the invention, as well as the profits from the English patent (*x*), and also the profits from the sale of the patented article for exportation (*y*). In strictness these should be stated in the petition (*z*).

Although the words "profits of the patentee as such" specify one particular class of profits as absolutely necessary to be considered, there is nothing in the section to intimate that the committee are not to look at other classes of profits, and the accounts relating to foreign patents must still, as hitherto, be produced (*a*).

And when the patent rights have been transferred wholly or in part to a company, it is essential that there should be deposited, not only the patentee's accounts of his profits, but also the account of the profits of

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(*p*) *Willaoy's Patent*, 5 R. P. C. 690.

(*q*) *Thomas and Gilchrist's Patent*, 9 R. P. C. 367, 372.

(*r*) *Perkin's Patent*, 2 Webst. 14.

(*s*) Judicial Committee Rules, r. iii. *post*.

(*t*) *Trotman's Patent*, L. R. 1 P. C. 123; *Saxby's Patent*, L. R. 3 P. C. 298; *Hills' Patent*, 1 Moo. P. C. (N.S.) 258, 268; *Lane Fox's Patent*, 9 R. P. C. 411.

(*u*) *Thomas and Gilchrist's Patent*, 9 R. P. C. 367, 372.

(*x*) *Johnson's Patent*, L. R. 4 P. C. 82 (disapproving of *Poole's Patent*, L. R. 1 P. C. 517); *Adair's Patent*, 6 App. Cas. 178; *Bower-Barff Patent*, [1895] A. C. 675.

(*y*) *Hardy's Patent*, 6 Moo. P. C. 441.

(*z*) *Bower-Barff Patent*, *ubi supra*.

(*a*) *Newton's Patents*, 9 App. Cas. 592.

Sect. 25 (4). the company to whom the patent has been transferred (*b*). So, also, where a third share in the patent had been assigned to persons to whom a free licence was given, it was held that the profits made by virtue of the assignment of the third share, so far as the manufacturing profits were assignable to the patent, and also the profits made by the use of the free licence as compared with the profits made by other persons who had paid royalties, ought to appear in the accounts (*c*).

Note.

Where the patentee had in consideration of a sum of money paid by a company, assigned the patent to the company subject to a licence, and the company paid the consideration money not to the patentee but to the licensee, and worked the patent and granted licences and afterwards re-assigned to the patentee, it was held that the accounts ought to show an account of the original transaction and of the licence, and of the working of the patent in the hands of the company, and this not having been done, the petition was dismissed (*d*).

And where the patent was assigned by the petitioner to a company subject to certain mortgages which the company undertook to pay off, the omission of any reference to the transaction in the accounts was held a fatal objection to the petition (*e*).

The remuneration from the patent as a whole is to be looked to (*f*). And for this purpose the prices received on sales of the patent by the patentee and successive assignees may be added together (*g*).

Allowances in accounts.

An allowance may be made in the accounts to a patentee who is a manufacturer for his personal superintendence of the business of the patent (*h*), and a patentee may deduct his personal expenses for the exclusive devotion of his time in bringing the invention into practical operation and public notice (*i*). But if such allowances or deductions are claimed, the claim must appear on the petition or the accounts, otherwise no evidence can be given or argument addressed to the judicial committee in support of them (*k*).

So, also, when the petitioner desires to claim that certain of his profits should not be considered "profits of the patentee as such," notice should be given either in the petition or the accounts, that such a claim is to be made (*l*).

(*b*) *Deacon's Patents*, 4 R. P. C. 119; *Lane Fox's Patent*, 9 R. P. C. 411.

(*c*) *Thomas and Gilchrist's Patent*, 9 R. P. C. 367.

(*d*) *Lane Fox's Patent*, 9 R. P. C. 411.

(*e*) *Lane Fox's Patent*, *ubi sup.*

(*f*) *Perkin's Patent*, 2 Webst. 9 See also *Furness' Patent*, 2 R. P. C. 175.

(*g*) *Carmont's Patent*, 14 R. P. C. 239.

(*h*) *Perkin's Patent*, 2 Webst. 8, 17; *Roberts' Patent*, 1 Webst. 575.

(*i*) *Carr's Patent*, L. R. 4 P. C. 539; *Newton's Patent*, 14 Moo. P. C. 156; *Roberts' Patent*, 1 Webst. 575.

(*k*) *Bailey's Patent*, 1 R. P. C. 1.

(*l*) *Bailey's Patent*, *ubi supra.*

Sect. 25 (4) — Note.

But where the patentee did not manufacture but only granted licences, a charge for expenses in visiting and superintending the licensees' establishments was disallowed (*m*).

An allowance may also be made for the expenses of taking out and defending the patent (*n*), and for experiments (*o*).

But though deductions for law expenses in defending the patent are in general a fair head of deduction, still, if the patentee has compromised actions and given up claims to costs to which he had an apparent title, it is not proper to deduct these expenses in an unexplained lump (*p*).

A foreign patentee residing abroad may also be allowed to deduct moneys paid by him to an agent for the purpose of getting the patented article into use in England (*q*).

Where a patentee has sold his patent for a small sum when it was thought to be of little value, and afterwards bought it back at an increased value, the item was not allowed in the accounts as one of loss (*r*).

In *Darby's Patent* (*s*), where the patentee had clearly suffered a very heavy loss in endeavouring to introduce his invention, a prolongation was granted although the accounts had not been accurately kept during the first three years of the patent.

Manufacturers' profits to be taken into account.

The judicial committee also require that the profits made by the patentee as manufacturer, although not in a strict point of view profits of the patent, should be taken into consideration on the question of remuneration. It may be that possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer (*t*). In such a case it was held that the two heads of profit could not be severed, and a very considerable sum having been in fact received, an extension was refused (*u*). And this principle was applied to manufacturing profits arising from the manufacture of the materials of which the patented article was made (*x*).

(*m*) *Trotman's Patent*, L. R. 1 P. C. 125.

(*n*) *Roberts' Patent*, 1 Webst. 575; *Kay's Patent*, 1 Webst. 572; *Galloway's Patent*, 1 Webst. 729; *Betts' Patent*, 1 Moo. P. C. (N.S.) 49.

(*o*) *Kay's Patent*, 1 Webst. 572.

(*p*) *Hills' Patent*, 1 Moo. P. C. (N.S.) 258, 268.

(*q*) *Poole's Patent*, L. R. 1 P. C. 514.

(*r*) *Wield's Patent*, L. R. 4 P. C. 89.

(*s*) 8 R. P. C. 380, 384.

(*t*) *Saxby's Patent*, L. R. 3 P. C. 295; *Betts' Patent*, 1 Moo. P. C. (N.S.) 49; *Hills' Patent*, 1 Moo. P. C. (N.S.) 258; *Johnson's Patent*, L. R. 4 P. C. 75; *Willans and Robinson's Patent*, 13 R. P. C. 550.

(*u*) *Muntz's Patent*, 2 Webst. 121. See also *Saxby's Patent*, L. R. 3 P. C. 292.

(*x*) *Newton's Patent*, Eng. Rep. Jan. to Mar. 1681, xvi.

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Salesman's profits.

Where a considerable profit on the sale of the patented article had been made, the judicial committee refused to consider the difference between the actual cost of the article and the receipts on the sale (which difference was large) as mere profit made by the patentee as salesman, but considered that a great portion of that sum was profit which the patentee received, because having the patent he was able to sell the article (*y*).

But deductions for these sometimes allowed.

The principle, however, was not to be pushed to an unreasonable extreme (*z*), and in some cases the profits as manufacturer have been deducted in ascertaining the profits of the patent (*a*). But the committee refused to accept as reasonable, without explanation, an estimate by the patentee that the manufacturing profits were two-thirds of the total profits (*b*).

When the patent is worked as part of a general manufacturing business, the accounts should be so kept as to show every thing which would apply to the patent business, and when this had not been done and the accounts did not show satisfactorily that the various items charged were attributable to the patent part of the business only, and not to the factory portion, extension was on that ground refused (*c*).

Practice when accounts imperfect.

The hearing of a petition has been adjourned for the purpose of enabling the petitioner to produce further evidence as to his profits, but this was only as an indulgence (*d*), and would probably not be now allowed (*e*). An adjournment was refused when the objection was the absence of accounts of certain foreign patents, and the attention of the petitioner had in the grounds of objection delivered by the opponents been called to the omission (*f*). And where accounts were unsatisfactory, extension was refused even though the committee considered the invention meritorious, and were not satisfied that the petitioner had been sufficiently remunerated (*g*).

If the accounts are on the face of them unsatisfactory, the committee will adjudicate on the accounts without reference to the merits of the invention (*h*); but if the accounts are *primâ facie* satisfactory, the

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(*y*) *Bailey's Patent*, 1 R. P. C. 1.

(*z*) *Hills' Patent*, 1 Moo. P. C. (N.S.) 258, 270.

(*a*) *Betts' Patent*, 1 Moo. P. C. (N.S.) 49; *Galloway's Patent*, 1 Webst. 729.

(*b*) *Hills' Patent, ubi supra.*

(*c*) *Duncan and Wilson's Patent*, 1 R. P. C. 257.

(*d*) *Perkin's Patent*, 2 Webst. 17; *Heath's Patent, Ibid.* 256.

(*e*) See *Clark's Patent*, L. R. 3 P. C. 421.

(*f*) *Newton's Patents*, 9 App. Cas. 592; 1 R. P. C. 177.

(*g*) *Adair's Patent*, 6 App. Cas. 178.

(*h*) *Saxby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, L. R. 3 P. C. 421; *Wield's Patent*, L. R. 4 P. C. 89; *Newton's Patents*, 9 App. Cas. 592.

petitioner will be allowed to prove the merits without going first into the accounts (*i*).

NOTE.

Opposers have not been allowed production and inspection of the petitioner's accounts prior to the hearing (*k*), but under the Judicial Committee's Rules they can obtain copies of the accounts lodged by the petitioner. See Judicial Committee Rules, r. V., *post*.

Some forms of accounts will be found in the Appendix, *post*.

"All the circumstances of the case."—It has been considered that it is no objection to an extension that during the existence of the patent an Act of Parliament has been passed which might in effect compel the use of the patented article (*l*).

The applicant must show that he has used his best endeavours to introduce his invention (*m*). If he has slumbered on his rights and permitted parties to infringe with impunity (*n*), or if there has been intentional delay on his part in bringing out the invention (*o*), or the proper working the invention has been postponed by reason of disputes between the co-owners of the patent (*p*), extension may be refused. The petitioner ought also to be able to show that he has been ready to give the public the benefit of his invention by granting licences on fair terms (*q*). And in any case he must prove that the circumstances have ceased which prevented the invention being lucrative, and that it is really coming into use (*r*).

The fact that the petitioners had taken out a patent for an improved machine which had almost shut out the use of the original patent has been taken into consideration against the petitioners (*s*).

The costly experiments of the inventor should be taken into account (*t*).

Imported inventions.

The merit of an importer is less than that of an inventor (*u*), but in a proper case an importer may obtain an extension (*x*).

The circumstances, however, that the invention was imported, and that the owners of the English patent were foreigners, who made the

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(*i*) *Houghton's Patent*, L. R. 3 P. C. 461.

(*k*) *Bridson's Patent*, L. R. 7 Moo. P. C. 499.

(*l*) *Evarde's Patent*, 9 Moo. P. C. 376.

(*m*) *Hanlball's Patent*, 9 Moo. P. C. 393; *Norton's Patent*, 1 Moo. P. C. (N.S.) 339.

(*n*) *Simister's Patent*, 1 Webst. 723.

(*o*) *Norton's Patent*, 1 Moo. P. C. (N.S.) 339.

(*p*) *Patterson's Patent*, 6 Moo. P. C. 469.

(*q*) See *Stewart's Patent*, 3 R.P.C. 7, 10.

(*r*) *Woodcroft's Patent*, 2 Webst. 29.

(*s*) *Nussey and Leachman's Patent*, 7 R. P. C. 22.

(*t*) *Per* Lord WATSON, *Davies' Patent*, 11 R. P. C. 28.

(*u*) *Soames' Patent*. 1 Webst. 733; *Johnson's Patent*, (Willcox & Gibbs), L. R. 4 P. C. 75; *Bell's Patent*, 2 Webst. 160; *Claridge's Patent*, 7 Moo. P. C. 394.

(*x*) *Berry's Patent*, 7 Moo. P. C. 187; *Claridge's Patent*, *ubi supra*.

Sect. 25 (4). article abroad and sent it over to England for sale, were considered as being against a prolongation (*y*).

Note. The fact that the patentee at a late period of the patent disclaimed part of the invention has been urged, and apparently successfully, against an extension, as if granted, it would interfere with what others had been doing in reliance on the invalidity of the patent (*z*).

A patent granted to an English inventor may be renewed though a foreign one taken out by the same inventor for the same invention has been allowed to expire (*a*).

Expiry of foreign patent. Section 25 of the Act of 1852 (see *post*, p. 346), repealed by the present Act, and not re-enacted, provided that where a foreign patent had been granted before the date of the English patent, the rights under the latter should determine with the determination of the foreign patent. And the judicial committee were accustomed to act on the spirit of this enactment in cases which were not actually within the letter of the statute, and where the patentee in England was a foreigner, would refuse extension if the foreign patents, even though subsequent in date to the English patent, had expired or were on the point of expiring (*b*).

Now, however, applications under the present Act are to be dealt with on the footing that the above-mentioned enactment has been repealed, and extensions may be granted in all cases notwithstanding the expiry of foreign patents for the invention (*c*).

But the lapse on expiry of foreign patents is still one of the circumstances to be taken into consideration (*d*).

The circumstance that the patent sought to be prolonged is the last survivor of several patents, the others of which were foreign, is a great obstacle to granting a renewal of it. And in such a case when the patent had not been pushed in the earlier part of its existence, and the invention was not of rare or exceptional merit, extension was refused (*e*).

Where the foreign and English patents represented concurrent and independent inventions by different inventors and the foreign patent was shortly about to expire, it was held that no prolongation of the English patent would be granted (*f*).

Applications by assignees. An assignee has not been viewed with the same favour as the original patentee (*g*), and applications by assignees when no benefit could come

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(*y*) *Johnson's Patent*, L. R. 4 P. C. 80; *Pitman's Patent*, *Ibid.* 88.

(*z*) *Sinister's Patent*, 1 Webst. 723.

(*a*) *Adair's Patent*, 6 App. Cas. 176; *Johnson's Patent*, L. R. 4 P. C. 75.

(*b*) *Winan's Patent*, L. R. 4 P. C. 93; *Blake's Patent*, L. R. 4 P. C. 535; *Newton's Patent*, 15 Moo. P. C. 176; *Normand's Patent*, L. R. 3 P. C. 193.

(*c*) *Semet and Solvay's Patent*, [1895] A. C. 78.

(*d*) *Semet and Solvay's Patent*, *ubi supra*.

(*e*) *Pieper's Patent*, 12 R.P.C. 292.

(*f*) *Hills' Patent*, 1 Moo. P. C. (N.S.) 258.

(*g*) *Norton's Patent*, 1 Moo. P. C. (N.S.) 339; *Claridge's Patent*, 7 Moo. P. C. 394; *Normand's Patent*, L. R. 3. P. C. 193.

to the patentee have been refused (*h*). So, also, when the patentee would have no legitimate interest in making the application, as for instance, when he has been sufficiently remunerated at the expense of the public (*i*).

Conditions for the benefit of the patentee have, where extension has been granted to assignees, been inserted in the new letters patent (*k*).

And when a petition was presented by a patentee and his mortgagees extension has been granted to the patentee alone (*l*). Where, however, the patent had been mortgaged and the mortgagee was not a party to the petition, extension was only granted on the terms that the petitioner should undertake to give to the mortgagee the same security over the new letters patent as he had over the existing patent (*m*).

But extension may be granted to an assignee without any such conditions as above, if the patentee has ceased to have any connection with the working of the patent (*n*), or has received a large sum from the assignee (*o*).

Exclusive licence.

An agreement by a patentee to grant an exclusive licence to a company, and to obtain an extension of the patent, was held to be against public policy, and an application for extension by the patentee was refused (*p*).

The grant of an exclusive licence during the term is a point not in favour of the prolongation of a patent, but this circumstance was not considered in a case where the invention was of great merit and the patentee had suffered heavy loss and the licensee claimed no benefit under the new patent if granted (*q*), nor where the patentee had granted an exclusive licence because he could not otherwise introduce his invention into use and the exclusive licensees agreed to waive all rights under their licence (*r*).

Considerations in favour of assignees

In applications by assignees the judicial committee have considered in some respects the expenses incurred by the assignee in bringing the patent into notice, and the merit of the assignee in patronizing the patentee, but the general rule is, as was stated by Lord BROUGHAM in *Morgan's Patent* (*s*), that "they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that

(*h*) *Norton's Patent*, *ubi supra*; *Pitman's Patent*, L. R. 4 P. C. 87.

(*i*) *Bower-Barff Patent*, [1895] A. C. 675; *Hopkinson's Patent*, [1897] A. C. 249.

(*k*) See *post*, p. 119.

(*l*) *Borill's Patent*, 1 Moo. P. C. (N.S.) 348.

(*m*) *Church's Patents*, 3 R. P. C. 95.

(*n*) *Napier's Patent*, 13 Moo. P. C. 543.

(*o*) *Bodmer's Patent*, 6 Moo. P. C. 469.

(*p*) *Cardwell's Patent*, 10 Moo. P. C. 488.

(*q*) *Darby's Patent*, 8 R. P. C. 380.

(*r*) *Shone's Patent*, 9 R. P. C. 439.

(*s*) 1 Webst. 738.

Sect. 25 (4). NOTE.

the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified" (*t*).

Company assignees.

And there appears to be no reason why, where a patentee assigns to a company, not being himself able to bring out the patent, the company should not have the benefit (*u*).

Extension was granted to a company which had bought the patent for a lump sum paid to the patentee and the allotment to him of a certain number of paid-up shares, and had spent, in trying to introduce the invention, considerable sums without profit either to the company or to the patentee who had received no dividends on his shares (*x*). So, also, where the company had owned certain other patents and the patent sought to be prolonged had been assigned to them under a covenant to assign future improvements and the patentee was a considerable shareholder in the company (*y*).

And where a patentee had suffered great loss in trying to introduce his invention and had entered into an agreement with three persons who had agreed to assist him in presenting a petition and to give him further assistance in the event of the patent being prolonged on the terms that the patentee should have a third share of the profits, an extension was granted (*z*).

But where the assignees were a company who bought the patent for the purpose of trading with it, and not for any purpose by which any benefit could come to the inventor, who had long since died, extension was refused (*a*). So, also, where the assignees were a company who having bought the patent made a considerable sum of money by selling their shares at a premium to stockbrokers on the Stock Exchange, and it was considered that the company took over the invention and carried on their operations for the purpose of speculating rather than benefiting the public (*b*).

Where a company is petitioner, the petition should always contain a statement as to whether any, and, if so, what dealings have taken place in its shares (*c*).

(*t*) *Per* Sir J. COLVILE, *Pitman's Patent*, L. R. 4 P. C. 87. See also *Berry's Patent*, 7 Moo. P. C. 187.

(*u*) See *per* Lord WATSON, *Davies' Patent*, 11 R. P. C. 27, 28. See also as to this, *Berry's Patent*, 7 Moo. P. C. 187.

(*x*) *Houghton's Patent*, L. R. 3 P. C. 461. See also *Davies' Patent*, 11 R. P. C. 27.

(*y*) *Davies' Patent*, 11 R. P. C. 27.

(*z*) *Darby's Patent*, 8 R. P. C. 380.

(*a*) *Re Electric Telegraph Co.*, cited in *Norton's Patent*, 1 Moo. P. C. (N.S.) 329; *Bower-Barff Patent*, [1895] A. C. 675; *Hopkinson's Patent*, [1897] A. C. 249.

(*b*) *Sillar's Patent*, Goodeve, P. C. 581. See also *Lane Fox's Patent*, 9 R. P. C. 411.

(*c*) Per Lord WATSON, *Barff's and Bower's Patent*, 12 R. P. C. 383, 385.

When the patent has been mortgaged by assignment, the mortgagee, as the legal owner, ought to concur in the petition (*d*). Sect. 25(4): Note.

The assignee's title must be strictly proved, whether admitted or not (*e*). An equitable assignee cannot appear as co-petitioner unless his name has been inserted in the advertisements (*f*).

It has never been the practice of the judicial committee to decide on the validity of a patent, though they would abstain in any case from prolonging a patent which was manifestly bad (*g*). A *primâ facie* case of validity was all that was required, the question being left to the determination of the Courts of Law (*h*), and consistently with this view, applications for extension have been entertained while proceedings impeaching the patent were actually pending (*i*). Validity how far considered.

The committee have, however, where on the face of the specification it appeared doubtful whether the alleged invention was proper subject-matter of a patent, refused, in the exercise of their discretion, to grant a prolongation (*k*); and they will also consider the question of novelty in reference to the merit of the invention (*l*).

And where the specification of a patent for expanding flues for boilers was framed so as to make success dependent on "certain scientific proportions" or on "certain mathematically determined proportions" without any definition of those proportions, and it was shown that the petitioner's profits had been derived from building furnaces and that there was no instance of the grant of a licence under which the licensee had constructed his own furnace, an extension was refused (*m*).

Sub-section (5).

"Inadequately remunerated," etc.—The question is whether, having regard to the merit of the invention, the judicial committee are able to report to Her Majesty that the patentee has been inadequately remunerated by his patent, and unless their lordships can make such a report Her Majesty has no power to extend the term of the patent (*n*). Remuneration.

When there was a doubt as to the merit of the invention and the profits of the patent had been 12,000*l.*, an extension was refused (*o*).

(*d*) *Church's Patents*, 3 R.P.C. 95.

(*e*) *Galloway's Patent*, 1 Webst. 725; *Wright's Patent*, 1 Webst. 561.

(*f*) *Noble's Patent*, 7 Moo. P. C. 191.

(*g*) *Hills' Patent*, 1 Moo. P. C. (N.S.) 252; *Saxby's Patent*, L. R. 3 P. C. 294; *Cooking's Patent*, 2 R. P. C. 153; *Erard's Patent*, 1 Webst. 557.

(*h*) *Kay's Patent*, 1 Webst. 568.

(*i*) *Kay's Patent*, *ubi supra*; *Heath's Patent*, 2 Webst. 257; *Lane Fox's Patent*, 9 R. P. C. 411.

(*k*) *McDougal's Patent*, L. R. 2 P. C. 1; *McInnes' Patent*, L. R. 2 P. C. 54.

(*l*) *Stewart's Patent*, 3 R. P. C. 7, 10.

(*m*) *Liret's Patent*, 9 R.P.C. 327.

(*n*) *Per* Lord Monkswell, *Furness' Patent*, 2 R. P. C. 175.

(*o*) *Lawrence's Patent*, 9 R.P.C. 85.

Sect. 25 (5).

NOTE.

Statements in a prospectus issued on the formation of the petitioning company were held binding on the question of remuneration, for if untrue, they would bring an amount of discredit into the case which would prevent a prolongation being granted (*p*).

On the question whether a patentee has been adequately remunerated, the judicial committee will take into consideration, in favour of the patentee, the benefit which has resulted to the public as compared with that which the patentee has received (*q*).

If the invention be meritorious, the facts that no profit has been made (*r*), or that from want of capital and means (*s*), or by reason of the costliness of the manufacture, and the consequent necessity of large sales in order to earn profit (*t*), the inventor has not obtained an adequate return, or that a loss has resulted to the petitioner (*u*), or that the remuneration is insufficient having regard to the expense incurred (*x*), are grounds for extension, subject, of course, to the limitations above mentioned, that the want of profit has not arisen from the non-utility of the invention or the default of the owner of the patent (*y*). But extension was refused to an assignee who had purchased the petitioner's stock-in-trade at a fair value and had not lost by the transaction (*z*).

If the remuneration is adequate, it is no ground for extension that it was made only during the last few years of the patent (*a*).

Where the invention was of no great public utility, and the profits of the patentee had been 700*l*., and those of his licensees between 300*l*. and 400*l*., and it was not shown that the patentee had incurred any great expense or great labour in relation to the invention, and it had not interfered with his private business, it was held that the remuneration was not so inadequate as to justify a prolongation (*b*).

Term of extension.

"Extend the term of the patent," etc.—Where a loss had been incurred by the patentee, and there appeared to be no reasonable chance of that loss being counteracted by profit unless seven years'

(*p*) *Lawrence's Patent*, *ubi supra*.

(*q*) *Derosne's Patent*, 2 Webst. 4; *Newton's Patent*, 14 Moo. P. C. 156; *Mallet's Patent*, L. R. 1 P. C. 175.

(*r*) *Houghton's Patent*, L. R. 3 P. C. 461.

(*s*) *Downton's Patent*, 1 Webst. 567.

(*t*) *Mallet's Patent*, L. R. 1 P. C. 175.

(*u*) *Swaine's Patent*, 1 Webst. 560; *Stafford's Patent*, 1 Webst. 564; *Jones' Patent*, 1 Webst. 579; *Napier's Patent*, 6 App. Cas. 174; *Morton's Patent*, Eng. Rep., April to June, 1881, vii.; *Currie and Timmis' Patent*, 15 R. P. C. 63.

(*x*) *Martin's Patent*, Eng. Rep., Jan. to March, 1881, xiii.; *Bates' Patent*, 1 Webst. 739.

(*y*) *Ante*, pp. 105, 111.

(*z*) *Quarrill's Patent*, 1 Webst. 740.

(*a*) *Ryder's Patent*, cited Johnson Pat. Man. 213.

(*b*) *Beanland's Patent*, 4 R. P. C. 489.

extension were granted, the patent was extended for that term (*c*). So also, where pending litigation would be likely to prevent the parties availing themselves of the extension (*d*).

The general considerations which guide the judicial committee as to the term of extension are mentioned in *Stoney's Patent* (*e*).

"**In exceptional cases.**"—Under the Act of 1844, which allowed extension for fourteen years if a petition was presented setting forth that the patentee had been unable to obtain sufficient remuneration, and that seven years' extension would not suffice, it was held that the petition ought to contain the latter averment in order to obtain an extension of more than seven years, and leave to amend at the hearing by adding this averment was refused (*f*).

Where the invention is one which is not likely to be used except by the Government, the judicial committee rely very much on what is said in favour of the invention by those who represent the Crown (*g*).

When the Attorney-General admitted the merit of the invention and stated that the view of the Crown was in favour of a moderate prolongation, the judicial committee required the evidence of one engineer and of the patentee to be given (*h*).

But it is not a matter of course that a patent should be extended, even though the Attorney-General offers no objection, and the application is otherwise unopposed (*i*).

A detailed statement of several cases of application for prolongation, showing in each instance the remuneration made and the term of extension granted, will be found in Johnson's Patentees' Manual, 6th edition, pp. 209 to 215, from which it will appear that the usual practice of the judicial committee has been to grant extensions only for periods of less than seven years. This limit has, however, occasionally been exceeded, as in *Ruthven's Patent* for water-propellers, and in *Darby's Patent* (*k*) and *Stoney's Patent* (*l*), when an extension for ten years was granted. In the latter case, the invention was one which could only be profitably applied in certain large undertakings, which must be few and far between, and in *Darby's Patent*, the invention was of exceptional merit and there was great difficulty in introducing the

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(*c*) *Jones' Patent*, 1 Webst. 579; *Bischof's Patent*, 1 R. P. C. 162. See also *Darby's Patent*, 8 R. P. C. 380.

(*d*) *Heath's Patent*, 2 Webst. 257.

(*e*) 5 R. P. C. 518, 523.

(*f*) *Newton's Patent*, Eng. Rep. Jan. to Mar. 1881, xv.

(*g*) *Hughes' Patent*, 4 App. Cas. 179, citing *Berrington's Case and Ruthven's Patent*.

(*h*) *Joy's Patent*, 10 R. P. C. 89. See also *Darby's Patent*, 8 R. P. C. 380, 383.

(*i*) *Cardwell's Patent*, 10 Moo. P. C. 490.

(*k*) 8 R. P. C. 380. See also *Currie and Timmis' Patent*, 3 R. P. C. 63.

(*l*) 5 R. P. C. 518.

Sect. 25 (5). machines into use, and the patentee had, in endeavouring to push his invention, suffered heavy losses which it was not likely he could recover in any short space of time.

NOTE.

New patent. "**Grant of a new patent.**"—It is the practice of the judicial committee to confer the extension by ordering the grant of a new patent(*m*). The order fixes a term within which application for the new patent is to be made (*n*).

The grant of a new patent under the repealed Acts did not preclude a contention in a court of law that the Crown had, under the circumstances, no power to grant an extension (*o*), and there is nothing to alter the law in this respect in the present Act.

Under the Act of 1835, it was held that renewed letters patent were not void if granted after the expiration of the term, if the preliminary steps required by s. 4 of that Act were taken before the term ended (*p*), and this seems to be still the law if the provisions of sub-s. (1) are complied with.

Under the old practice new letters patent must be granted to parties having a legal interest in the existing letters patent(*q*), as a mortgagee (*r*), or the administrator of a deceased patentee (*s*), or the executors of a surviving assignee (*t*), or to trustees of a company (*u*) or the patentee being the agent for the foreign inventor (*x*).

Where an annuity to the patentee is part of the terms of the extension, the new letters patent may recite the conditions and contain a proviso avoiding the same if the annuity be not paid (*y*); or the letters patent may be withheld until the petitioner has executed a proper annuity deed (*z*).

Every new grant of letters patent was under the repealed Acts a graft on the original grant, and had no existence apart from the parent grant (*a*). This appears also to be the case with a new grant under the present Act, and accordingly no new specification need be filed (*b*).

(*m*) *Stoney's Patent*, 5 R. P. C. 524.

(*n*) Seton, 1984.

(*o*) *Russell* v. *Ledsam*, 14 M. & W. 583; 1 H. L. C. 687. See also *Bovill* v. *Finch*, L. R. 5 C. P. 523.

(*p*) *Russell* v. *Ledsam*, 14 M. & W. 575; 1 H. L. C. 687.

(*q*) *Southworth's Patent*, 1 Webst. 488.

(*r*) *Southworth's Patent, ubi supra;* but see *Church's Patents*, 3 R. P. C. 95.

(*s*) *Heath's Patent*, 2 Webst. 247; *Downton's Patent*, 1 Webst. 565.

(*t*) *Bodmer's Patent*, 6 Moo. P. C. 469.

(*u*) *Pettit Smith's Patent*, 7 Moo. P. C. 133.

(*x*) *Newton's Patent*, 14 Moo. P. C. 156.

(*y*) *Whitehouse's Patent*, 1 Webst. 476, note (*h*). See also *ibid.* 723.

(*z*) *Morton's Patent*, Eng. Rep., Apr. to June, 1881, vii.

(*a*) *Bovill* v. *Finch*, L. R. 5 C. P. 523, 533.

(*b*) *Wastency Smith's Patent*, 2 R. P. C. 14.

But a new grant is so far a new patent that it will be subject to the provisions of ss. 22 and 27 of the present Act (*c*). Sect. 25 (5).

Where the petition had been presented by the patentee and the assignees of a moiety of the patent, and the patentee died before the hearing of the petition, leaving his widow sole executrix and residuary legatee, the new patent was, with her consent, granted to the assignees upon trust that they should hold one moiety in trust for the widow (*d*). NOTE.

If the invention is used in the interval between the expiry of the old patent and the grant of the new patent, the persons using are not liable (*e*).

"Restrictions, conditions, and provisions."—It has been the practice of the judicial committee, in cases of applications by assignees for prolongation, to impose conditions in favour of the original inventor (*f*) or his representatives (*g*). Thus the assignee has been required to secure to the inventor an annuity (*h*) or a share of the profits (*i*), and exclusive licensees have been required to renounce all right and benefit under their licence (*k*). Conditions in favour of inventor.

On the other hand, conditions have been imposed on a patentee in favour of persons who have acquired interests in the patent from him (*l*), or who might be prejudiced by the delay of the patentee in getting the new patent sealed (*m*). Or persons dealing with him.

But such conditions were only imposed when the patentee had made nothing by his patent, and therefore where an assignee had given valuable consideration for the assignment and had sustained loss, the extension was granted without conditions (*n*).

Where a mortgagee was not a co-petitioner, a condition was imposed that the petitioner should undertake to give to the mortgagee the same security over the new letters patent as he had over the existing patent (*o*).

Conditions on behalf of the public have also been imposed, as that the patentee shall grant licences upon terms similar to one already Conditions in favour of the public or the Crown

(*c*) *Wasteney Smith's Patent*, *ubi supra*; *Cooking's Patent*, 2 R. P. C. 161.

(*d*) *Herbert's Patent*, L. R. 1 P. C. 404.

(*e*) *Russell* v. *Ledsam*, 14 M. & W. 583; 1 H. L. C. 687.

(*f*) *Whitehouse's Patent*, 1 Webst. 473 (reported as *Russell's Patent*, 2 Moo. P. C. 496).

(*g*) *Herbert's Patent*, L. R. 1 P. C. 399.

(*h*) *Whitehouse's Patent*, *ubi supra*; *Markwick's Patent*, 13 Moo. P. C. 310; *Russell* v. *Ledsam*, 14 M. & W. 574.

(*i*) *Hardy's Patent*, 6 Moo. P. C. 441; *Morton's Patent*, Eng. Rep., Apr. to June, 1881, vii.

(*k*) *Shone's Patent*, 9 R. P. C. 438.

(*l*) *Normandy's Patent*, 9 Moo. P. C. 452. See also *Baxter's Patent*, 13 Jur. 593.

(*m*) *Schlumberger's Patent*, 8 Moo. P. C. 282.

(*n*) *Bodmer's Patent*, 6 Moo. P. C. 468.

(*o*) *Church's Patents*, 3 R. P. C. 95.

Sect. 25 (5). granted by him (*p*), or shall sell the patented article at a fixed price (*q*), or shall disclaim so much of the specification as relates to parts of the invention not worked out (*r*).

NOTE.

In *Pettit Smith's Patent* (*s*), a condition was inserted requiring the patentee to allow the Crown to use the invention without licence. This condition was refused in *Lancaster's Patent* and *Carpenter's Patent* (*t*); but since the decision in *Dixon* v. *London Small Arms Co.* (*u*), a condition permitting the use of the invention by the Crown, and all contractors employed by the Crown, had become usual in all cases of inventions likely to be required by Government (*x*). But since ss. 22 and 27 apply to new patents granted by way of prolongation, conditions in favour of the Crown are not now inserted (*y*).

Two cognate patents with different terms were extended so that both should expire on the same day (*z*).

Prolongation may be granted for part only of the invention (*a*).

The judicial committee have no jurisdiction to grant a second extension after one prolongation has been granted (*b*).

Where an order has been made by Her Majesty in Council for the extension of a patent for a further term, or for the grant of a new patent, the person in whose favour such order has been made must leave at the Patent Office an office copy of such order (*c*).

SUB-SECTION (6).

Rules have now been made under this sub-section. See Judicial Committee Rules, *post*.

SUB-SECTION (7).

Costs in extension cases.

"**Costs**"—The judicial committee have always considered that it is not desirable to refuse the costs of a fair opposition to applications for prolongation, and that *bonâ fide* opposition should rather be encouraged, in order that the court may be put into possession of all that can be

(*p*) *Mallet's Patent*, L. R. 1 P. C. 308; *Lyon's Patent*, 11 R. P. C. 537.
(*q*) *Hardy's Patent*, 6 Moo. P. C. 441.
(*r*) *Bodmer's Patent*, 8 Moo. P. C. 282.
(*s*) 7 Moo. 133.
(*t*) 2 Moo. P. C. (N.S.) 189, 191.
(*u*) 1 App. Cas. 632.
(*x*) *Hughes' Patent*, 4 App. Cas. 174; *Napier's Patent*, 5 App. Cas. 174.
(*y*) *Wasteney Smith's Patent*, 2 R. P. C. 14; *Cooking's Patent*, 2 R. P. C. 151.
(*z*) *Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87.
(*a*) *Napier's Patent*, 6 App. Cas. 174; *Lee's Patent*, 10 Moo. P. C. 226; *Bodmer's Patent*, *ubi supra*; *Church's Patents*, 3. R. P. C. 95, 102.
(*b*) *Goucher's Patent*, 2 Moo. P. C. (N.S.) 532.
(*c*) P. R., r. 74, *post*.

alleged against the continuance of the patent (*d*). The costs of a successful opposition are therefore in general allowed. But when the committee have not been satisfied with the manner in which the opposition has been conducted, the costs of opposition have been refused (*e*). And where there was no ground for the opposition, the opponents were made to pay the extra costs occasioned thereby (*f*). And when the petition is abandoned, the petitioner will in general have to pay the costs of opposers (*g*).

Sect. 25 (7).

NOTE.

When there was good ground for the opposition, and the case was doubtful, no costs were given to the petitioner, though he was successful in obtaining a prolongation (*h*).

When there are several opponents the petitioner has been ordered to pay a named sum to be divided among the opponents, sometimes with (*i*) and sometimes without (*k*) the option of having the costs of all the opponents taxed in the usual way ; and the petitioner has been allowed time in which to declare his option (*l*).

One set of costs has been given to each set of opponents (*m*) ; and in another case, one set of costs was given between all the opponents (*n*).

It has been considered a reason for giving between two opponents a lump sum for costs that they both represented the same kind of opposition (*o*).

In the case of an abandoned petition there is no need to serve the petitioners with notice of an intended application by the opponents for costs (*p*).

Revocation.

26.—(1.) The proceeding by scire facias to repeal a patent is hereby abolished.

Revocation of patent.

(*d*) *Wield's Patent*, L. R. 4 P. C. 89 ; *Westrupp and Gibbin's Patent*, 1 Webst. 556 ; *Honiball's Patent*, 9 Moo. P. C. 394.

(*e*) *Honiball's Patent*, 9 Moo. P. C. 394. See also *Muntz's Patent*, 2 Webst. 122.

(*f*) *Downton's Patent*, 1 Webst. 567.

(*g*) *Macintosh's Patent*, 1 Webst. 739 ; *Bridson's Patent*, 7 Moo. P. C. 499 ; *Hornby's Patent*, 7 Moo. P. C. 503 ; *Re Milner's Patent*, 9 Moo. P. C. 39 ; *Morgan Brown's Patent*, 3 R. P. C. 212.

(*h*) *Church's Patents*, 3 R. P. C. 95.

(*i*) *Milner's Patent*, 9 Moo. P. C. 39 ; *Hills' Patent*, 1 Moo. P. C. (N.S.) 258 ; *Wield's Patent*, L. R. 4 P. C. 89 ; *Hopkinson's Patent*, [1897] A. C. 249, 253.

(*k*) *Re Schlumberger*, 1 Moo. P. C. (N.S.) 1 ; *Johnson's Patent*, L. R. 4 P. C. 75 ; *Jones' Patent*, 9 Moo. P. C. 41.

(*l*) *Wield's Patent*, L. R. 4 P. C, 89.

(*m*) *Newton's Patent*, Eng. Rep. Jan. to Mar. 1881, xv.

(*n*) *Newton's Patents*, 9 App. Cas. 592 ; 1 R. P. C. 177.

(*o*) *Johnson's Patent*, L. R. 4 P. C. 92.

(*p*) *Bridson's Patent*, 7 Moo. P. C. 499.

Sect. 26 (2).

(2.) Revocation of a patent may be obtained on petition to the Court.

(3.) Every ground on which a patent might, at the commencement of this Act, be repealed by scire facias shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(a.) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

(b.) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

(c.) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :

(d.) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee.

(e.) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true

inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted. Sect. 26 (8).

This section must be read in connection with s. 109, *post*.

Patents for inventions as to which the Secretary of State certifies under s. 44, (3), *post*, are not revocable. See s. 44 (9).

SUB-SECTION (2).

"Petition"—A petition to revoke a patent, by whomsoever presented, is a petition on behalf of the public and is not personal to the petitioner (*q*).

Therefore, a defendant against whom judgment has been given in an action for infringement is not estopped from presenting a petition for revocation of the patent (*r*).

And the fact that a claim of a specification has been held invalid in an action for infringement will not estop the patentee, on a petition by the alleged infringer for revocation, from denying the invalidity of the claim (*s*). Nor, although the court may at the instance of the patentee in an action for infringement have given a wide construction to the specification, is the patentee estopped on a subsequent petition for revocation from insisting on a narrower construction (*t*).

Where the patent was assigned after presentation of the petition for revocation, the name of the assignee was, on payment of a sum into court by the patentee and the assignee, substituted for that of the patentee as respondent (*u*).

The Act contains no provision for service of the petition out of the jurisdiction.

Patentee out of the jurisdiction.

When the petitioner was resident and domiciled in England, and the patentee was resident and domiciled in Scotland, and the petitioner had delivered to the patentee in Scotland a copy of the petition and particulars of objections, and the patentee had written to the petitioner's solicitors that he did not intend to appear at the hearing as he was not subject to the jurisdiction of the English court, and on the petition coming on for hearing the petitioner asked that it might be put into

(*q*) *Deeley's Patent*, [1895] 1 Ch. 687.

(*r*) *Shoe Machinery* v. *Cutlan*, [1896] 1 Ch. 108, 113.

(*s*) *Deeley's Patent, ubi supra.*

(*t*) *Lewis and Stirckler's Patent*, 14 R. P. C. 24.

(*u*) *Re Haddan's Patent*, 2 R.P.C. 218, 219.

Sect. 26 (2). the witness list and tried by *vivâ voce* evidence, an order *nisi* was made for such trial unless the petitioner should appear by a given day and object, and if he appeared it was to be open to him to dispute the jurisdiction (*x*).

NOTE.

And in *Kay's Patent* (*y*), where one of the patentees was out of the jurisdiction, it was held (following the analogy of the procedure in *King & Co.'s Trade Mark* (*z*)) that, if he could not be served, notice of the petition should be given to him. And when notice of the petition and of the time fixed for hearing had, by order of the court, been sent by registered letter to a foreign patentee and he did not appear, the patent was on proof of its invalidity revoked (*a*).

"The Court"—Having regard to sub-s. (4) (a), (b), and to s. 109, "the Court" would seem to be in England the High Court of Justice in England (s. 117), in Scotland the Court of Session, and in Ireland the High Court of Justice in Ireland (s. 111) ; and since the word "patent" means (ss. 46 and 16) letters patent having effect throughout the United Kingdom and the Isle of Man, it appears that revocation for the whole of the United Kingdom may be obtained in the courts (defined as above) of any of the three kingdoms. The Court of the County Palatine of Lancaster was held not to be a court within the meaning of the Act (*b*), except with respect to the particular action and proceedings referred to in s. 112A, *post*. But now by s. 3 of the Chancery of Lancaster Act, 1890 (*c*), that court has, as to all persons and property within its jurisdiction, the same jurisdiction as the Chancery Division of the High Court.

Where an order for revocation has been made, an office copy of the order must be left with the comptroller (*d*).

SUB-SECTION (3).

General rule as to *scire facias*.

Scire facias to repeal letters patent lay in three cases :—

1. When the king doth grant by several letters patent one and the self-same thing to several persons, the first patentee shall have a *sci. fa.* to repeal the second (*e*).

2. When the king doth grant a thing upon a false suggestion, he, *prærogativâ regis*, may by *sci. fa.* repeal his own grant.

(*a*) *Drummond's Patent*, 43 Ch. D. 80 : Seton, 1987.

(*y*) 11 R. P. C. 279. See also *Görz and Höghʼs Patent*, 12 R. P. C. 370.

(*z*) [1892] 2 Ch. D. 462.

(*a*) *Hirschfeld's Patent*, 11 R.P.C. 514.

(*b*) *Proctor* v. *Sutton Lodge Chemical Co.*, 5 R. P. C. 184.

(*c*) 53 & 54 Vict. c. 23.

(*d*) P. R., r. 74, *post*.

(*e*) See *R.* v. *Neilson*, 1 Webst. 671, 672.

3. When the king doth grant anything which by law he cannot grant (*f*). Sect. 26 (3).

As to the second of these rules, the law is thus stated by PARKE, B :— NOTE.

"That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void not against the Crown merely, but in a suit against a third person : *Travell* v. *Carteret* (*g*) ; *Alcock* v. *Cooke* (*h*). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson* (*i*) and *Brunton* v. *Hawkes* (*k*) ; for although the statute invalidates a patent for want of novelty, and consequently by force of the statute the patent would be void so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it" (*l*).

False suggestion avoids patent as against third party as well as against Crown.

Avoids patent altogether when one of two inventions old.

A statement of various grounds on which false suggestion avoids a patent will be found in the Index to Mr. Webster's Reports, p. 751, under the title "False Suggestion."

The grounds on which proceedings might be instituted are stated by Mr. Webster to be "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent" (*m*).

Grounds of *scire facias*.

Thus *scire facias* would lie to repeal a patent when the invention, being a mere application of a known article to a new use, the mode of application not being new, was not the proper subject of a patent (*n*).

So, also, where the specification was insufficient, for the patent being granted on condition of filing a proper description of the invention, an insufficient specification was not a compliance with the condition (*o*).

Some of the above grounds for *scire facias* at the commencement of this Act were more or less dependent on recitals in the patent (*p*).

(*f*) *R.* v. *Mussary*, 1 Webst. P. C. 41 ; citing 4 Inst. 88.
(*g*) 3 Lev. 134.
(*h*) 5 Bing. 340.
(*i*) 8 Taunt. 375.
(*k*) 4 B. & A. 541.
(*l*) *Morgan* v. *Seaward*, 2 M. & W. 544 ; 1 Webst. 196.
(*m*) Webster on the Law and Practice of Letters Patent for Inventions, p. 32.
(*n*) *R.* v. *Cutler*, Macr. P. C. 124.
(*o*) See *R.* v. *Arkwright*, 1 Webst. P. C. 66 ; *R.* v. *Cutler*, Macr. P. C. 137.
(*p*) See Hindmarch on Patents, p. 106.

Sect. 26 (3). There is also a distinction "between such an error in the specification as will render a suggestion in the letters patent false, and such an error in a matter of direction or otherwise as affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility. Other defects in a specification, as insufficiency of description, vitiate by reason of non-compliance with the proviso in the letters patent" (*q*). As the documents on which for the future patents will be granted under this Act, and the form of the patent itself, differ in many particulars from what were in use before this Act, there might have been questions how far such grounds of defence to an action for infringement as were founded on false suggestion are now available, but under this sub-section no such question can, it is submitted, arise (*r*).

Note

In addition to the above grounds of defence and revocation there is now that contained in clause (c), which appears to be new (*s*).

Practice in *scire facias*

Two parties could not have a *scire facias* for the same patent (*t*).

Where a patent was originally granted to two persons it was necessary to join both patentees as defendants, even though one had before the issue of the writ assigned all his share to his co-patentee (*u*).

In *R.* v. *Arkwright* (*x*) it was held that a suggestion on a writ of *scire facias* that "the grant is prejudicial and inconvenient to our subjects in general," was too vague, and evidence on this issue was refused. This was before particulars of objection were required.

Where the trial had ended in a verdict for the Crown it was no ground for a new trial that the patentee could bring further evidence on certain points, he not alleging surprise or any new discovery of evidence (*y*).

Under the old practice in *scire facias* the Lord Chancellor had power to stay proceedings, and apparently could order security for costs to be given (*z*), and, if the action resulted in favour of the Crown, could order the patent to be restored into Chancery to be cancelled (*a*). There is no provision in the present Act for delivering up the patent in the event of revocation.

The fact of a *scire facias* pending was a ground for refusing a non-suit on an objection to a patent (*b*), and when a plaintiff had obtained a

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(*q*) 1 Webst. 42 n.
(*r*) See *Siddell* v. *Vickers*, 39 Ch. D. 92, 106, 109.
(*s*) See *Vincent's Patent*, L. R. 2 Ch. 341.
(*t*) *R.* v. *Neilson*, 1 Webst. 673.
(*u*) *R.* v. *Betts*, 15 Q. B. 540.
(*x*) 1 Webst. P. C. 64 n.
(*y*) *R.* v. *Arkwright*, 1 Webst. 74.
(*z*) *R.* v. *Neilson*, 1 Webst. 672; but see *R.* v. *Prosser*, 14 Bea. 306.
(*a*) *R.* v. *Newton*, Hindmarch on Patents, p. 427. As to the jurisdiction of the Lord Chancellor after judgment, see *R.* v. *Eastern Archipelago Co.*, 4 D. M. & G. 199.
(*b*) *Haworth* v. *Hardcastle*, 1 Webst. P. C. 485.

verdict in an action for infringement, and subsequently a *scire facias* was sued out, and a rule obtained to show cause why a non-suit in the action should not be entered, the Court refused to enlarge the time for this rule till after the trial in the *scire facias*; and Sir N.C. TINDAL, C.J., said, that even if the *scire facias* availed, and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objection taken at the trial of the action for infringement (*c*).

Sect. 26 (3). NOTE.

SUB-SECTION (4).

4 (a). There appears to be a limitation on proceedings for revocation in Scotland which does not affect such proceedings in England or Ireland, inasmuch as by s. 109 it is provided that proceedings in Scotland for revocation shall be in the form of an action of reduction, at the instance of the Lord Advocate, or at the instance of a party *having interest* with his concurrence, which concurrence may be given on just cause shown only. On the principle stated by JESSEL, M. R., in *Ex parte Stephens* (*d*), "that when there is a special affirmative power given which would not be required because there is a general power, it is always read to import the negative, and that nothing else can be done," it would seem, on comparing the present section with s. 109, that the latter is to be read as limiting the former, and that in Scotland clauses (c), (d), and (e) are not available unless with the Lord Advocate's concurrence, and that revocation can only be had in the Scotch Courts under the conditions mentioned in s. 109.

Action of reduction in Scotland, Lord Advocate's concurrence always required.

4 (b). By s. 109 the party at whose instance the proceedings are taken in Scotland must have *an interest*. There are no such words in this sub-section. Under the old practice, however, although in the above case of *R.* v. *Mussary* (*e*) it is stated, on the authority of *Butler's case* (*f*), that when a patent is granted to the prejudice of a subject, the King of right is to permit him upon his petition to use his name for the repeal of it, it was also said that the subject had not a right *mero motu* to have a *scire facias* (*g*); and the fiat of the Attorney-General was, in fact, necessary in all cases, and was not issued as of course (*h*).

Attorney-General's fiat required in England, and not issued as of course

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(*c*) *Ibid.* p. 486; *Muntz* v. *Foster*, 2 Webst. P. C. 93 n.; but see *Smith* v. *Upton*, 6 M. & G. 251; *Patteson* v. *Holland*, Hindmarch on Patents, p. 293. In *Smith* v. *Upton*, the postponement was at the instance of the plaintiff in the action.

(*d*) 3 Ch. D. 660.

(*e*) 1 Webst. 41.

(*f*) 2 Ventr. 344.

(*g*) *R.* v. *Neilson*, 1 Webst. P. C. 672.

(*h*) 1 Webst. 671, n.; *Ibid.* 672; *R.* v. *Prosser*, 14 Bea. 306.

Sect. 26 (4).

NOTE. Attorney-General's fiat.

In *Young's Patent* (*i*) the fiat was refused by Sir R. BETHELL, A.-G. In this case the patent was for the production of paraffin oil by the distillation of bituminous coal. The application for *scire facias* was made by the owner of a coal-field in Scotland, containing a certain mineral called the Torbane Hill mineral, the right to get which was leased to certain persons who sold to the patentee, by whom it was used in his manufacture. Under the terms of the lease, the applicant had a pecuniary interest in the quantity of the mineral raised. His application was based on allegations that the invention was not new, and that his interests were prejudicially affected by the patent, and the use made thereof to interfere with the sale of the Torbane Hill mineral. It appeared also that the applicant had raised in Scotland an action of declaration and reduction (a proceeding analogous to the English *scire facias*) to repeal the patentee's Scotch patent for the same invention. The application was refused on the ground (1) that as a general rule the writ of *scire facias* ought to be used for public purposes only, and not with a view to promote any private end or interest; (2) that the action in Scotland being pending, the proper course was to allow that action to go on, and then to allow, or not allow, proceedings after its determination; and (3) that the patent was eleven years old, and had been the subject of several legal proceedings which had been compromised, and that no evidence of want of novelty was produced, and that such a patent ought not to be lightly challenged. And again, in the same patent, on a fresh application for the writ of *scire facias* made by the same applicants (*k*) after the abandonment of the original Scotch action, but after the institution of a second action for the same purpose which had not been formally, though it was alleged it had been virtually, abandoned, Sir W. ATHERTON, A.-G., refused his fiat (*l*).

Where an action for infringement at the suit of the patentees, who were resident in Scotland, was pending in Scotland against the applicants, the Attorney-General refused his fiat pending the result of the action, but gave leave to renew the application if necessary (*m*).

Where no action is pending the authority of the Attorney-General may be granted without any notice to the patentee (*n*). So, also, where an action against the applicants had been abandoned and the patentee had applied at the Patent Office for leave to amend his specification (*o*).

(*i*) Practical Mechanic's Journal, 2nd series, vol. 6, p. 98.

(*k*) *Young's Patent*, Practical Mechanic's Journal, 2nd series, vol. 7, p. 44.

(*l*) See also *R.* v. *Neilson*, 1 Webst. P. C. 673, where it is said that after one party has sued out a *scire facias* another could not do it.

(*m*) *Bell and Coleman's Patent*, Griffin, P. C. 320.

(*n*) *Gaulard and Gibbs' Patent*, Griffin. P. C. 320; but see *Siddell's Patent*, *ibid.*

(*o*) *Rothwell's Patent*, Griffin, P.C. 320.

But where in an action for infringement, judgment was given against the defendants, who appealed, and in the interval between the judgment and the hearing of the appeal applied for the authority of the Attorney-General under this sub-section, notice was ordered to be given to the patentee (*p*). So, also, where the applicant was a licensee (*q*). Sect. 26 (4). NOTE.

And where notice had been given to the patentee and he undertook to bring an action for infringement, the application for the Attorney-General's fiat was ordered to stand over (*r*).

The Attorney-General had control over the prosecutor's proceedings, and it seems that he could direct a *nolle prosequi* to be entered as to certain parts of the writ if the prosecutor insisted on retaining them, and he was accustomed to afford similar relief in other cases, though his jurisdiction was exercised principally on the subject of security for costs (*s*).

Where a petition under this sub-section for the authority of the Attorney-General has been abandoned, he has no power under s. 38, *post*, to order payment of costs (*t*).

For the proceedings necessary to obtain the fiat of the Attorney-General, see Appendix, *post*, pp. 611, 612.

4 (c). "**In fraud of his rights.**"—These words mean acts done with the intention of depriving a person of his rights, and do not apply to cases of mere mistake, and therefore, where a person appointed by an agent for a foreign inventor, without any fraudulent intention, took out the patent in his own name without stating that any part of it was a communication from abroad, but always intended to hold the patent for the benefit of the foreign inventor, it was held that, even if the patent was void, a petition could not be sustained under this sub-section, and it was dismissed without prejudice to any petition which the petitioner might present under sub-s. (4) (d), claiming to be the true inventor (*u*).

But where it appeared that the experiments resulting in the invention were made by one of two petitioners under the direction of the other, and not, as alleged by the patentee, by one of the petitioners under the patentee's direction, though they were made at the patentee's factory, and the judge found on the evidence that the invention was not that of the patentee, and that the patent was taken out with the intention of depriving one of the petitioners of his rights, the patent was revoked (*x*).

(*p*) *Watling's Patent*, Griffin, P. C. 320.

(*q*) *Martin's Patent*, Griffin, P. C. 320.

(*r*) *Siddell's Patent*, Griffin, P. C. 320.

(*s*) *R.* v. *Newall*, 1 Webst. P. C. 671, n.

(*t*) *Martin's Patent*, 29 S. J. 148; Griffin, P. C. 320.

(*u*) *Avery's Patent*, 36 Ch. 307.

(*x*) *Norwood's Patents*, 12 R. P. C. 214. See also *Norwood's Patent* (No. 2), 15 R. P. C. 104.

Sect. 26 (4). NOTE.

4 (d). Where it did not appear that the second patentee had copied, or fraudulently taken from the first patent, and the second patent was not for an invention identical with that comprised in the first patent, but was for a different method of effecting the objects of the latter invention, and showed a different way of dealing with knowledge common at the date of the first patent, a petition for revocation presented by the first patentee was dismissed with costs (*y*).

Since the words of the sub-section are "true inventor," and not "true and first inventor," which latter words include an importer (*ante*, p. 6), it would seem that the sub-section distinguishes between a mere importer and the inventor, and that in the case of an invention of foreign origin a patent granted to a person who is only importer and not inventor may be revoked at the instance of the actual inventor.

4 (e). Where it was proved that the petitioner had, before the patent, for many years used a process practically, for all chemical purposes, identical with the patented process, and producing a material chemically the same as the patented material, the patent was revoked under this sub-section (*z*).

If the petitioner is qualified under sub-ss. (c), (d), or (e), to present the petition, it is open to him to impeach the patent on any lawful ground (*a*). But the court will not go into the question whether the patent is or is not good, if it appears on the hearing that the petitioner has no *locus standi* under these sub-sections (*b*). If, therefore, there is any doubt on this latter point, it will be necessary to obtain the authority of the Attorney-General under sub-s. (b).

When the objection is taken that the fiat of the Attorney-General was necessary and has not been obtained, the petitioner's counsel will be heard on the point of *locus standi*, notwithstanding the provisions of sub-s. (7), that the respondent is entitled to begin; and a petition wrongly presented under sub-ss. (c), (d), or (e) will, if the objection is established, be ordered to stand over in order that application may be made for the fiat, and when the fiat is obtained may be amended and brought on again for hearing (*c*).

The petition must be presented in the name of the person making the allegations referred to in sub-ss. (c), (d), and (e), and not in the name of his attorney, and all persons interested in the patent must be made respondents (*d*).

(*y*) *Walker* v. *Hydro-Carbon Syndicate, Limited*, 2 R. P. C. 3. An appeal from this decision was presented but afterwards withdrawn, 3 R. P. C. 254.

(*z*) *Haddan's Patent*, 2 R. P. C. 218.

(*a*) *Morgan's Patent*, 5 R. P. C. 186.

(*b*) *Avery's Patent*, 36 Ch. D. 307, 323.

(*c*) *Re Dege's Patent*, 12 R. P. C. 448.

(*d*) *Avery's Patent*, 36 Ch. D. 307.

SUB-SECTIONS (5), (6). Sect. 26 (5, 6).

NOTE

On a petition for revocation, interrogatories may be exhibited by the petitioner to the respondent (*e*).

For a form of particulars of objections under this sub-section, see *Re Haddan's Patent* (*f*). See also the notes under s. 29 (2), (3), (4), (5).

It appears that a certificate under s. 29 (6) (*post*, p. 159) cannot be given in respect of the particulars of objections delivered under the present sub-sections on a petition for revocation (*g*).

SUB-SECTION (7).

A re-enactment of the latter part of s. 41 of the Act of 1852.

In *scire facias* the burden of proof was on the prosecutor, and it was apparently not enough for him to make out merely a *primâ facie* case against the patentee (*h*).

Patentee not appearing.

Under the present Act when the patentee did not appear at the hearing, the court, on evidence of want of novelty being given, revoked the patent (*i*). Where the patentee did not appear when the petition came on for directions, and the petitioner had been informed by the patentee that he did not intend to oppose, the court declined to make an order for revocation until an affidavit verifying the petition had been filed (*k*).

The patent may be revoked by consent of the patentee (*l*).

Evidence.

If the respondents desire it a petition for revocation will be tried on *viva voce* evidence (*m*).

When the evidence is taken by affidavit, the party who has the right to begin should file his evidence first, and if either party cross-examines, he ought to bring that evidence before the court (*n*).

If several persons join in the petition they ought not to appear separately. In *Norwood's Patent* (*o*), where there were two petitioners, and one conducted his own case and the other appeared by counsel and no objection was taken, the judge allowed the separate appearances, but intimated that it was not to be taken as a precedent.

Mode of trial.

No summons ought to be taken out as to the mode of trial; the judge will decide this when the petition comes on for hearing (*p*).

(*e*) *Haddan's Patent*, 54 L. J. Ch. (N.S.) 126; 51 L. T. (N.S.) 190; W. N. (1884), p. 192.

(*f*) 2 R. P. C. 219.

(*g*) *Gaulard and Gibbs' Patent*, 5 R. P. C. 525, 537.

(*h*) See *R.* v. *Cutler*, Macr. P. C. 124, 133, 134.

(*i*) *Ingram, Jones and Elvan's Patent*, 13 R. P. C. 446.

(*k*) *Vaisey's Patent*, 11 R. P. C. 591.

(*l*) *Rendell's Patent*, 11 R. P. C. 277.

(*m*) *Gaulard and Gibbs' Patent*, 34 Ch. D. 396. See also *per* CHITTY, J., *Gales' Patent*, 8 R. P. C. 438, 440.

(*n*) *Gales' Patent*, 8 R. P. C. 438.

(*o*) 12 R. P. C. 214.

(*p*) See *per* KEKEWICH, J., *Miller's Patent*, 11 R. P. C. 55.

Sect. 26 (7). NOTE.

Under the S. C. R. 1883, Order XXXVI. r. 1, or Order XXX. r. 1, an order was made for a trial of the petition at assizes before a judge without a jury; but such an order was not to prevent the judge at the trial from acting on his own view of his jurisdiction (*q*).

When the petition was for revocation on the ground of fraud, and the petitioner had brought an action complaining of the alleged fraud and claiming damages, an order was made transferring the petition from the Chancery to the Queen's Bench Division, in order that the petition and the action might be tried together (*r*).

Order of revocation—Practice in cases of appeal.

In *Armstrong's Patent* (*s*) the order for revocation was made, but on the application of the respondents it was directed that it should not be delivered out for a week, and then, if notice of appeal were presented, execution was to be stayed; the court expressing a doubt whether a patent when revoked could be restored.

But in the subsequent case of *Deeley* v. *Perkes* (*t*), where the court of first instance had held all the claims bad and revoked the patent, and the order had been entered on the registe of patents, it was held in the House of Lords that the Court of Appeal, who were of opinion that one claim was valid, could reverse the order below, and order that the patent be revoked unless within three months, or such further time as the court might allow, the patentee should obtain leave to amend his specification by disclaiming the other claims (*u*).

For forms of orders of revocation, see Seton, 1987.

It is not now the practice formally to cancel a patent even after there has been an order revoking it. The order of revocation is carried to the office of the comptroller, and there a note is made, but there is no actual cancellation of the document (*x*).

Security for costs.

Security for costs will not be ordered against a respondent to a petition for revocation who is resident out of the jurisdiction (*y*).

Costs.

The only costs which can be given on a petition for revocation are the costs of the petition. The court does not deal with any costs incurred before the law officer (*z*).

Where the petition had been sent by the Chancery Division for trial at the assizes, and the judge found that the patent ought to be revoked, but the order having been drawn up as for the trial of an issue the

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(*q*) *Edmonds' Patent*, 5 Times Rep. 109. The order was made as in the text. As actually drawn up (Seton, 1987), it appears to be incorrect. See remarks of NORTH, J., at 6 R. P. C. 358.

(*r*) *Edge's Patent*, W. N. (1890), 149.

(*s*) 13 R. P. C. 501.

(*t*) [1896] A. C. 496.

(*u*) And see *Armstrong's Patent*, before the Court of Appeal, 14 R.P.C. 747.

(*x*) See *per* LINDLEY, L.J., *Armstrong's Patent*, 14 R. P. C. 747, 755.

(*y*) *Miller's Patent*, 11 R. P. C. 55.

(*z*) *Rendell's Patent*, 11 R. P. C. 277.

judge at assizes sent the case back to the Chancery Division without making any order for revocation, it was held in the Chancery Division that under the general jurisdiction of the court the costs could be ordered to be paid by the unsuccessful party, and an order was made revoking the patent with costs, to be paid by the patentee (*a*).

Sect. 26 (7). NOTE.

SUB-SECTION (8).

It would seem that it is only when the patent has been revoked under sub-s. (4) (c) that sub-s. (8) applies, and that it would not apply if the patent were revoked under sub-s. (4) (d) (*b*).

Crown.

27.—(1.) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject. Patent to bind Crown.

(2.) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

This section does not apply to patents existing at the commencement of the Act, or granted on applications then pending. See s. 45 (2). These patents will be subject to the law as laid down in *Feather* v. *The Queen* (*c*), where it was held by the Court of Queen's Bench, contrary to the opinion which formerly prevailed (*d*), that the ordinary form of grant in letters patent did not preclude the Crown from using the invention even without the assent of or compensation made to the patentee. And the patentee, therefore, could not prevent the use of his invention by a Government department. But persons contracting

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(*a*) *Edmonds' Patent*, 6 R. P. C. 355.

(*b*) See *per* BOWEN, L.J., *Avery's Patent*, 36 Ch. D. 307, 326.

(*c*) 6 B. & S. 257.

(*d*) *Walker* v. *Congreve*, 1 Carpmael Pat. Cases, 356; mentioned also in Norman on Patents, p. 181. *In re Pettit Smith's Patent*, 7 Moo. P. C. 133; *In re Lancaster's Patent*, 2 Moo. P. C. (N.S.) 189.

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NOTE.

to supply the Crown with certain articles of manufacture are not servants of the Crown, doing the work of the Crown, and therefore, when contractors for the supply of rifles to the War Office made such rifles according to a patented invention, but without the licence of the patentee, it was held that they were liable to be sued by the patentee for infringement (*e*).

In patents under the present Act, *Feather* v. *The Queen* will not apply, and the case of contractors acting for a Government Department will be dealt with under sub-s. (2).

The section applies to new patents granted under s. 25 by way of extension of existing patents (*f*).

In cases not within this sub-section, the patentee's remedy is not by petition of right, but by proceeding against the officers of the Crown using the patent (*g*). This also seems to have been the view of Lord ELDON in *Walker* v. *Congreve* (*h*).

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Plaintiff need not apply to defendant before commencing proceedings.

A plaintiff is not bound, before commencing proceedings, to apply to the defendant and ascertain whether he will, without suit, do what is required (*i*); and as a general rule the court takes no notice of negotiations before suit (save in cases of bad faith), unless they amount to a release or binding agreement with respect to the causes of action (*k*). Nor is a plaintiff compelled to rely on the promise of the offending party not to infringe again, but he is entitled to the protection of an injunction (*l*). If, however, this right is exercised oppressively, the plaintiff may lose the costs of the action (*m*). And the injunction ought not to be granted if the defendant has ceased from the acts complained of and there is no ground to apprehend that they will be repeated (*n*).

Limitation as to proceedings for infringement.

No proceedings are to be taken in respect of an infringement committed before the publication of the complete specification (*o*); and if

(*e*) *Dixon* v. *London Small Arms Co.*, 1 App. Cas. 632.

(*f*) *Wasteney Smith's Patent*, 2 R. P. C. 14; *Cooking's Patent*, 2 R. P. C. 151.

(*g*) *Feather* v. *The Queen*, 6 B. & S. 257.

(*h*) *Ubi supra.*

(*i*) *Upmann* v. *Elkan*, L. R. 12 Eq. 146; *Burgess* v. *Hills*, 26 Bea. 244, 247; *Burgess* v. *Hately*, 26 Bea. 249; *Upmann* v. *Forrester*, 24 Ch. D. 231.

(*k*) *Edelsten* v. *Edelsten*, 1 D. J. S. 203; *Davenport* v. *Rylands*, L. R. 1 Eq. 305.

(*l*) *Losh* v. *Hague*, 1 Webst. P. C. 201; *Geary* v. *Norton*, 1 De. G. & Sm. 9.

(*m*) See *post*, p. 238.

(*n*) *Proctor* v. *Bayley*, 42 Ch. D. 390; *Leahy* v. *Glover*, 10 R. P. C. 141 (H. L.)

(*o*) Section 13, *ante*, p. 61.

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the time for making any of the prescribed payments has been enlarged, the court may refuse to award damages in respect of any infringement committed after the failure to pay, and before the enlargement of the time for payment (*p*).

Several infringements at one time.

A patentee is often placed in serious difficulty when his patent is infringed by several persons at once. If he proceed by separate actions against the several infringers at the same time, he may have to try the validity of his patent in several distinct proceedings, in each of which different objections may be taken, and he will also be liable to the charge of oppressive litigation. On the other hand, if he does not file bills against the general body of infringers till he has established his patent in an action against one of them, there is not only the difficulty that each separate infringer is not bound by the proceedings in that action, and may require the patent to be established afresh against him (*q*), but the patentee, by reason of his *laches* (*r*), may be unable to obtain the interlocutory injunctions to which, having established his patent in one action, he would be otherwise entitled (*s*).

In such a state of things the course which has been suggested by Lord HATHERLEY, C. (*t*), is that a patentee in the position referred to should select the case which he thinks best to try the question fairly, and proceed to obtain an interlocutory injunction against that infringer. He should at the same time write to the other persons infringing, who were *in simili casu*, and say to them: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction, and if you will not object on the ground of delay, I do not mean to file bills against all of you at once."

In such a case where the objection of delay was urged against the grant of the interlocutory injunction, the court, while refusing the injunction, has required the defendant to pay a sum of money into court as security, and has required the action to be prosecuted without delay, and pleadings to be delivered in the vacation (*u*). In the *North British Rubber Co.* v. *Gormully, etc. Co.* (*x*), the defendants having offered to pay a sum of money into court the injunction was refused though the patent had been established in a previous action.

All parties claiming interest should be

All parties claiming an interest in the letters patent, if they do not join as co-plaintiffs, may properly be made defendants to the action, in order that the infringing defendants may not be compelled to account

(*p*) Section 17 (4) (b), *ante*, p. 67.

(*q*) *Bovill* v. *Goodier* (2), L. R. 2 Eq. 195; *Bovill* v. *Smith*, W. N. (1867), 340; *Croskill* v. *Tuxford*, 5 L. T. 342.

(*r*) See *post*, p. 272.

(*s*) *Bovill* v. *Crate*, L. R. 1 Eq. 388. See also *North British Rubber Co.* v. *Gormully & Co.*, 12 R. P. C. 17.

(*t*) *Bovill* v. *Crate*, *ubi supra*.

(*u*) *Edison-Bell Phonograph Co.* v. *Hough*, 11 R. P. C. 594.

(*x*) 12 R. P. C. 17.

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twice, first to the plaintiff, and then to the other defendants who claim an interest (*y*). And where assignments of shares of the profits under a licence had been made, it was held in an action by one assignee against the licensee for an account, that in order to avoid multiplicity of actions the account must be taken once for all in the presence of all the persons interested (*z*).

joined in the action.

The mortgagor of a patent may, however, sue alone for infringement without joining the mortgagees, either as co-plaintiffs or as defendants, but if at any time the presence of the mortgagees is necessary, as, for instance, if an account has to be taken, the defendants may apply to make them parties to the action (*a*). In the case cited, the mortgagee was not registered as proprietor, but it seems (though the point was not decided) that such registration of the mortgagee would not have affected the mortgagor's right to sue alone (*b*).

But no cause is to be defeated by reason of the mis-joinder or non-joinder of parties, and the court may in every cause deal with the matter in controversy so far as regards the rights and interests of the parties actually before it; and the court or a judge may order that the names of any parties improperly joined be struck out, and that the names of any parties, whether plaintiffs or defendants, who ought to have been joined, or whose presence before the court may be necessary in order to enable the court effectually and completely to adjudicate upon and settle all the questions involved in the cause, be added (*c*). If the judge thinks the action is defective for want of parties, it is his duty under this rule to join the necessary parties himself (*d*). But the maker of an infringing machine cannot claim under this rule to be added as a defendant in an action against the user (*e*).

Where, during the progress of a trial, it appeared that the plaintiff's rights had been transferred to a company before action brought, leave to add the company as plaintiffs was allowed, but with a right to the defendant, if he thought fit, to have the trial postponed, although the fact of the transfer was known to the defendant when he put in his defence (*f*).

But where the defendants had pleaded that they had not been concerned in any infringement since the assignment of the patent to the present plaintiffs, leave at the trial to add as co-plaintiffs the predecessors in title of the plaintiffs was refused (*g*).

(*y*) *Westhead* v. *Keene*, 1 Bea. 287, 295; Hindmarch on Patents, p. 308.

(*z*) *Bergmann* v. *McMillan*, 17 Ch. D. 423.

(*a*) *Van Gelder, etc. Co.*, v. *Sowerby Bridge, etc. Society*, 44 Ch. D. 374; 7 R. P. C. 208.

(*b*) *Ibid.*

(*c*) S. C. R. 1883, Order XVI. r. 11.

(*d*) *Van Gelder* v. *Sowerby*, *ubi supra*.

(*e*) *Moser* v. *Marsden*, [1892] 1 Ch. 487.

(*f*) *Ruston* v. *Tobin*, 49 L.J. Ch. 262.

(*g*) *Nobels Explosives Co.* v. *Jones*, 42 L. T. (N.S.) 754.

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Where defendants, while the action was pending, assigned their business, and then obtained an order in chambers adding their assignees as defendants, such order was, on the application of the plaintiffs, discharged as irregular (*h*).

Patent vested in trustees.

If the letters patent are vested in trustees for any persons the trustees may sue alone, but the court or a judge may at any stage of the proceedings order any of such persons to be made parties (*i*).

Where simple licences granted patentee can sue alone.

A patentee who has granted simple licences to work the invention may of course sue alone to restrain infringement, without bringing his licensees before the court, for since the patentee may grant licences to whom he pleases, no injury is done to a licensee by infringement being permitted (*j*).

Right of patentee where exclusive licence granted.

An exclusive licence may in effect amount to an assignment of the whole interest in a patent, but in general a power of revocation, in the event of breach of covenant, is reserved to the patentee. In virtue of this dominion over the patent it would seem that a patentee who has granted an exclusive licence may sue to restrain infringement without bringing his licensee before the court. The injury done by the infringement to the patentee is distinct from that done to the licensee. The latter suffers by the direct competition with his trade, the former by the injury to the reputation of the patent, through infringement being permitted, and the consequent difficulty of restraining such infringement whenever the dominion is resumed, and also (where the exclusive licence is granted in consideration of royalties reserved) by the diminished returns which, from the interference with the licensee's trade, are made to the patentee. It would seem, therefore, that a patentee who has granted an exclusive licence ought to be allowed to sue to restrain infringement without bringing his licensee before the court. The point has not been actually decided, but it is believed that such a form of action is quite usual.

Assignees tenants in common.

Where a patent has been assigned to two persons as tenants in common, there is a joint right of action in the two assignees, and in the event of the death of either it descends to the survivor, who may sue and recover damages for an infringement committed during the joint lives (*k*).

Assignee of distinct and

Where several heads of invention are included in one patent, the assignee of a distinct and severable part of the invention may sue alone

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(*h*) *Brigge* v. *Lardeur*, 2 R. P. C. 13.

(*i*) S. C. R. 1883, Order XVI. r. 8.

(*j*) See *Newby* v. *Harrison*, before Lord CAMPBELL, cited in *Renard* v. *Levinstein*, 2 H. & M. 628.

(*k*) *Smith* v. *London and North-Western Rail. Co.*, 2 E. & B. 69; *S. C.* Macr. P. C. 207.

Ss. 28—32. for damages for infringement of that part of the patent without joining the persons interested in the other parts (*l*).]

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severable part of patent.

In *Walton* v. *Lavater* (*m*), the defendant, the original patentee, assigned a moiety of the patent right to the plaintiff, who ultimately became entitled to the other moiety, and then sued the defendant for infringing the patent. One of the grounds of defence was that the thing granted by the letters patent was one and indivisible, and that under the above-mentioned circumstances the patent right remained in the patentee, though he had no beneficial interest, and that the plaintiff, therefore, had no right to sue. But it was held that the assignment of the moiety passed an interest in the patent, and that the plaintiff, having acquired the other moiety, had the whole right in him, and could therefore sustain the action.

This decision, it will be observed, does not decide anything as to the right of the assignee of a share in letters patent for a single invention which is not separable into parts to sue alone, but in *Smith* v. *London and North Western Rail. Co.* (*n*), where the right of the survivor of two persons to whom the patent had been assigned as tenants in common to sue at law for the whole damages was established, the ground of the decision was that if one of the assignees had not died the action must have been brought by both (*o*); and in *Bergmann* v. *McMillan* (*p*), it was held by FRY, J., that when an assignment is made of a share of profits arising from the working of a patent by licences, although the assignee is entitled to an account from the licensee, it must be taken, once for all, in the presence of all the parties interested, otherwise the account might have to be repeated at the instance of each of the other assignees of shares. On the other hand, it was held by MALINS, V.-C., in *Sheehan* v. *Great Eastern Rail. Co.* (*q*), that one of several co-owners of a patent could sue alone without making the other co-owners parties.

A mere licensee, having a simple licence to work the patented invention, cannot sue alone to restrain infringement, because, since the patentee may grant a licence to other persons besides the plaintiff, and therefore to the defendant, the infringement is not an injury to the plaintiff but to the patentee (*r*), and this seems to have been admitted

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(*l*) *Dunnicliff* v. *Mallett*, 7 C. B. (N.S.) 209.

(*m*) 8 C. B. (N.S.) 184.

(*n*) Macr. P. C. 203.

(*o*) See remarks of JESSEL, M. R., in *Powell* v. *Head*, 12 Ch. D. (a copyright case) 686; and *Anderson* v. *Patent Oxonite Co.*, 3 R. P. C. 271.

(*p*) 17 Ch. D. 427.

(*q*) 16 Ch. D. 59, following the analogy of *Dent* v. *Turpin*, 2 J. & H. 139, a case of two owners of the same trade-mark. See also Lindley on Partnership, 6th ed., p. 36; *Davenport* v. *Richards*, 3 L. T. (N.S.) 503.

(*r*) *Newby* v. *Harrison*, before Lord CAMPBELL, C., cited in the judgment in *Renard* v. *Levinstein*,

in the case of *Renard* v. *Levinstein*, cited below. Nor can a person to whom foreign owners of an English patent, not assigned to him, have given the sole agency and control of the working of the patent in England, maintain an action against infringers (*s*).

Actions by exclusive licensee.

But in *Renard* v. *Levinstein* (*t*), it was held that an exclusive licensee may sue alone, at all events if he bring the owner of the patent before the court as a defendant. In that case a suit to restrain infringement was brought by owners of a patent and persons to whom they had granted an exclusive licence. After the institution of the suit, the owners assigned the patent to third parties, and an unsuccessful attempt having been made to add the latter as co-plaintiffs, they were made defendants. It was objected that the plaintiffs had no right to sue, but the objection was overruled by Lord HATHERLEY, then Vice-Chancellor.

However, in the course of the litigation which followed the establishment of the validity of the roller skate patent (*u*), where the practice of the patentee was to grant exclusive licences for particular districts in consideration of a lump sum, and an agreement by the licensees to purchase skates from the patentee at a particular price, JESSEL, M.R., intimated an opinion that it was the safest course to join the patentee as a co-plaintiff with the licensee in an action to restrain infringement within the licensee's district, and this course was followed in all the actions. See the title to the consolidation order in *Plimpton* v. *Spiller*, Appendix, *post*, p. 598 (*v*). And in *Heap* v. *Hartley* (*x*), it was held by the Court of Appeal that a mere exclusive licensee, not being a grantee of the patent for a limited period or a limited space, cannot sue without joining the patentee.

As to the effect of the requirement of registration on the right to sue, see *post*, s. 87.

Defendants to action for infringement.

The person by whom a patent has been infringed will, of course, be a defendant to the action, but it is not necessary to include as defendants workmen or others by whom the actual infringement is committed. The master is responsible for the acts of his workmen, even though he may have given them general directions not to violate a particular patent (*y*), and the common form of injunction against the master restrains the repetition of the infringement by him, his servants, agents, or workmen (*z*).

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2 H. & M. 628. See also *Derosne* v. *Fairie*, 1 Webst. P. C. 155; Webster's Law and Practice of Letters Patent, pp. 24, 30.

(*s*) *Adams* v. *North British Rail. Co.*, 29 L. T. (N.S.) 367.

(*t*) 2 H. & M. 633.

(*u*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531.

(*v*) See also *Barnett* v. *Barrett's Screw Stopper Bottling Co.*, 1 R.P.C. 9.

(*x*) 42 Ch. D. 461; 6 R. P. C. 496.

(*y*) *Betts* v. *De Vitre*, L. R. 3 Ch. 442.

(*z*) Seton, p. 548.

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But anybody who takes part in a wrong of this description is liable to be restrained from committing the wrong, and therefore an agent infringing a patent may be made a defendant to the action, and personally and individually be made to pay the costs of it, and it is no justification for him to say that his master ordered him to do it (*a*).

The master of a ship is not a mere agent; he has a possession of a particular nature, and he may be sued as a principal (*b*).

And where there was a patent for the construction of fancy rollers for carding machines by attaching strips of card at intervals to the periphery of the roller, and a cardmaker, under a contract to clothe the rollers of a carding machine, made and supplied to a manufacturer cards of the ordinary construction, which were fastened on the rollers by a nailer whose trade was separate and distinct from that of the cardmaker, and who was selected by the manufacturer but paid by the cardmaker, and the cards were so nailed that the rollers when covered infringed the patent, it was held that the nailer was the agent, not of the manufacturer, but of the cardmaker, and that the latter was properly sued for infringement (*c*).

But persons who are only custom-house agents for foreign importers, and not themselves the importers of the goods complained of, and have neither possession nor control over the goods, are not liable to be sued as infringers (*d*).

Account against manufacturer no licence to purchasers from him.

An account directed against the manufacturer of a patented article does not licence the use of the article in the hands of purchasers from him, and therefore, when a patent was infringed by a manufacturer who sold to others who made use of the article without the licence of the patentee, the latter was entitled to file separate bills against the manufacturer and the user, and might have an account of profits against the manufacturer and damages against the user (*e*).

Distinct infringements by different persons, separate actions necessary, but not where one infringes several patents.

If there are distinct invasions of a patent by different persons, there must be separate actions against each infringer (*f*); but where one person at one time infringes several patents, there is no occasion for distinct actions upon each patent; the infringement of the various patents may be comprehended in one action (*g*); and where this was not done, and two actions were brought against the same person for infringement of two patents, the plaintiffs were only allowed such costs

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(*a*) *Per* Sir W. P. WOOD, V.-C., *Betts* v. *De Vitre*, 11 Jur. (N.S.) 11; and see judgment of COTTON, L.J., *Adair* v. *Young*, 12 Ch. D. 19. See also *Betts* v. *Neilson*, 6 N. R. 221.

(*b*) *Adair* v. *Young*, 12 Ch. D. 19.

(*c*) *Sykes* v. *Howarth*, 12 Ch. D. 826.

(*d*) *Nobel's Explosives Co.* v. *Jones*, 8 App. Cas. 5.

(*e*) *Penn* v. *Bibby*, L. R. 3 Eq. 308.

(*f*) *Dilly* v. *Doig*, 2 Ves. 487.

(*g*) See the decree in *Lister* v. *Wood*, cited in Seton on Decrees, 3rd ed. p. 909.

as they would have been entitled to had they joined both patents in one action (*h*).

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The manufacturer and users who have bought from him may be included together as defendants in one action (*i*). Where such an action is defended by the manufacturer but not by the user, it cannot be set down against the user alone on motion for judgment on default of pleading (*k*).

Manufacturer and users may be sued in one action.

If the action is brought against the user alone, the manufacturer cannot insist on being added as a defendant (*l*). But where an action for infringement was brought against the user to whom an indemnity had been given by the manufacturers, and the user gave notice under the third party procedure (*m*) claiming indemnity, and the manufacturers put in an appearance, it was held that the proper order to be made was that on the manufacturers admitting their liability to indemnify the defendants they should be at liberty to appear at the trial and take such part therein as the judge should direct; and that they should be bound by the decision of the court in the action in any question as to the above indemnity, but not further (*n*).

Foreigners infringing.

Foreigners are in all cases subject to the laws of the country in which they may happen to be, and if a foreigner while in England infringes a patent, he may be restrained by injunction (*o*). But the Court has no jurisdiction to interfere with the property of a foreign Sovereign, and therefore, when certain shells made in Germany for the Mikado of Japan in infringement of an English patent were brought to this country to be placed on board a ship belonging to the Mikado of Japan, it was held that the court would not interfere to prevent him removing the shells (*p*).

And where a foreign manufacturer in compliance with an order from an English dealer to send to him by post, sent to the latter under circumstances which the court considered equivalent to sending by post, a packet containing the infringing article, it was held by the House of Lords that the foreigner had done nothing in this country to infringe the patent and the action was dismissed (*q*).

(*h*) *United Telephone Co.* v. *Sharples*, 2 R. P. C. 28.

(*i*) See *Proctor* v. *Bennis*, 36 Ch. D. 740.

(*k*) *Actien Gesellschaft für Cartonnagen, etc.* v. *Remus*, 12 R. P. C. 94.

(*l*) *Moser* v. *Marsden*, [1892] 1 Ch. 487.

(*m*) S. C. R., 1883, Order XVI. r. 48.

(*n*) *Edison, etc. Co.* v. *Holland*, 3 R. P. C. 397.

(*o*) *Caldwell* v. *Van Vlissengen*, 9 Ha. 415, said by TURNER, L.J., (3 D. J. S. 87; 11 Jur. (N.S.) 680) to have been affirmed on appeal.

(*p*) *Vavasseur* v. *Krupp*, 9 Ch. D. 352.

(*q*) *Badische Anilin und Soda Fabrik* v. *Basle Chemical Works, Bindschedler*, [1898] A. C., 200.

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Company defendant, directors may be made personally liable.

A company infringing a patent may, of course, be made defendants to an action, and where the directors actively interfere in the infringement they may be joined as co-defendants, and a decree may be made against them as well as against the company, and they may be ordered personally to pay the costs of the action (*r*).

Threat to infringe sufficient to found action.

A threat to infringe under a claim of right so to do is sufficient to found an action for an injunction, provided, of course, that what is threatened to be done is an infringement; and where a defendant had by his original statement of defence asserted a right and intention to continue the manufacture complained of, and afterwards omitted such assertion from his defence, it was held that the original statement of defence might be used against him as evidence (*s*).

The mere possession of infringing machines is of itself sufficient ground for injunction (*t*).

A defendant may be restrained from selling or using machines piratically made during the patent (*u*).

On the question of infringement the patent is assumed to be good (*x*).

Defendants out of the jurisdiction.

Where in a trade mark case the defendants were a company having their registered office in Scotland with branches in England, leave to serve the writ out of the jurisdiction was given, as an injunction could be enforced by sequestration of the property of the company in England (*y*). But leave will not be given where the injunction can only be enforced against the agent living in England of the Scotch principal (*z*). And so, where the defendant was resident in Ireland and had no business premises or agents in England, and only sold to a small extent to customers in England, it was held, having regard to Order XI., r. 2, that the action ought to have been brought in Ireland, and an order for service out of the jurisdiction was set aside as irregular (*a*).

Consignees may be made parties to an action against a steamship company which has brought infringing goods into this country, and if living out of the jurisdiction an order may properly be made for serving them out of the jurisdiction (*b*).

(*r*) *Betts* v. *De Vitre*, 11 Jur. (N.S.) 9, affirmed L. R. 3 Ch. 442; *Spencer* v. *The Ancoats Vale Rubber Co.*, 6 R. P. C. 46.

(*s*) *Frearson* v. *Loe*, 9 Ch. D. 66.

(*t*) *United Telephone Co.* v. *London and Globe Telephone Co.*, 26 Ch. D. 766.

(*u*) *Crossley* v. *Beverley*, 1 Webst. 119; *Crossley & Derby Gas Light Co.*, *ibid.*

(*x*) *Muntz* v. *Foster*, 2 Webst. P. C. 99.

(*y*) *Burland* v. *Broxburn Oil Co.* 41 Ch. D. 542.

(*z*) *Marshall* v. *Marshall*, 38 Ch. D. 330.

(*a*) *Kinahan* v. *Kinahan*, 45 Ch. D. 78.

(*b*) *Washburn and Moen, etc. Co.* v. *Cunard Co.*, 6 R. P. C. 398.

Service on the managing director, resident in England, of a company whose registered office is in Scotland or Ireland will be set aside as irregular (*c*). But service on the head officer at the place of business in England of a foreign corporation carrying on business in England is good service (*d*); and a foreign or colonial firm which carries on business in England may be sued in the firm-name under Order XLVIIIA, r. 1, without leave, although its members are resident out of England (*e*), and it would seem that r. 3 of the same order enables service to be made at the firm's principal place of business in England on the person in control of the business there (*f*).

Where plaintiffs proved a *primâ facie* case of a sale within this country by a foreign manufacturer residing abroad, leave was given to issue a concurrent writ and to serve notice thereof on the foreigner out of the jurisdiction (*g*).

Consolidation of actions against different infringers.

Where there are several actions on the same patent against different infringers, they may be consolidated so that the validity of the patent, and any other questions common to all the actions, may be tried once for all in one action (*h*); and by S. C. R. 1883, Order XLIX. r. 8, re-enacting Order LI. r. 4, of the Judicature Rules, actions are to be consolidated in the manner in use before the Judicature Act in the superior courts of common law.

At common law actions could only be consolidated at the instance of defendants (*i*), and this is now the rule under the above order (*k*). Nor could the plaintiff, according to the practice at common law, be bound without his consent by the result of the one action tried, and he might, after a verdict against him in one action, proceed with any of the others (*l*).

The order in *Foxwell* v. *Webster* was binding upon the plaintiff as well as the defendants (*m*), but it would appear from the report (*n*) that the order was the subject of arrangement; and now that the practice at common law is to be followed in these cases, it would seem that the

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(*c*) *Wood* v. *Anderston Foundry Co.*, 36 W. R. 918; *Watkins* v. *Scottish Imperial Insurance Co.*, 23 Q. B. D. 285.

(*d*) *Newby* v. *Van Oppen*, L. R. 7 Q. B. 293; *Haggin* v. *Comptoir d'Escompte de Paris*, 23 Q. B. D. 519.

(*e*) *Worcester, etc., Co.* v. *Firbank*, [1894] 1 Q. B. 784.

(*f*) *Ibid.*

(*g*) *Badische Anilin und Soda Fabrik* v. *Johnson*, [1896] 1 Ch. 25, and see also *Tozier* v. *Hawkins*, 15 Q. B. D. 650, 680. In the first cited case it was afterwards held that the foreigner had done no wrongful act within the jurisdiction, [1898] A. C. 200.

(*h*) *Foxwell* v. *Webster*, 4 D. J. S. 77.

(*i*) Lush's Practice, 3rd ed., p. 965.

(*k*) *Amos* v. *Chadwick*, 4 Ch. D. 869.

(*l*) Lush's Practice, cited above.

(*m*) See the order in Seton, p. 556.

(*n*) 4 D. J. S. 83.

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order for consolidation should, if made adversely, be framed so as only to bind the defendants (*o*).

At common law, it was held that the consolidation order could be made as soon as the defendants had appeared, and before declaration (*p*); but in *Foxwell* v. *Webster*, on an application by defendants for consolidation, it was held that no consolidation order could be made until the defendants had given discovery by answer (*q*), and on appeal it was, at the suggestion of Lord WESTBURY, C., arranged that the defendants should file affidavits stating their objections to the validity of the patent, and giving full information of every combination of machine made, sold, or used by them, and whence obtained and when used, and undertaking to pay plaintiff royalty in case plaintiff should succeed; the defendants also to furnish verified models of every machine made. On these terms the application was to stand over, no proceedings to be taken in the meantime; but his lordship remarked that in so restraining the plaintiff he was greatly stretching the power of the court (*r*).

Where, by a consolidation order, the defendants in several actions, who all appeared by the same attorneys, bound themselves to abide by the result of a trial in one, and the plaintiff having succeeded in that action, the particular defendant therein neglected to prosecute an appeal, it was held that a defendant in one of the other actions had no equity to be allowed to carry the case to a superior court (*s*).

And where in a test action the defendant did not appear, and after formal evidence had been adduced judgment was given for the plaintiffs, an application by the defendant in another action, who had agreed to be bound by the test action, that no steps should be taken on the judgment until he had had an opportunity of moving to set aside this judgment and proceed to trial in the test action was refused (*t*).

It is therefore desirable in consolidation orders to provide for the case of submission by the defendant in the test action (*tt*).

But although actions can only be consolidated at the instance of defendants, the court will, where several actions have been brought by different plaintiffs against the same defendants, make an order upon the application of the plaintiffs enlarging the time for taking the

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(*o*) See the orders in *Borill* v. *Ainsoough*, *Plimpton* v. *Spiller*, and *Johnasson* v. *Palgrave* in the Appendix, *post*, p. 596.

(*p*) Lush's Practice, 3rd ed., 965.

(*q*) *Foxwell* v. *Webster*, 2 Dr. & Sm. 250.

(*r*) *Foxwell* v. *Webster*, 4 D. J. S. 82. See the order in *Borill* v. *Ainscough* in the Appendix, *post*, p. 596.

(*s*) *Thomas* v. *Winter*, 17 L. T. (N.S.) 148.

(*t*) *Edison United Phonograph Co.* v. *Young*, 11 R. P. C. 489.

(*tt*) See the orders in *Plimpton* v. *Spiller* and *Johnasson* v. *Palgrave*, in the Appendix, *post*, pp. 598, 599.

next step in several of the actions, and staying proceedings therein till after one has been tried as a test action (*u*).

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If, however, the original test action fails to be a real trial of the issue between the plaintiffs and the defendants, the court may substitute another of the actions as the test action (*x*).

An action for infringement of patent cannot be brought in a county court; the grant of letters patent is a franchise which is excepted from the jurisdiction given by the County Courts Act, 1888 (*y*).

Destruction or delivery up of infringing articles.

In addition to the remedies by injunction and account of profits or damages (see s. 30), the court may, on making a final decree in favour of a patentee, direct an inquiry as to what articles made in infringement of the patent are in the possession of the defendant, and may order such articles to be destroyed in the presence of the plaintiff (*z*). But if the several parts of the machine may be innocently used for other purposes, it would seem that the proper course is not to order the destruction of the machines, but to order them to be marked so as to prevent the various parts from being afterwards used so as to continue the infringement (*a*).

And when certain lawn tennis racquets had been stamped with a word which the court held was likely to deceive, an injunction was granted, and it was ordered that the racquets should be delivered up to be destroyed, or, in the alternative, that the word complained of should be erased in the presence of the plaintiff (*b*).

Instead of ordering the destruction or marking of the articles made in infringement of the patent, they may be ordered to be delivered up to the plaintiff (*c*), or the court may make an order in the alternative for delivery up or destruction of the articles complained of (*d*), or the

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(*u*) *Amos* v. *Chadwick*, 4 Ch. D. 869; *Bennett* v. *Lord Bury*, 5 C.P.D. 339.

(*x*) *Amos* v. *Chadwick*, 9 Ch. D. 459. The order in *Plimpton* v. *Spiller* (see Appendix, *post*), provides for this event. See also the order in *Bennett* v. *Lord Bury*, 5 C. P. D. 310.

(*y*) *R.* v. *County Court Judge of Halifax*, 1891, 1 Q. B. 793; 1891, 2 Q. B. 263; 8 R. P. C. 338. See also *Cameron* v. *Gray*, 6 T. R. 363; Higgins' Digest, 353.

(*z*) *Betts* v. *De Vitre*, 34 L. J. Ch. 289, 291; *S. C.*, 11 Jur. (N.S.) 9, 217; Seton, p. 566; *Emperor of Austria* v. *Day*, 3 D. F. J. 217.

(*a*) *Needham* v. *Oxley*, 3 L. T. (N.S.) 604; Pemberton, p. 485. See also order in *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 253; *United Telephone Co.* v. *London and Globe Telephone Co.*, 26 Ch. D. 766; *Automatic Weighing Co.* v. *Fearby*, 10 R. P. C. 442, 447.

(*b*) *Slazenger* v. *Feltham* (2), 6 R. P. C. 531.

(*c*) *Tangye* v. *Stott*, 14 W. R. 386; *Young* v. *Fernie*, Pemberton, p. 484; *Washburn and Moen Manufacturing Co.* v. *Patterson*, 1 R. P. C. 158, 162. See also *ibid.* 191.

(*d*) *Plimpton* v. *Malcolmson*, Seton, p. 565; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 176.

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matter may be reserved for further consideration when the account of profits shall have been taken (*e*). In *Edison Bell, etc. Co.* v. *Smith* (*f*) it was ordered by the Court of Appeal that the infringing parts should be removed in the presence of both parties, and delivered up. And where plaintiff sued on two patents for making barbed wire fencing, the defendants were ordered to give up not only the infringing machines, but also the barbed wire in their possession made thereby (*g*).

The order ought to fix a time within which the machines or articles are to be given up (*h*). And the defendant may be ordered to specify by affidavit what infringing articles are in his possession (*i*).

Hearing with assessor

28.—(1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

This section removes the difficulty raised by the case of *Sugg* v. *Silber* (*k*), when a trial with assessors was refused, and it was held that there was no power under the Judicature Rules in a patent action brought in the Common Law Division to deprive the defendant of his right to a jury. In the Chancery Division an adverse order might be made for trial without a jury, since a patent action was before the Judicature Acts an action which, "without any consent of parties,

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(*e*) *Hocking* v. *Fraser*, 3 R. P. C. 3, 7.

(*f*) 11 R. P. C. 389, 406, and see p. 395, *Howes* v. *Webber*, 12 R. P. C. 465.

(*g*) *Washburn and Moen Manufacturing Co.* v. *Patterson*, *ubi supra*.

(*h*) *Washburn and Moen Manufacturing Co.* v. *Patterson*, 1 R. P. C. 191; *Otto* v. *Steel*, 3 R. P. C. 109, 120.

(*i*) *Tangye* v. *Stott*, Seton, 565.

(*k*) 1 Q. B. D. 362.

could be tried without a jury" (*l*). (See Order XXXVI. r. 26, of the Judicature Rules, re-enacted in Order XXXVI. r. 4, S. C. R. 1883.) The section, it will be observed, relates only to the trial of the action. Sect. 28. NOTE.

The section has been acted on in Scotland, and patent actions have been tried by judges with the aid of assessors (*m*).

By Lord Cairns' Act (*n*), the Court of Chancery was empowered to order questions of fact to be tried by a jury before the court itself, or before the court itself without a jury; and by Sir John Rolt's Act (*o*) the Court of Chancery was required to determine every question of law or fact arising in the cause on the determination of which the plaintiff's title to relief depended. Issues.

Under these Acts the practice arose in the Court of Chancery of directing in patent cases the trial of certain issues involving the validity of the patent and the question of infringement, and these issues were tried sometimes before a judge without a jury, and sometimes before a judge with a jury. These Acts are now repealed (*p*), but the jurisdiction thereby established is not affected by the repeal (*q*). And by the Arbitration Act, 1889 (*r*), repealing and re-enacting with variations s. 57 of the Judicature Act, 1873, the court may, in any cause or matter requiring scientific or local investigation, which cannot, in the opinion of the court or a judge, be conveniently made before a jury, or conducted by the court through its other ordinary officers (and a patent action was held to be an action requiring scientific investigation within the meaning of the repealed section) (*s*), order any question or issue of fact to be tried before a special referee or arbitrator or an official referee or officer of the court, and by Order XXXVI. r. 5, S. C. R. 1883, the court or a judge may order a trial without a jury of any cause, matter, or issue, requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in their or his opinion, be conveniently made with a jury. Further, a proviso at the end of rule 7 (a) of the same order empowers the court or a judge at any time to order any cause, matter, or issue, to be tried by a judge with a jury, or by a judge sitting with assessors, or by an official referee or a

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(*l*) *Patent Marine Inventions Co.* v. *Chadburn*, L. R. 16 Eq. 447. See also *Swindell* v. *Birmingham Syndicate*, 3 Ch. D. 327; *Back* v. *Hay*, 5 Ch. D. 235; *Bordier* v. *Burrell*, 5 Ch. D. 515; cases under the Judicature Rules.

(*m*) *United Horsenail Co.* v. *Stewart*, 2 R. P. C. 122; *Mackie* v. *Berry*, 2 R. P. C. 146; *Gwynne* v. *Drysdale*, 2 R. P. C. 160.

(*n*) 21 & 22 Vict. c. 27.

(*o*) 25 & 26 Vict. c. 42.

(*p*) 46 & 47 Vict. c. 49.

(*q*) *Sayers* v. *Collier*, 28 Ch. D. 103, 108.

(*r*) 52 & 53 Vict. c. 49, s. 14.

(*s*) *Saxby* v. *Gloucester Wagon Co.*, W. N. 1880, p. 28.

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special referee with or without assessors. Issues may therefore still be granted in patent actions, but the usual practice in such actions is not to apply for issues, but to bring the action on for trial in the ordinary way.

By Order XXXIII. r. 1, S. C. R. 1883, when in any cause or matter it appears to the court or a judge that the issues of fact in dispute are not sufficiently defined, the parties may be directed to prepare issues, and such issues shall, if the parties differ, be settled by the court or a judge. The usual questions of fact which, if issues are directed, are ordered to be tried in an action for infringement of patent, are in substance the following :—

1. Was the patentee the true and first inventor of the invention ?
2. Was the invention new ?
3. Is the specification sufficient ?
4. Has the defendant infringed ?

Other issues may, of course, be added, according to the nature of the defence set up (*t*).

The trial of issues may be directed at any stage of the action (*u*).

When questions of fact were referred for trial under the repealed s. 57 of the Judicature Act, 1873, the particular issues did not need to be specified in the order, but the reference might be in general terms (*x*).

By Order XXXIV. r. 9, S. C. R. 1883, when the parties to a cause or matter are agreed as to the questions of fact to be decided between them, they may, after writ issued and before judgment, by consent and order of the court or a judge, proceed to the trial of any such questions of fact without formal pleadings. If this course be adopted in a patent action, it is presumed that the order for trial will direct the delivery of particulars of breaches and notices of objections, as was done under the old practice, when issues were directed by the Court of Chancery under Sir J. Rolt's Act and Lord Cairns' Act (*y*). See *post*, s. 29.

Sufficiency of specification treated as question of fact.

The question of the sufficiency of the specification is properly treated as a question of fact, for although the construction of all written instruments belongs to the court alone, the specification of an invention

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(*t*) For the technical form of the above issues, and for other issues in patent actions, see Seton, p. 554.

(*u*) S. C. R. 1883, Order XXXVI. r. 7 (*a*). See under the old practice *Henderson* v. *Runcorn, etc. Co.*, W. N. 1868, p. 250 ; 19 L. T. (N.S.) 277 ; *Arnold* v. *Bradbury*, L. R. 6 Ch. 706.

(*x*) See the order of Sir H. HAWKINS, *Saxby* v. *Gloucester Wagon Co.*, Appendix, *post*. See also *Curtis* v. *Platt*, 11 L. T. (N.S.) 250. See, however, now the forms in S. C. R. 1883, Appendix K., No. 33.

(*y*) See the order in *Davenport* v. *Jepson*, Seton, p. 554 ; *Bovill* v. *Bird*, W. N. 1867, p. 96.

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contains generally, if not always, some technical terms, some phrases of art, some description of processes, which require the light to be derived from what are called surrounding circumstances, and these are matters of fact on which evidence may be given (*z*).

Upon an issue as to the sufficiency of the specification, an order has been made that a defendant should be at liberty to dispute the utility of parts of the alleged invention, although he had not raised the general issue as to utility (*a*).

Variance between provisional and complete specification

The objection that there is a material variance between the provisional and the complete specification may be taken upon the issue that the specification does not completely describe and ascertain the nature of the invention (*b*).

Issue of true and first inventor.

The issue that the patentee is not the true and first inventor is not the same as the issue that the invention is not new ; "the one objection is applied to the patentee, and shows that he is not a person capable of sustaining such a grant, and the other objection is applied to the invention, and shows that it could not be made the subject of a patent privilege. . . . An invention may be perfectly new to the public, and yet the patentee may not be the *true* and first inventor. For he may have purloined it from another, or it may have been communicated to him by one of his fellow subjects, in either of which cases he could not be the *true* inventor" (*c*). The issue whether the patentee was the true and first inventor ought not to be raised unless the defendant is prepared to support the case that the patentee is not really the inventor, and if taken without real ground the costs will not be allowed (*d*).

A defendant is entitled to have the question of newness of manufacture tried apart from the question of newness of invention (*e*).

Subject-matter.

An issue that "the invention is not the subject of letters patent" is not a proper issue (*f*).

Infringement.

An issue as to infringement was not directed by the Court of Chancery unless the infringement was denied by the defendants (*g*), nor was a defendant allowed to add a totally new question of fact not

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(*z*) *Hill* v. *Evans*, 4 D. F. J. 288, 293 ; *Betts* v. *Menzies*, 10 H. L. C. 117.

(*a*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 536.

(*b*) *Penn* v. *Bibby*, L. R. 2 Ch. 127, 130.

(*c*) Hindmarch on Patents, pp. 268, 269.

(*d*) *Morgan* v. *Windover*, 7 R. P. C. 449 ; *Thomson* v. *Macdonald*, 8 R. P. C. 5.

(*e*) *Spencer* v. *Jack*, 3 D. J. S. 346. See also *Household Co.* v. *Neilson*, 1 Webst. 689.

(*f*) *Penn* v. *Jack*, 14 W. R. 760.

(*g*) *Davenport* v. *Phillips*, 5 N. R. 485.

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suggested by his answer to the questions of fact already directed to be tried. In such a case it was held that a supplemental answer must be filed (*h*).

Patent actions generally not cases for a a jury.

"Tried without a jury unless the court otherwise direct."—In the opinion of eminent judges, patent cases are not, in general, such as to require the intervention of a jury.

Thus, in *Bovill* v. *Hitchcock* (*i*), Lord CAIRNS, C., expressed an opinion that many patent cases could be disposed of by a judge much more satisfactorily than by a jury.

And in *Patent Marine Inventions Co.* v. *Chadburn* (*k*), Lord SELBORNE, C., when refusing an application for a trial by a jury of issues in a patent case, said, "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence in such cases, is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a judge as by any jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the judge. It very rarely happens, if ever it does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the judge, the direction of the judge" (*l*).

Issues to a jury, when granted and when refused.

Before directing an issue to be tried by a jury, the court must be satisfied by evidence that there is a real question to try (*m*). And in the case of *Henderson* v. *The Runcorn Soap and Alkali Co.* (*n*), Sir GEO. GIFFARD, V.-C., said that he would never grant a trial of issues at the request of a defendant when the motion was opposed by the plaintiffs; and in *Roskell* v. *Whitworth* (*o*), it was held by the same learned judge, then Lord Justice, that though there was no inflexible rule as to the

(*h*) *Morgan* v. *Fuller* (1), L. R. 2 Eq. 296.

(*i*) L. R. 3 Ch. 417. See also *Young* v. *Fernie*, 1 D. J. S. 353; *Saxby* v. *Gloucester Wagon Co.*, W. N. 1880, p. 28; *Downes* v. *Hughes & Co.*, 69 L. T. 150.

(*k*) L. R. 16 Eq. 447.

(*l*) See also observations of COCKBURN, C.J., in *Sugg* v. *Silber*, 1 Q. B. D. 362.

(*m*) *Davenport* v. *Phillips*, 5 N. R. 485.

(*n*) W. N. 1868, p. 250; 19 L. T. (N.S.) 377.

(*o*) L. R. 5 Ch. 459.

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stage of a cause at which issues would, on the application of a defendant, be directed to be tried by a jury, the court would require strong proof that the case was one which it could not satisfactorily try if the defendant made the application, not on the occasion of a motion for injunction, or a motion to dissolve an injunction, but by an independent motion at any other time, and especially if it was after the disclosure of the plaintiff's evidence.

Where a patent had been the subject of previous proceedings, and on one occasion a trial had been before a jury, and the plaintiffs were nonsuited on the ground of the insufficiency of the specification, but ultimately the court above held the specification good, and ordered the verdict to be entered for the plaintiffs, who then signed judgment and obtained a decree; and on a second occasion, in an action against another defendant, the jury disagreed; and in a subsequent action against the same defendant he did not appear, and a verdict was taken for the plaintiffs, and afterwards a decree was made in their favour,—Sir W. P. WOOD, V.-C., in a suit against a third defendant who desired to contest over again all the points raised in the preceding actions, refused a reference to a jury (*p*).

But in the same case it was held that if there were a really doubtful question at issue, the court would not decide it for itself if either party desired a jury.

Where in a suit to restrain infringement of a patent the plaintiff opened his case by stating that he should prove certain fraudulent acts on the part of the defendant, and the defendant's counsel stated that these charges were not raised by the pleadings, and asked to have the case tried by a jury, a trial by jury was ordered, and the cause was directed to stand over for that purpose (*q*).

Patent established in previous action, injunction granted, but issue as to novelty to be tried before a jury.

Where a patent had been repeatedly established in previous litigation against other defendants, Lord ROMILLY, M. R., being satisfied at the hearing of the sufficiency of the specification, the utility of the invention, and the fact of infringement, granted an injunction to restrain the defendant from infringing the patent, but directed an issue as to the novelty of the invention to be tried before a jury (*r*).

The circumstance that, as a matter of fact, a patent case arising in the Court of Chancery was, before Lord Cairns' Act (*s*) and Sir John Rolt's Act (*t*), tried by a jury, did not, after the passing of those Acts, enable either party to insist on its then being so tried. The Court of Chancery did not require the legal question to be tried by a jury.

(*p*) *Davenport* v. *Goldberg*, 2 H. & M. 282.

(*q*) *Tangye* v. *Stott*, 14 W. R. 128.

(*r*) *Bovill* v. *Goodier*, L. R. 2 Eq. 195; and see S. C. R. 1883, Ord. XXXVI. r. 8.

(*s*) 21 & 22 Vict. c. 27.

(*t*) 25 & 26 Vict. c. 42.

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"What it required was the judgment of a Court of Common Law. In most cases it was a necessary incident to proceedings at law that there should be the verdict of a jury before judgment; but these cases were sent to law, not that they might be tried by a jury, but because the court had no jurisdiction to decide upon legal rights" (*p*).

Under s. 2 of Sir John Rolt's Act, which empowered the court to send issues to the assizes whenever it should appear that any question of fact might be more conveniently tried by a jury, it was held that this power was not to be exercised unless the court was satisfied that the administration of justice in the particular suit would be more conveniently promoted by sending issues to be so tried (*q*).

By s. 29 of the Judicature Act, 1873, any party to any cause or matter involving the trial of a question or issue of fact, or partly of fact and partly of law, may, with the leave of the judge or judges to whose division the cause or matter is assigned, require the question or issues to be tried at the assizes or at the sittings in London or Middlesex. See also S. C. R. 1883, Order XXXVI. r. 44.

Where under Order XXXVI. r. 1, S. C. R. 1883, in an action for infringement brought in the Chancery Division, a place of trial out of Middlesex was named in the statement of claim, and at the assizes for that place the parties were ready for the trial, it was held that notwithstanding Order XXXVI. r. 34, the judge at the assizes had no power to send the case back to the judge of the Chancery Division merely because there was no time to try it at the assizes (*r*).

Trial by jury cannot be had before a judge of the Chancery Division (*s*).

By Order XXXIV. r. 2, S. C. R. 1883, if it appear to the court or a judge that there is in any cause or matter a question of law which it would be convenient to have decided before any evidence is given or any question or issue of fact is tried, or before any reference is made to a referee or an arbitrator, the court or judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the court, either by special case or in such other manner as the court or judge may deem expedient, and all such further proceedings as the decision of such question of law may render unnecessary may thereupon be stayed.

By Order XXXVI. r. 8, of the same Rules, the court or a judge may in any cause or matter, at any time or from time to time, order that different questions of fact arising therein be tried by different

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(*p*) *Per* Lord CAIRNS, C., L. R. 3 Ch. 419.

(*q*) *Young* v. *Fernie*, 1 D. J. & S. 353.

(*r*) *Fairburn* v. *Household*, 2 R. P. C. 195.

(*s*) *Warner* v. *Murdoch*, 4 Ch. D. 750.

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modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trials and in all cases may order that one or more issues of fact be tried before any other or others.

The first of the two rules last above stated was said by JESSEL, M.R., in *The Republic of Bolivia* v. *The National Bolivian Navigation Co.*, to be intended for cases where the judge saw his way to the final determination of the action; for example, the question of the sufficiency of the specification in a patent case might be tried without any evidence at all, as where it is alleged that the specification is ambiguous or vague(*t*). But except in such a case as this, or in a case like *Bovill* v. *Goodier*, cited above, it is in general an inconvenient course to try the issues in a patent case separately, and before different tribunals(*u*).

An order will not be made for trying the question of infringement by itself unless the validity of the patent is admitted; and a qualified admission of the validity is not sufficient(*x*).

Where several users were alleged in anticipation of a patent, the court at the trial disposed of all the evidence on one of the alleged users before going into the others(*y*).

So also where in the cross-examination of the plaintiff, who was the first witness, an article was shown to him, the use of which his counsel admitted would, if proved, be an anticipation sufficient to invalidate the patent, the defendant was allowed to call a witness to prove the prior user of the article, and the action was dismissed(*z*).

Court of Appeal will not in general interfere with court below as to mode of trial.

If the court below has decided that the case can be satisfactorily tried in any particular mode, the Court of Appeal is exceedingly disinclined to interfere with that decision(*a*).

And where a judge had, under s. 57 of the Judicature Act, 1873(*b*), referred a question of fact in a patent action to the official referee, the Court of Appeal refused to interfere with his discretion(*c*).

By the Arbitration Act, 1889, ss. 13 and 26, repealing and re-enacting with variations s. 56 of the Judicature Act, 1873, any question arising in a cause may be referred for inquiry and report to an official or

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(*t*) 24 W. R. 362.

(*u*) See judgment of Lord WESTBURY, C., in *Young* v. *Fernie*, 1 D. J. & S. 355.

(*x*) *United Telephone Co.* v. *Mottishead*, 3 R. P. C. 213.

(*y*) *Richardson* v. *Castrey*, 4 R. P. C. 265.

(*z*) *Badham* v. *Bird*, 5 R. P. C. 238.

(*a*) *Bovill* v. *Hitchcock*, L. R. 3 Ch. 419; *Williams* v. *Guest*, L. R. 10 Ch. 467; *Brooke* v. *Wigg*, 8 Ch. D. 510, 517; *Ruston* v. *Tobin*, 10 Ch. D. 558; *Wharton* v. *Boffin*, W. N. 1883, p. 97.

(*b*) Now repealed and re-enacted with variations by the Arbitration Act, 1889. See s. 14.

(*c*) *Saxby* v. *Gloucester Wagon Co.*, W. N. 1880, p. 28.

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special referee, and the report of any such referee may be adopted wholly or partially by the court (*d*).

This provision was acted on by PEARSON, J., in *Badische Anilin und Soda Fabrik* v. *Levinstein* (*e*), where certain experiments were directed to be performed by a special referee for the purpose of advising the court; and by the Court of Appeal, in *Moore* v. *Bennett* (*f*), where the referee was appointed to examine and report on the defendant's machine, and directions were given for the machine to be worked in a particular manner.

Where issues have been tried, the plaintiff may at once set down a motion for judgment as soon as the issues have been determined; and where some only of the issues have been tried or determined, any party who considers that the result renders the trial or determination of the others unnecessary, or renders it desirable that such trial or determination should be postponed, may apply to the court for leave to set down a motion for judgment without waiting for such trial or determination. And the court may give such leave upon such terms as may appear just (*g*).

Where issues disposing of the whole question in the suit had been directed, and the cause was in the paper for hearing immediately after the trial of the issues, the court made a decree in the suit, but directed it not to be drawn up till the time for moving for a new trial had expired (*h*); but if a motion for a new trial was refused, the injunction was at once granted (*i*).

Applications for new trials, whether the action has been tried with a jury (*k*), or without a jury (*l*), must be made to the Court of Appeal.

Upon motion for new trial the Court of Appeal would not consider whether the finding was proper, but merely whether there was sufficient evidence to warrant the verdict (*m*).

And if the motion were grounded on the improper rejection of evidence, the evidence ought to have been formally tendered to the judge of the court below, and rejected by him (*n*). And see now S. C. R. 1883, Order XXXIX. rr. 6, 7, and 8.

Where the jury found two claims of a specification to be old and a third one new, and on the question of infringment found that the

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(*d*) See now S. C. R. 1883, Order XXXVI. r. 55.

(*e*) 24 Ch. D. 156.

(*f*) 1 R. P. C. 129. See the Order, p. 133. See also *Edison Co.* v. *Holland*, 5 R. P. C. 459, 480; *North British Rubber Co.* v. *Macintosh*, 11 R. P. C. 477.

(*g*) S. C. R. 1883, Order XL. rr. 7, 8.

(*h*) *Macdougall* v. *General Sewage and Manure Co.*, W. N. 1875, 64; following *Fernie* v. *Young*, L. R. 1 H. L. 63, 84.

(*i*) *Tangye* v. *Stott*, 14 W. R. 387.

(*k*) 53 & 54 Vict. c. 44, s. 1.

(*l*) S. C. R. 1883, Order XXXIX. r. 1.

(*m*) *Penn* v. *Bibby*, L.R. 2 Ch. 127.

(*n*) *Penn* v. *Bibby*, *ubi supra*.

defendant had not infringed this latter claim, a new trial of the question of infringement was refused, on the ground that there must in any case be judgment in the action for the defendant, and that the issue of infringement had become immaterial (*o*).

Where, after verdict for plaintiff, the court, on an application for a new trial, was of opinion that the plaintiff ought to have been non-suited, a new trial was only granted upon the terms that the costs of the new trial should be costs in the cause if the defendant obtained a verdict finally, but should not be costs in the cause if the plaintiff obtained a verdict (*p*).

By S. C. R. 1883, Order XXVII. r. 11, if the defendant makes default in pleading, the plaintiff may set down the action on motion for judgment, and such judgment is to be given as upon the statement of claim the court or a judge may consider the plaintiff entitled to. In such a case, particulars of breaches are to be considered part of the statement of claim (*q*).

If the defendant elects to ask for judgment at the close of the plaintiff's case, and the court considers he is entitled to it, the court is bound to give him that judgment, he running the risk of a new trial in the event of the decision being held to be wrong (*r*). See *post*, p. 158.

Appeals.

On a trial of questions of fact under Lord Cairns' Act, the Court of Appeal had no power to reverse the findings of the judge on the questions of fact, but could only direct a new trial (*s*). Where, however, the issues raised mixed questions of law and fact, then, if the decision of one of the questions discussed was sufficient to dispose of the case, the Court of Appeal might give a final judgment upon it; and, therefore, when the fact which in the judgment of the Court of Appeal showed the invalidity of the patent was proved and not denied by the patentee, it was held that the Court of Appeal was justified in deciding against the patent, without ordering a new trial (*t*). And now, by S. C. R. 1883, Order LVIII. r. 5, if, upon the hearing of an appeal, it shall appear to the Court of Appeal that a new trial ought to be had, the Court of Appeal may, if it shall think fit, order that the verdict and judgment shall be set aside, and that a new trial shall be had. And

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(*o*) *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 229.

(*p*) *Derosne* v. *Fairie*, 1 Webst. P. C. 160.

(*q*) *United Telephone Co.* v. *Smith*, 38 W. R. 70.

(*r*) *Thomson* v. *Macdonald*, 8 R.P.C. 5; *Fairfax* v. *Lyons*, 8 R.P.C. 401, 406.

(*s*) *Simpson* v. *Holliday*, L. R. 1 H. L. 315.

(*t*) *Simpson* v. *Holliday*, cited. above. See also *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.* 1 R. P. C. 229.

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by r. 4 of the same order very full powers of dealing with the case are given to the Court of Appeal.

Where the issues are settled at the commencement of the trial, then, whether the judge delivers his finding on the facts and his judgment on the whole case on separate days or at one time, his finding of fact is an interlocutory order, which, under the Judicature Rules, Order LVIII. r. 15 (*u*), can only be appealed within a limited time. But if no definite issues of facts are settled at the commencement of the trial, the finding of fact, as well as the judgment on the whole case, can be appealed as a final order (*x*).

Where, under Lord Cairns' Act, questions of fact were tried before the judge without a jury, the verdict of the judge was conclusive, and could only be questioned by application for a new trial, as provided by the Act ; and when this course had not been pursued, but the defendants in a patent suit appealed from a decree made against them, founded on a verdict of the judge on a trial of questions of fact, it was held by the House of Lords that, as the decree merely stated the finding of the judge, and did not refer to the evidence, the House could not look at the evidence to see if it afforded grounds for the findings or the decree (*y*).

But upon appeal from a judge where both law and fact are open to appeal there is no presumption that the judgment in the court below is right, and the appellate tribunal is bound to pronounce such judgment as in their view ought to have been pronounced in the court from which the appeal proceeds, and it is not within their competence to say that they would have given a different judgment if they had been the judge of first instance, but that because he has pronounced a different judgment they will adhere to his decision (*z*).

In the absence, however, of very exceptional circumstances, the House of Lords will not on a question of fact disturb concurrent findings of the court of first instance and the Court of Appeal (*a*).

All appeals to the Court of Appeal are to be by way of re-hearing, and are to be brought by notice of motion, and no petition, case, or other formal proceeding is necessary (*b*). The respondent need not give notice of cross-appeal, but if he intends, on the hearing of the appeal, to contend that the decision of the court below should be

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(*u*) Re-enacted with variations, S. C. R. 1883, Order LVIII. r. 15.

(*x*) *Lowe* v. *Lowe*, 10 Ch. D. 432 ; *Krehl* v. *Burrell*, 10 Ch. D. 420.

(*y*) *Fernie* v. *Young*, L. R. 1 H. L. 63.

(*z*) *Riekmann* v. *Thierry*, 14 R.P.C. 105, 116. 117 (H. L.).

(*a*) *Nobel's Explosives Co.* v. *Anderson*, 12 R. P. C. 164, 166.

(*b*) S. C. R. Order LVIII. r. 1.

varied, he is to give notice of such intention to any parties affected by such contention (*c*).

Defendants, against whom an injunction restraining the manufacture or sale of articles in infringement of a patent had been granted, and who subsequently became bankrupt, were held nevertheless to have such an interest in being relieved from the injunction as to entitle them on giving security for costs to proceed with an appeal which had been set down before the bankruptcy (*d*).

Where, after setting down an appeal, defendants became bankrupt, it was held that the appeal could only proceed on the defendants giving security for costs, or the trustee in bankruptcy making himself a party to the proceedings, and an order was made dismissing the appeal unless this was done within a time named (*e*).

Where an appellant is ordered to give security for the costs of an appeal (see S. C. R., Order LVIII. r. 15), and such security is not given within a reasonable time, an order will be made for the immediate dismissal of the appeal unless there are extenuating circumstances (*f*)

Further evidence on appeal.

By S. C. R., Order LVIII. r. 4, the Court of Appeal may receive further evidence, but on appeal from a judgment after trial, this evidence, except as to matters subsequent to the judgment, is to be admitted on special grounds only, and not without special leave.

The "special grounds" referred to in the last-mentioned order mean something in the nature of the production of a lost document, not simply that the applicant could not earlier get sufficient evidence to support the issue now desired to be raised (*g*).

And when a defendant in the court below only raised an issue of infringement, an application to adduce fresh evidence raising an issue of want of novelty was refused in the absence of proof that such evidence could not have been produced at the trial (*h*).

So, also, where a defendant was shown to have known of a certain patent which was put to him when he was examined *de bene esse* before the trial, and was used against him at the trial, but as to which he had not given evidence, he was not allowed to give further evidence on appeal (*i*).

And when a witness for the defendant deposed at the trial to the manufacture and sale of a machine not mentioned in the particulars of

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(*c*) S. C. R. Order LVIII. r. 6. See also rr. 3, 7.

(*d*) *United Telephone Co.* v. *Bassano*, 31 Ch. D. 630.

(*e*) *United Telephone Co.* v. *Bassano, ubi supra.*

(*f*) *Washburn and Moen Manufacturing Co.* v. *Patterson*, 29 Ch. D. 48.

(*g*) *Hinde* v. *Osborne*, 2 R. P. C. 45.

(*h*) *Hinde* v. *Osborne, ubi supra.*

(*i*) *Walker* v. *Hydro-Carbon Syndicate*, 3 R. P. C. 253.

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objections, and the plaintiff did not apply for an adjournment, and on this evidence the judge held the patent invalid, an application by the plaintiff to the Court of Appeal for leave to adduce fresh evidence on the appeal to meet the case thus set up was refused (*k*).

But where the court of first instance had dismissed the action without hearing the defendant's evidence, on the ground of want of subject matter in the alleged invention, the Court of Appeal allowed the defendants to go into their evidence (*l*). See *ante*, p. 155.

Further evidence was also received in the cases cited in the note (*m*).

Where on an appeal from a judgment, given after a trial of several days, during which several objections were gone into, the defendants on the appeal sought to add several new specifications to their objections, alleging that they had only discovered these specifications since the trial. leave to do so was refused, the court considering that it was open to the defendants to raise these objections on a petition for revocation (*n*).

The Court of Appeal has power under this order in a proper case to amend the objections in order to allow fresh evidence of anticipation to be produced (*o*); and it seems that the plaintiff would be allowed under this order to cure a merely formal defect in his title (*p*).

The mere fact that the plaintiff, who was an engineer, was abroad, but desired to attend and instruct his counsel, is not a sufficient ground for postponing the hearing of an appeal (*q*).

Cases before the law officers ought not to be cited before the High Court of Justice or the Court of Appeal (*r*).

Delivery of particulars.

29.—(1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defence, or, by order of the Court or a judge, at any subse-

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(*k*) *Barcroft* v. *Smith*, 14 R. P. C. 172.

(*l*) *Deutsche Nähmaschinen Fabrik* v. *Pfaff*, 7 R. P. C. 251.

(*m*) *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 118; *Britain* v. *Hirsch*, 5 R. P. C. 226. See also *Blakey* v. *Latham*, 6 R. P. C. 184; and on an interlocutory application *Spencer* v. *Anoouts, etc. Co.*, 6 R. P. C. 46.

(*n*) *Shoe Machinery Co.* v. *Cutlan*, [1896] 1 Ch. 108; 12 R. P. C. 530.

(*o*) *Ibid.* See also *Pirrie* v. *York Street Flax Spinning Co.*, 11 R. P. C. 429, 431.

(*p*) *Nordenfelt* v. *Gardner*, 1 R. P. C. 73. See judgment of LINDLEY, L. J.

(*q*) *Walker* v. *Hydro-Carbon Syndicate*, 3 R. P. C. 253.

(*r*) *Siddell* v. *Vickers*, 5 R. P. C. 416, 436.

quent time, particulars of any objections on which he relies in support thereof. Sect. 29.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended, by leave of the Court or a judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

SUB-SECTION 1.

Statement of claim.

"Statement of claim."—The plaintiff must state on the face of his *statement of claim a sufficient case to justify the injunction asked (s).*

The grant of the letters patent must be alleged, and if the plaintiff sues by a derivative title, his title must also be stated. It has been usual to allege the novelty of the invention, but this is not necessary, since the allegation of the grant and the production of the letters patent throw upon the defendant the *onus* of disputing the novelty (*t*). Nor has the court required the plaintiff to allege that the stamp duties necessary for keeping the patent alive have been paid (*u*). It has been, however, usual to allege in general terms that the letters patent are, and since the grant thereof have remained, valid and subsisting, but this allegation is not contained in the model form given in Appendix C. to the S. C. R. 1883, Form No. 6 of Section VI.

(*s*) See *Curtis* v. *Cutts*, 8 L. J. (N.S.) Ch. 184.

(*t*) *Amory* v. *Brown*, L. R. 8 Eq. 664.

(*u*) *Sarazin* v. *Hamel* (No. 1), 32 Ben. 145.

Sect. 29 (1)

NOTE.

There was, at one time, some question whether or not it was necessary to set out the specification in the plaintiff's pleadings, but if the pleadings contained an allegation that the specification duly described and ascertained the nature of the invention, and in what manner the same was to be performed, and that the same had been duly filed (thus showing that the conditions of the letters patent had been complied with), this was sufficient (*x*). It was, however, usual, at all events in bills in Chancery under the old practice, to set out at least so much of the specification as described in general terms the nature of the invention, but since the Judicature Acts this practice has become obsolete, and the model form above mentioned does not in any manner refer to the specification.

The plaintiff must also allege infringement, but in his statement of claim need only allege this in general terms. He must, however, go into detail in the particulars of breaches.

When an action for infringement of a patent has been discontinued, the plaintiff cannot in a second action on the same patent against the same parties join a claim to be repaid the costs of the first action on the ground that its discontinuance was brought about by false evidence on the part of the defendants (*y*).

As to delivery of statement of claim, see now S. C. R. Order XVIIIA. and Order XXX. of May, 1897.

Particulars of breaches.

"Particulars of breaches."—The courts of common law had always a general power to protect a defendant in an action for infringement of patent from surprise, by requiring the plaintiff to deliver particulars of the breaches of which he complained (*z*). But where a motion for an injunction had been made in the Court of Chancery, the Court of Common Pleas considered that the defendants had sufficient information as to the alleged infringement, and refused to require the plaintiffs to give particulars of the alleged infringements (*a*).

Act of 1852.

Particulars of breaches were required by the Act of 1852 (*b*), but were by that statute only applicable to actions at law. However, under Lord Cairns' Act and Sir John Rolt's Act (*c*) (which enabled the Court of Chancery to try by itself, or with a jury, questions of fact, and required it to try all questions of law arising in a cause), the

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(*x*) *Kay* v. *Marshall*, 2 Webst. P. C. 39; *Westhead* v. *Keene*, 1 Bea. 287.

(*y*) *United Telephone Co.* v. *Tasker* (No. 2), 6 R. P. C. 38.

(*z*) *Electric Telegraph Co.* v. *Nott*, 4 C. B. 462; *Perry* v. *Mitchell*, 1 Webst. P. C. 269.

(*a*) *Electric Telegraph Co.* v. *Nott*, *ubi supra*.

(*b*) 15 & 16 Vict. c. 83, s. 41.

(*c*) 21 & 22 Vict. c. 27; 25 & 26 Vict. c. 42.

practice of requiring particulars of breaches and notices of objections was adopted by that court, at all events when issues were directed (*d*). In *Finnegan* v. *James* (*e*), however, it was held that the practice prescribed by the statute ought to be followed in all suits in equity as closely as circumstances would admit, and the practice was, since the Judicature Acts, uniformly followed in the Chancery Division, as well as in the other divisions of the High Court of Justice.

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NOTE.

Particulars of breaches adopted in Chancery.

There was a difference in the requirements of the Act of 1852 (*f*), as to particulars of breaches and notices of objections, and this difference exists also in the present Act. In the former case it is simply enacted that particulars of breaches shall be given, but there is no enactment on the nature of those particulars, while considerable detail was and is required in the objections.

Difference in requirements of particulars of breaches and notices of objections.

Thus, in *Talbot* v. *La Roche* (*g*), where the particulars pointed to a specific article sold by the defendant, the Court of Common Pleas refused to compel a plaintiff in his particulars of breaches to specify particularly the persons with respect to whom, and the occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed. And the court rested their refusal on the ground that the defendant must know whether and in what respects he had been guilty of infringement (*h*).

Particulars sufficient if specific instance of infringement given.

Again, in *Needham* v. *Oxley* (*i*), it was held by Lord HATHERLEY, then V.-C., that when the particulars of breaches, taken together with the pleadings, give the defendant fair notice of the case to be made against him, they are sufficient. In that case the plaintiffs stated in their bill that the defendant's machine included and combined certain named substantial ingredients combined in the plaintiffs' invention, and the combination whereof was new and important, and by their particulars of breaches they simply pointed to certain specified machines, and stated in general terms that these infringed the plaintiffs' patent, and it was contended, but unsuccessfully, that the plaintiffs ought to specify precisely in what respect the defendant's machines were an infringement.

And in *Batley* v. *Kynock* (No. 2) (*k*), where the thing alleged to be an infringement had been made an exhibit in the cause, it was held that it

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(*d*) *Curtis* v. *Platt*, 35 L. J. (N.S.) Ch. 853. See *Bovill* v. *Goodier*, L. R. 1 Eq. 35.

(*e*) L. R. 19 Eq. 72.

(*f*) 15 & 16 Vict. c. 83, s. 41.

(*g*) 15 C. B. 310.

(*h*) See also *Ledgard* v. *Bull*, 11 App. Cas. 649; *S. C.*, reported as *Petman* v. *Bull*, 3 R. P. C. 90; *Walter C. Church Engineering Co.* v. *Wilson*, 3 R. P. C. 123, 127; *Haslam Co.* v. *Hall*, 4 R. P. C. 203.

(*i*) 1 H. & M. 248.

(*k*) L. R. 19 Eq. 229.

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was not necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed. And in an Indian case (the Indian Act being substantially the same as the Act of 1852, as far as it relates to particulars of breaches), it was held, by the Judicial Committee of the Privy Council, that where the plaintiff in his plaint pointed to a particular kiln constructed and used by the defendants and not only referred to his patents but indicated in each case the distinctive features of his invention which he alleged to have been appropriated by the defendants, the Act had been sufficiently complied with notwithstanding formal particulars had not been delivered with the plaint (*l*).

Where reference to particular part of specification required.

But where a specification contained a description of a number of articles, the subject of the invention, a plaintiff has been ordered to point out what part of the specification he alleges to have been infringed.

Thus, in *Perry* v. *Mitchell* (*m*), a case before the Act of 1852, in a suit to restrain infringement of a patent for making pens, thirteen different sorts being mentioned in the specification, the plaintiff was ordered to specify the particular pens shown in the drawing annexed to the specification in respect of which infringement was alleged.

And in *Talbot* v. *La Roche* (*n*), it was said by JERVIS, C.J., that if two processes described in a specification were wholly distinct from each other, and the defendant's process might be an infringement of the one, and not of the other, particulars in general terms would not be sufficient.

So, also, in *Patent Type Founding Co.* v. *Richard* (*o*), a merely general allegation of infringement of a patent for making type was struck out of the particulars, apparently on the ground that the case was distinguishable from *Talbot* v. *La Roche* (where the general allegation was held sufficient) in the circumstance that type might be made in various different ways, whereas *Talbot* v. *La Roche* was a case of sun pictures, and one instance would represent the process in every instance.

And in *Lamb* v. *The Nottingham Manufacturers Co.* (*p*), a case since the Act of 1852, a plaintiff was ordered to specify, by reference to pages and lines, the parts of his specification in respect of which the alleged breaches had been committed.

(*l*) *Ledgard* v. *Bull*, 11 App. Cas. 648.

(*m*) 1 Webst. P. C. 269.

(*n*) 15 C. B. 320.

(*o*) 2 L. T. (N.S.) 359.

(*p*) Seton, 557, cited in *Batley* v. *Kynoch* (No. 2), L. R. 19 Eq. 229, where it is stated by counsel that there was an admission of infringement, and that there had been an inspection. See also *Jones* v. *Lee*, 25 L. J. (N.S.) Ex. 241.

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Present practice.

Under the present Act it has been held that the plaintiff should state whether he alleges breaches of all or only some and which of the claims in the specification (*q*). But where the particulars referred to pages and lines of the specification, this was held sufficient, though the claiming clauses were not mentioned (*r*). In a simple case a reference to the claims alleged to be infringed was held sufficient without reference to pages and lines (*s*). And in an action on two patents relating to dog muzzles, the specification of the first having a single claim for an improved dog muzzle, and the specification of the second having two claims, one for providing the muzzle with guides and the other for the improved muzzle described, particulars of breaches, alleging that the defendant had made and sold muzzles substantially in accordance with the improved muzzle described and claimed in the first specification, and also substantially in accordance with the improved muzzle described and claimed in the second specification and illustrated in the drawings thereof, and that the defendant's muzzles were guided substantially in accordance with the first claim of the second specification, were held sufficient (*t*).

In *Walter C. Church Engineering Co.* v. *Wilson* (*u*), particulars of breaches alleging infringement by reference to certain named claiming clauses of the plaintiffs' specification, and identifying certain machines of the defendant as infringements, were held sufficient, and a summons requiring the plaintiffs to give further particulars by stating what portions of the plaintiffs' specification were alleged to be infringed with reference to pages and lines of such specification, was dismissed.

In an action for infringement of a patent for a new dye which the plaintiff sold as "Naphtol black," the specification claiming the process and the new colouring matter, it was held by the Court of Appeal that the proper form of particulars of breaches was as follows: "(i.) The defendants have, since the date of the patent, manufactured or caused to be manufactured and sold, dye stuffs the same, or substantially the same, as the plaintiff's Naphtol black. (ii.) The dye stuffs complained of are those sold by the defendants under the name of Naphtol black O. D. (iii.) The dye stuffs complained of are made according to the process described and claimed in the plaintiff's specification in all respects" (*v*).

Specific instances required.

An allegation that defendants had infringed by importing and selling glass globes treated with the patented process was held too wide, and

(*q*) *Haslam Co.* v. *Hall*, 4 R. P. C. 203.

(*r*) *Elsey* v. *Butler*, 1 R. P. C. 189.

(*s*) *Cheetham* v. *Oldham* (No. 3), 5 R. P. C. 624.

(*t*) *Egleton* v. *Nichols*, 7 R. P. C. 423.

(*u*) 3 R. P. C. 123. *Wenham Co.* v. *Champion Gas Lamp Co.*, 8 R. P. C. 22.

(*v*) *Cassella* v. *Levinstein*, 8 R. P. C. 473.

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the plaintiffs were ordered to give specific instances (*x*). And where in an action on several patents for water-proofing garments the particulars of breaches alleged sales by the defendant of certain named articles and of other waterproof garments made by the manufacturers of the named articles but not bearing their distinguishing names, but which unnamed garments were manufactured by similar processes to the named garments, and that every one of the patented processes had been used in the manufacture of the named and the other garments, the particulars were held insufficient (*y*).

But in a simple case particulars alleging infringement by reference to certain claims of the specification, but not identifying the plaintiff's process with defendant's process, were held sufficient (*z*).

In an action for infringement a patentee will not be compelled to produce to the defendant a specimen of the patented article (*a*).

Nor can a plaintiff be compelled in particulars of breaches to put a construction on his specification (*b*).

References by way of example not now allowed.

A plaintiff has been allowed, after specifying particular instances of infringement, to add words stating that the instances were given by way of example only and not so as to preclude him at the trial from insisting on other infringements (*c*) ; but in *Walter C. Church Engineering Co.* v. *Wilson* (*d*), the words "in particular and by way of illustration" were held to be too wide. In *Haslam Co.* v. *Hall* (*e*), however, where the particulars complained "*by way of example and not of limitation*" of certain machines fitted by the defendants on board a named ship, and *of all machines made by the defendants similar to them*, the words in italics were allowed to remain, the plaintiff, however, being confined (so far as concerned machines fitted to ships) to the named ship unless further names were given.

Where there is a question of amending particulars of the types of engines alleged to be infringements, it lies on the party who alleges that for the honest purpose of his litigation he wants further information or limitation to satisfy the court that he is really placed in a difficulty by the particulars as they stand (*f*).

And where a plaintiff had given particulars of breaches alleging generally the manufacture of articles according to the invention, and

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(*x*) *Tilghman's Patent Sandblast Co.* v. *Wright*, 1 R. P. C. 103.

(*y*) *Mandleberg* v. *Morley*, 10 R. P. C. 256.

(*z*) *Cheetham* v. *Oldham* (No. 3), 5 R. P. C. 624.

(*a*) *Crofts* v. *Peach*, 1 Webst. 268.

(*b*) *Wenham Co.* v. *Champion Gas Lamp Co.* 8 R. P. C. 22.

(*c*) *Talbot* v. *La Roche*, 15 C. B. 310 ; *Tilghman's Patent Sandblast Co.* v. *Wright*, 1 R. P. C. 103.

(*d*) 3 R. P. C. 125.

(*e*) 4 R. P. C. 204.

(*f*) *Haslam Co.* v. *Hall*, 4 R. P. C. 203, 207, *per* WILLS, J.

specifying sales to one particular company, but stating that he could not give further particulars till he had obtained discovery from the defendant, a motion for better particulars was ordered to stand over till after the defendant had given discovery (*g*). **Sect. 29 (1)** NOTE.

Where the particulars of breaches are in form sufficient, and the plaintiff has in answer to interrogatories pledged his oath to their correctness, he cannot be required to answer interrogatories asking for particulars of the alleged infringement (*h*).

Where the defendant is a vendor only, the court may require greater detail in the particulars than where the defendant manufactures the infringing article (*i*).

SUB-SECTIONS (2) (3).

"Statement of defence."—See notes on s. 26 (3). A defendant in an action for infringement desiring to dispute the validity of the patent must state in his pleadings the various grounds of defence relied on, or he will not be allowed to bring them forward at the trial. Thus, in a case in Chancery, where notices of objections had not been ordered, and a defendant, by his answer, denied the validity of the patent on various specified grounds, but did not mention an objection that the patent was for an invention included in an expired French patent, and was therefore void under 15 & 16 Vict. c. 83, s. 25 (*k*), the court refused at the hearing to allow this objection to be raised (*l*). And a defendant who had, by his answer, disputed the validity of the patent upon certain specified grounds on which issues of fact were directed, was not allowed to add totally new issues of fact not suggested by the answer (*m*). Defence to state all the grounds of defence.

A defendant, who by his defence had simply denied infringement, has, however, been allowed, after the case had been set down for trial, to amend his defence by inserting therein a denial of the validity of the plaintiff's patent, but only on the terms that the defendant should pay the costs of the application and all costs occasioned by the amendment (*n*).

Where the defence was (1) a denial of infringement, (2) an allegation that if any such construction were put upon the claims of the

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(*g*) *Russell* v. *Hatfield*, 2 R. P. C. 144. See also *Millar* v. *Harper*, 38 Ch. D. 110.

(*h*) *Hoffmann* v. *Postill*, L. R. 4 Ch. 673, 674; *Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351; *Ehrlich* v. *Ihlee*, 5 R. P. C. 37.

(*i*) *Mandleberg* v. *Morley*, 10 R. P. C. 256.

(*k*) Repealed and not re-enacted in the present Act.

(*l*) *Borill* v. *Goodier* (No. 2), L. R. 2 Eq. 195.

(*m*) *Morgan* v. *Fuller* (1), L. R. 2 Eq. 296.

(*n*) *United Telephone Co.* v. *Bassano*, 2 R. P. C. 70.

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specification as would include the articles made by the defendant the patent was invalid, it was held that this allegation, though unnecessary, was not embarrassing within the meaning of S. C. R. Order XIX. r. 27, and the Court refused to strike it out of the defence (*o*).

As to delivery of statement of defence, see now S. C. R. Order XVIIIA., and Order XXX. of May, 1897.

But where there was a contract between plaintiff and defendant relating to certain patents and involving a right for defendant to work the invention at a royalty, it was held in an action on the contract, and for an account and injunction, that the defendant could not combine with his defence to the contract a defence to an action for infringement. And all the paragraphs of the defence relating to invalidity of the patent were struck out (*p*).

Form of pleas to raise particular issues.

The following cases have been decided upon the subject of the proper pleas to raise the issues in an action for infringement of patent.

The issue as to novelty of invention is distinct from the issue whether the patentee was the first inventor (*q*).

Invention not new manufacture.

In *Walton* v. *Potter* (*r*), it was held that a plea that the invention was not a new manufacture admitted the invention to be a manufacture, and put in issue the novelty (*s*). But in *Bush* v. *Fox* (*t*) it was held by the House of Lords that this plea put in issue both the novelty of the invention and its being a manufacture; and in *Spencer* v. *Jack* (*u*), the defendant was allowed to have the question of newness of manufacture tried apart from the question of newness of invention.

Under plea of not new manufacture want of utility cannot be alleged.

Under a plea that the patentee was not the inventor, or that the invention was not a new manufacture, no objection can be taken to the specification (*x*). Nor will a plea that the invention is not a new manufacture allow the defendant to raise the defence of want of utility (*y*).

Plea of no subject-matter.

An objection that the invention is not the proper subject for a patent cannot be taken under a plea denying the novelty of the invention (*z*), or upon a plea denying infringement (*a*).

(*o*) *Hocking* v. *Hocking*, 3 R. P. C. 291.

(*p*) *McDougall* v. *Partington*, 7 R. P. C. 216.

(*q*) *Household Co.* v. *Neilson*, 1 Webst. 689.

(*r*) 1 Webst. 601, 611. See also 1 Webst. 598, n. (*h*).

(*s*) See also *Spilsbury* v. *Clough*, 1 Webst. 255.

(*t*) Macr. P. C. 179.

(*u*) 3 D. J. S. 346.

(*x*) *Bateman* v. *Gray*, Macr. P. C. 110.

(*y*) *Walton* v. *Bateman*, 1 Webst. 623.

(*z*) *Walton* v. *Potter*, 1 Webst. 598; *Household Co.* v. *Neilson*, 1 Webst. 677.

(*a*) *Household Co.* v. *Neilson*, 1 Webst. 677.

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Proper plea to raise issue of utility.

Questions have been raised as to the proper form of pleading the defence of want of utility of the invention. The requirement of utility does not arise from express words to that effect in the Statute of Monopolies (*b*), but is rather an inference from the enactment in that statute that the monopoly granted must "not be mischievous to the State, or to the hurt of trade, or generally inconvenient" (*c*). And it seems to have been thought that the proper form of plea was to plead the statute, and not merely the want of utility.

The practice at common law, however, appears to have been to put in a plea denying utility in general terms (*d*), and the practice was followed in the Court of Chancery (*e*).

Insufficiency of specification.

Under the old law insufficiency of the specification was one of the most usual grounds of objection to a patent. This was founded on the condition which was contained in the patent obliging the patentee to file a specification ascertaining the nature of his invention, and in what manner it was to be performed, and unless that condition was complied with the patentee forfeited all the benefit he derived from the Great Seal (*f*).

The form of patent given in the first schedule to the present Act (which, however, is not compulsory (*g*)) contains no condition avoiding the patent if the specification be insufficient. But the objection may still be taken in actions upon patents granted under the present Act. Insufficiency of the specification was a ground on which a patent might be repealed by *scire facias* (*h*), and by s. 26, sub-s. 3, of this Act, every such ground is made available by way of defence to an action for infringement (*i*).

Objections to specification, still available in case of new patents.

Disconformity between provisional and final specification still a defence.

So also the fact that the complete specification differed materially from the provisional, was a ground for *scire facias* at the commencement of this Act, and by s. 26, sub-s. 3, may therefore be taken as a defence to an infringement action (*k*).

What objections may be

Under a plea of the insufficiency of the specification, it has been held that it is not open to contend that the specification is not as large

(*b*) 21 Jac. 1, c. 3, s. 6.

(*c*) *Morgan* v. *Seaward*, 1 Webst. 197.

(*d*) Hindmarch on Patents, 275, and cases there cited.

(*e*) *Simpson* v. *Holliday*, *Renard* v. *Levinstein*, and *Morgan* v. *Fuller*, all cited Seton, 555; *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 536.

(*f*) *Arkwright* v. *Nightingale*, 1 Webst. P. C. 61.

(*g*) Section 33, *post*.

(*h*) *Ante*, p. 125.

(*i*) See *Siddell* v. *Vickers*, 39 Ch. D. 92, judgment of COTTON and FRY, L. JJ.

(*k*) *Nuttall* v. *Hargreaves*, [1892] 1 Ch. 23, following *dictum* of Lord HALSBURY, L.C. in *Vickers* v. *Siddell*, 15 App. Cas. 496, 499.

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as the title (*l*), nor, apparently, that the patent is for a principle only, and therefore void (*m*), nor that the invention is not the subject-matter of letters patent (*n*).

taken under plea of insufficiency of specification.

Upon an issue as to the sufficiency of the specification, it seems to have been doubted (*o*) whether a defendant could prove that the complete specification differed materially from the provisional specification, a fact which, if established, would invalidate the patent (*p*). But in *Penn* v. *Bibby* (*q*), Lord CHELMSFORD, C., allowed this to be done, and said that the specification did not particularly describe and ascertain the nature of the invention if the complete specification departed from the terms of the title or of the provisional specification, in which the nature of the invention must be described.

Ignorance no defence.

It is no defence to an action for infringement to say that the party charged was not aware of the existence of the patent (*r*), or was not aware that the article complained of was an infringement (*s*), or that the acts complained of were done by workmen employed by the defendant, but contrary to orders (*t*).

Nor the fact of no intention to infringe.

Nor is the intention of the defendant material if he has in fact invaded the rights of the patentee (*u*); and the fact that the defendant did not intend to infringe is no answer to a motion to commit for breach of an injunction which restrained infringement (*x*).

And where the defendant, who was a dealer only, had bought the article complained of in open market, without knowledge of the process of its manufacture, and, on the plaintiffs bringing to his knowledge the fact of an infringement, had offered, if the plaintiffs would refrain from taking proceedings, to cease to purchase the article, except from the plaintiffs, and the defendant had complied with his promise and

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(*l*) *Derosne* v *Fairie*, 1 Webst. 161; *Neilson* v. *Harford*, 1 Webst. 312. See, however, *Penn* v. *Bibby*, L. R. 2 Ch. 127.

(*m*) *Jupe* v. *Pratt*, 1 Webst. 151.

(*n*) *Walton* v. *Potter*, 1 Webst 598; *Household Co.* v. *Neilson*, 1 Webst. 677.

(*o*) *Morgan* v. *Fuller* (1), L. R. 2 Eq. 297; *Derosne* v. *Fairie*, 1 Webst. 161; *Neilson* v. *Harford*, 1 Webst. 312.

(*p*) *Foxwell* v. *Bostock*, 4 D. J. S. 298; *Bailey* v. *Roberton*, 3 App. Cas. 1055.

(*q*) L. R. 2 Ch. 127, 130.

(*r*) *Wright* v. *Hitchcock*, L. R. 5 Ex. 37; *Davenport* v. *Rylands*, L. R. 1 Eq. 303; *Wittman* v. *Oppenheim*, 27 Ch. D. 260; *Young* v. *Morris*, 11 R. P. C. 617.

(*s*) *Walton* v. *Lavater*, 8 C. B. (N.S.) 162; *Wright* v. *Hitchcock*, L. R. 5 Ex. 37; *Geary* v. *Norton*, 1 De G. & Sm. 9.

(*t*) *Betts* v. *De Vitre*, L. R. 3 Ch. 430.

(*u*) *Heath* v. *Unwin*, 15 Sim. 552, disapproving what had been said in the same case by the Court of Exchequer, 13 M. & W. 583; *Stead* v. *Anderson*, 2 Webst. 156. See also *Seed* v. *Higgins*, 5 Jur. (N.S.) 540, 543; 8 E. & B. 771; *Young* v. *Rosenthal*, 1 R. P. C. 29, 39.

(*x*) *Plimpton* v. *Spiller*, 4 Ch. D. 286, 288.

had sold none of the patent articles since that time, except the trifling residue he had in stock, and had since purchased a considerable quantity from the plaintiffs, who had, nevertheless, without further communication, filed their bill, it was held that there was nothing in these circumstances which could operate as accord and satisfaction for the wrong committed by the infringement, and the plaintiffs were held to be entitled to damages (*y*). In this case the patent had expired pending the litigation, and therefore no injunction could be granted.

When defendant infringed in ignorance, injunction not always granted.

But although a plaintiff may have his action against a defendant infringing in ignorance of the patent, it is not a matter of course that he should be entitled in such a case to an injunction; and therefore, where a retailer had unwittingly sold a few articles in infringement of the patent, but gave the plaintiff full information as to where he had obtained the articles complained of, and promised not to sell any more, a bill for an injunction was dismissed, and he was left to his remedy in damages (*z*).

And where defendant had not intended to sell, but had lent on an undertaking to return, certain instruments admitted to be made in infringement of a patent, and these had come into plaintiff's possession, and this was the only evidence of infringement, the action was dismissed with costs; but the instruments being piracies an order for their return to the defendant was refused (*a*).

And in a Scotch case where the defendant admitted infringement before the action, but had discontinued such infringement, and offered to pay what was reasonable in respect of it, and the action was brought in respect of a different article which the court held not to infringe, it was held that there was no case for an interdict, and, notwithstanding the previous admitted infringement, the plaintiff must pay the costs of the action (*b*).

Particulars of objections under Act of 1835.

"**Particulars of objections.**"—By the 4 & 5 Will. 4, c. 83, s. 5, it was enacted that in an action brought against any person for infringing letters patent, the defendant on pleading thereto should give to the plaintiff a notice of any objections on which he meant to rely at the trial of such action, and that no objection should be allowed to be made in behalf of such defendant at such trial unless he proved the objections stated in such notice. This Act (*c*) did not require any more detail in the objections than in the particulars of breaches.

(*y*) *Davenport* v. *Rylands*, L. R. 1 Eq. 305.

(*z*) *Betts* v. *Willmott*, 18 W. R. 946; *Upmann* v. *Elkan*, L.R. 12 Eq. 145. See also *Thornton* v. *Baker*, 3 Times R. 715.

(*a*) *United Telephone Co.* v. *Henry*, 2 R. P. C. 11.

(*b*) *Fletcher* v. *Glasgow Gas Commissioners*, 4 R. P. C. 386.

(*c*) Section 5.

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Upon this statute it was soon decided that the particulars of objections delivered by a defendant were not conclusive at his peril; and that if they were insufficient the court could compel delivery of fuller and better particulars (*d*).

And further, that the objections were intended to give more specific information than the pleas (*e*), and that in general a notice of objections in the terms of the pleas would be insufficient (*f*).

Some difference of opinion seems to have prevailed as to the details which the court, under the Act of Will. 4, could require to be given of alleged prior user of the patented invention. In *Bulnois* v. *Mackenzie* (*g*) the Court of Common Pleas considered that they had no power to require the defendant to set out the names and addresses of those who were alleged to have used the invention previously to the patent. A similar view was taken in the cases of *Carpenter* v. *Walker* (*h*), *Heath* v. *Unwin* (*i*), and *R.* v. *Walton* (*k*). In *Jones* v. *Berger* (*l*), however, when the defendant's objections stated that the invention had been previously published by certain named persons in certain specifications, and "also by other persons in other books or writings," it was held that the defendant must specify the books relied on; and in *Galloway* v. *Bleaden* (*m*), the names, addresses, and descriptions of alleged prior users were ordered to be furnished. The question was again considered in *Russell* v. *Ledsam* (*n*), where the Court of Exchequer, upon a review of all the above-mentioned cases, decided that a defendant could not be compelled, in an objection for want of novelty, to state who was the first inventor, or when and in what place and under what circumstances the invention was used before.

Upon an objection that the specification is insufficient, it was held that if the plaintiff was contented to take that as notice, any objection showing insufficiency might be made at the trial (*o*).

And objections that the invention was not properly set forth in the specification (*p*), or that the specification is calculated to deceive (*q*), or that the specification does not sufficiently distinguish between what is

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(*d*) *Bulnois* v. *Mackenzie*, 1 Webst. P. C. 260.

(*e*) *Bulnois* v. *Mackenzie*, *ubi supra*; *Jones* v. *Berger*, 1 Webst. P. C. 544; and see judgment of CRESSWELL, J., in *Walton* v. *Bateman*, 1 Webst. P. C. 616.

(*f*) *Neilson* v. *Harford*, 1 Webst. P. C. 370; *Betts* v. *Walker*, 14 Q. B. 363, 368. See also *Walton* v. *Bateman*, 1 Webst. P. C. 268, n.

(*g*) 1 Webst. P. C. 260.

(*h*) 1 Webst. P. C. 268 n.

(*i*) 10 M. & W. 684.

(*k*) 2 Q. B. 969.

(*l*) 1 Webst. P. C. 544.

(*m*) 1 Webst. P. C. 268, n.

(*n*) 11 M. & W. 647.

(*o*) *Neilson* v. *Harford*, 1 Webst. P. C. 332.

(*p*) *Heath* v. *Unwin*, 10 M. & W. 687.

(*q*) *Neilson* v. *Harford*, 1 Webst. P. C. 324, n.

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new and what is old (*r*), or did not describe the most beneficial method with which the patentee was acquainted of practising his invention (*s*), or did not sufficiently describe the nature of the invention, or the manner in which it was to be performed (*t*), or that the invention does not produce the effect stated (*u*), were all held sufficient without going into particulars. It will be seen, however (*post*, p. 174), that under the most recent practice detailed particulars are now required in the case of several of these objections.

But upon an objection that the invention for which the patent was granted was more extensive than that described in the specification, and another objection founded on discrepancy between the drawings and specification, the defendant was required to call the plaintiff's attention to the particular parts (*x*). And where an objection alleged, as to certain letters patent the term of which had been extended by the Judicial Committee of the Privy Council, that such extension had been obtained by fraud, covin, and misrepresentation, the defendant was required to state the species of fraud, covin, and misrepresentation on which he relied (*y*).

Where a defendant in one objection alleged that the patentee had not, by his specification, sufficiently described the invention, and in a second objection that the patentee had not enrolled *any specification* sufficiently describing, etc., this was held not precise enough, and the word "*other*" was ordered to be inserted before the word "specification" in the second objection (*z*).

Particulars of objections under Acts of 1852 and 1883.

The Act of 1852 (*a*), defined the detail as to prior user necessary in particulars of objections, and required such particulars to state "the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent."

Several cases have been decided on this section, and these will probably form a guide to the construction to be placed on the words in the present sub-section, words which, though differing from and perhaps somewhat wider than the corresponding words of the Act of 1852, do not, it is submitted, carry the rules as to particulars of objection further than had been the practice under the latter Act.

(*r*) *Jones* v. *Berger*, 5 M. & G. 208.

(*s*) *Ibid*; *S. C.*, 1 Webst. P. C. 546.

(*t*) *Heath* v. *Unwin*, 1 Webst. P. C. 551, n.

(*u*) *Ibid.*

(*x*) *Fisher* v. *Dewick*, 1 Webst. P. C. 551, n.

(*y*) *Russell* v. *Ledsam*, 11 M. & W. 647.

(*z*) *Leaf* v. *Topham*, 14 M. & W. 146.

(*a*) 15 & 16 Vict. c. 83, s. 41.

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Prior specifications and prior user.

Thus, in *Curtis* v. *Platt* (*b*), the defendants, under an order requiring them to state "the place where, and the earliest date at which," the machines they relied on as showing a prior user had been made, gave a list of thirteen persons and firms, with a general statement that the user had, in all the cases, been at the earliest from 1825 downwards. It was contended that they ought to state in each instance the place at which the first machine had been made, and the date of making. Lord HATHERLEY, then Sir W. P. WOOD, V.-C., ordered the particulars to be amended, observing that, as far as concerned the date of user and the place of use of the machines, the defendants were bound to give the plaintiff all the information they themselves had. And in the same case the defendants, having alleged in their objections prior publications in books, and done this by a mere general reference, were ordered to state the particular work or document, and the volume of that work, in which the alleged prior publication was found. So also, where a defendant relied on prior specifications as anticipating the plaintiff's patent, it was held that he must point out the particular pages and lines of the prior specifications on which he relied, and in a case where infringement of several patents was complained of in one action, a defendant relying on prior user was ordered to state which parts of plaintiff's machines he alleged to have been so used (*c*).

Pages and lines.

Reference to claiming clauses of plaintiff's specification.

In the *London and Leicester Hosiery Co.* v. *Higham* (*d*), the defendant was ordered not only to state what portions of the specifications alleged as prior publications were alleged to anticipate the plaintiff's patents, with a reference to pages and lines of such specifications, but also what portions of plaintiff's inventions were alleged to have been published or used prior to the date of the letters patent, with reference to the claiming clauses of the specifications of such letters patent.

Present practice.

These rules have been in effect adopted in particulars of objections under the present Act, and defendants relying on prior specifications or anticipations have been ordered to state, by reference to pages and lines, what parts of the specifications are relied on (*e*). And when the plaintiff's specification has several claims, the court, following the order in the *London and Leicester Hosiery Co.* v. *Higham*, cited above, has compelled a defendant to show further to which of the plaintiff's

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(*b*) 8 L. T. (N.S.) 657.

(*c*) *Grover & Baker Sewing Machine Co.* v. *Wilson*, W. N. 1870, 78. See also *Fisher* v. *Dewick*, 1 Webst. P. C. 264; *Plimpton* v. *Spiller*, Higgins, p. 312.

(*d*) Appendix, *post*.

(*e*) *Fowler* v. *Gaul*, 3 R. P. C. 247; *Heathfield* v. *Greenway*, 11 R. P. C. 17, 19. See also *Harris* v. *Rothwell*, 3 R. P. C. 243; *Boyd* v. *Farrar*, 5 R. P. C. 33, 36.

claims the specifications relied on are addressed (*f*). In *Heathfield* v. *Greenway* (*g*), however, it was said by NORTH, J., that there must be special grounds for an order of this sort. Sect. 29 (2,3) NOTE.

And in a case where anticipation by prior user of a particular machine was alleged, KAY, J., refused to compel the defendant (although the plaintiff's specification contained seventeen claims) to state the parts of the plaintiff's invention which were said to be anticipated, as the plaintiff must be taken to understand his own patent well enough to be able, on seeing the machine, to judge how far it is or is not an anticipation of his invention (*h*).

Where a defendant had stated in objections alleging prior specification that "the parts relied upon are the whole specification, but more particularly," with a reference to certain portions of the specification, he was ordered to strike out the words denoting reliance on the whole, but was at liberty to refer to other pages and lines beyond those already referred to (*i*).

Detail in objections alleging prior publication.

But it would appear that an actual reference to pages and lines of the specification relied on is not always necessary. The whole question of the detail required in particulars of objections alleging prior publication was considered by the Court of Appeal in *Holliday* v. *Heppenstall* (*k*). In that case the defendants relied on seventeen specifications, all of them short, and in each case on the whole specification; and they also relied on a large number of other publications, referring in most instances to one page only, but in others to several pages. It was held that the particulars were insufficient, and that the defendants must give further and better particulars, and specify what the alleged anticipations were, and where they were to be found, but the defendants were not bound to state what were the particular pages of the documents relied on. And it was said by COTTON, L.J., that if the defendants would state the nature of the anticipation on which they relied, state where they found it, and, in the case of a specification, show on what part of the claim they relied, that would be enough, unless there was something else in the specification or publication of such a nature that it remained doubtful on what they meant to rely.

A defendant is, however, at liberty to say that he relies on the whole of a specification as anticipating the plaintiff's invention, and if the court comes to the conclusion that he is honestly relying on the whole,

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(*f*) *Harris* v. *Rothwell*, 3 R. P. C. 243; *Boyd* v. *Farrar*, 5 R. P. C. 33, 36; *Boyd* v. *Horrocks*, 3 R. P. C. 285.

(*g*) 11 R. P. C. 17, 19.

(*h*) *Boyd* v. *Farrar*, 5 R. P. C. 33.

(*i*) *Harris* v. *Rothwell*, 3 R. P. C. 243.

(*k*) 41 Ch. D. 109.

Sect. 29 (2,3) it will not compel him to give further particulars, although the specification may be of great length (*l*).

NOTE. But it is always in the discretion of the court to examine the matter, and see whether it is in fact the whole of the specification which is relied on (*m*).

Public general knowledge. If the defendant intends to depend for resistance to the plaintiff's claim upon common knowledge, as distinguished from anticipation, it is convenient, if not necessary, to plead that distinctly (*n*).

In *Holliday* v. *Heppenstall*, cited above, it was held that it is not required by the Act of Parliament that, if a defendant relies on general public knowledge as an objection to the patent, he should state all the books or publications which contain that knowledge. That is to be proved by witnesses in a general way, and, if necessary, by reference to well-known works, and the defendants were ordered to strike out from their particulars all the publications on which they relied simply as enabling them to prove general knowledge. And in *Siemens* v. *Karo* (*o*), this case was treated by CHITTY, J., as deciding that it is a wrong method of framing particulars when, by way of illustration of the case intended to be made, under the head of general public knowledge particular instances are given, which, according to the mode in which the objections are framed, can be made use of as special and particular anticipations of the patent.

But the case of *Holliday* v. *Heppenstall* is not an authority for allowing a defendant to use, as the only evidence of common knowledge, a specification not mentioned in the objections (*p*). And in the *Solvo Laundry Co.* v. *Mackie* (*q*), it was held that specifications do not show common knowledge, and a defendant, who in an action for infringement pleaded that if the plaintiffs alleged that material parts of their alleged invention had been used by her, such parts were old and in common use before the patent, but did not deliver any particulars of objections, was not allowed to adduce in evidence any prior specifications, although such specifications had been referred to on a motion for injunction in a threats action brought by the defendant against the plaintiffs, which came on for trial with the infringement action.

Detail in objections on specification. A defendant objecting that the invention described in the complete specification differed from that described in the provisional specification,

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(*l*) *Nettlefolds* v. *Reynolds*, 8 R. P. C. 410; *Siemens* v. *Karo*, 8 R. P. C. 376; *Sidebottom* v. *Fielden*, 8 R. P. C. 267.

(*m*) Per CHITTY, J., *Siemens* v. *Karo*, 8 R. P. C. 378.

(*n*) Per KEKEWICH, J., *Phillips* v. *Irel Cycle Co.*, 7 R. P. C. 77, 82.

(*o*) 8 R. P. C. 376, 377.

(*p*) *English and American Machinery Co.* v. *Union Boot and Shoe Co.*, 11 R. P. C. 367.

(*q*) 10 R. P. C. 68.

was ordered to give further and better particulars, pointing out the alleged difference (*r*).

And the words "in particular" were struck out of such an objection so as to confine it to the particular instance of variance stated (*s*).

And if a defendant alleges that the specification does not sufficiently describe the nature of the invention, and in what manner it is to be performed, or that it is ambiguous and misleading, he must state in what respects the description fails, or the specification is ambiguous or misleads (*t*).

And where, in an action for infringing a patent for dynamo-electric machines, on an objection that the specification did not sufficiently describe the nature of the invention, and in what manner the same was to be performed, a defendant had been ordered to give further particulars, it was held by the Court of Appeal that an allegation that the specification did not contain a sufficient direction to enable a workman skilled in the manufacture of electrical machinery to make a dynamo-electric machine in which the electro-motive force is kept approximately constant at constant speed when the resistance of the external circuit varies (words taken from the claim in the specification), was not sufficiently explicit, it being admitted that the defendants were in a position to give better particulars (*u*).

Flower v. *Lloyd*.

Under the Act of 1852, it was held by the Court of Appeal that an order requiring further particulars of objection must in form be confined to the particulars mentioned in the Act, and therefore, where an order had been made requiring the defendants to state *the names and addresses of the persons by whom*, and the places where, *and the dates at*, and the manner in which, the alleged prior user had taken place, it was held by the Court of Appeal that the order must be varied by omitting the particulars printed above in italics (*x*). The court, however, intimated that under the order so varied the defendants would still be required to furnish full and sufficient particulars; and accordingly, where the defendants, having, in alleged obedience to the last-mentioned order, given to the plaintiff particulars of prior user by three persons, the names and addresses of whom were furnished, added a statement that the invention had been used by "other persons in London and Birmingham," these words were held to be too indefinite, and the defendants were ordered to give more specific information, or to submit

Limits of *Flower* v. *Lloyd*.

(*r*) *Anglo-American Brush Electric Light Corporation* v. *Crompton*, 34 Ch. D. 152.

(*s*) *Heathfield* v. *Greenway*, 11 R. P. C. 17.

(*t*) *Heathfield* v. *Greenway*, *ubi supra*.

(*u*) *Crompton* v. *Anglo-American Brush Corporation*, 35 Ch. D. 283.

(*x*) *Flower* v. *Lloyd*, 45 L. J. (N.S.) 746.

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to the words objected to being struck out (*y*). It has since been expressly held that to satisfy an order in the form settled in *Flower* v. *Lloyd* the defendant must give the names and addresses of prior users (*z*). And a plaintiff may, on making out a proper case, administer interrogatories to a defendant who has delivered particulars of objections complying literally with the form of order as settled by *Flower* v. *Lloyd*, asking for the names and addresses of the alleged prior users, and whether the machines were in existence (*a*).

And again, where a defendant relied on an objection that a prior American patent had been surrendered, and that the invention had been published in certain journals of specified dates, and in sketches and drawings deposited at a specified time in the Patent Office library, it was held the defendant must state the date of the American patent, the name of the patentee, and the date of the alleged surrender, and specify also the pages but not the lines of the journals referred to, and that the drawings must be identified in writing, whether contained in books or not, the rest of the order to be in the terms of the above-cited case of *Flower* v. *Lloyd* (*b*).

Where names and addresses of prior users are given, the address must be the present residence of the alleged prior users (*c*).

Objections to be precise.

It has always been held that the objections must be precise and definite, and not in too general terms. Thus, it was not sufficient to say that "if any part of the invention were new, the same was useless," or that "the improvements or some of them had been used long before" (*d*). And where the prior user was alleged to be by persons named and "*divers other persons*" (*e*), or at Nottingham "*and elsewhere* (*f*)," or "*by other persons* in London and Birmingham (*g*)," the general words were in each case ordered to be struck out. So, also, a defendant has been compelled to state whether he objected to the whole of the alleged invention as being old, or whether the objection applied only to a particular part (*h*).

And an allegation of prior user by the exhibition in use *of articles made according to the supposed invention*, was held too vague in an action

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(*y*) 20 Sol. J. 860; Higgins. 311.

(*z*) *Birch* v. *Mather*, 22 Ch. D. 629.

(*a*) *Ibid.*

(*b*) *Plimpton* v. *Spiller*, 20 Sol. J. 860.

(*c*) *Palmer* v. *Cooper*, 9 Ex. 236.

(*d*) *Fisher* v. *Dewick*, 1 Webst. P. C. 264; *Heath* v. *Unwin*, 1 Webst. P. C. 552, n.; *Russell* v. *Ledsam*, 11 M. & W. 647.

(*e*) *Galloway* v. *Bleaden*, 2 Chit. Arch. Prac. 1031, cited 1 Webst. 268, n.; *Fisher* v. *Dewick*, 1 Webst. P. C. 551, n.

(*f*) *Jones* v. *Berger*, 1 Webst. P. C. 544; *Holland* v. *Fox*, 1 C. L. Rep. 440.

(*g*) *Flower* v. *Lloyd*, 29 Sol. J. 860.

(*h*) *Fisher* v. *Dewick*, 1 Webst. P. C. 264; *Russell* v. *Ledsam*, 11 M. & W. 647.

for infringement of a complicated patent for improvements in machinery for winding, doubling, and twisting thread, and the defendants were ordered to give such a statement as would show which particular machines were alleged as anticipations (*i*). So, also, an allegation of prior user *of the said invention or material parts thereof*, without saying what material parts, and an allegation which gave only the name and place and date of the user, but did not give the machine said to be used, were held insufficient (*k*).

And where the defendants delivered long and elaborate objections alleging several persons as having anticipated the plaintiff's patent by the mode in which they used certain contrivances, but not saying that these persons in every case did it in the same way, nor showing the particular mode adopted by each person, further particulars were ordered (*m*).

But when the patent was for improvements in machinery for spinning and doubling cotton, and the objections stated that the defendants relied on the use by certain named firms of spindles and bobbins made according to the alleged invention, this was held sufficient (*n*).

It would seem, however, from the case of *Penn* v. *Bibby* (*o*), that general words may sometimes be allowed in order to give the defendant the benefit of a general saving, and liberty to apply for leave to give particulars of prior user, if and when he may find them. In this case Lord HATHERLEY, then Sir W. P. WOOD, V.-C., refused to strike out from an objection alleging certain cases of prior user the words "*among other instances*;" and in the previous case of *Curtis* v. *Platt* (*p*), the same learned judge allowed the words "*amongst others*" to remain in an objection that the invention had been previously used by certain named persons. In this latter case, however, on the plaintiff objecting that if the words above mentioned were allowed to remain the defendant could go into any number of cases of which the plaintiff could have no notice, his Lordship observed that if anything of that sort were attempted at the trial the court would know how to protect the plaintiff from surprise. This view appears to be at variance with the practice at common law (*q*). *Curtis* v. *Platt*, however, was not a case before a jury, and this fact appears to have influenced the decision.

When the user relied on is a general user it may be stated in general terms. Thus, it was held a sufficient allegation of such user to say that

General user.

(*i*) *Boyd* v. *Farrar*, 5 R. P. C. 33.

(*k*) *Law* v. *Ashworth*, 7 R. P. C. 86.

(*m*) *Scott* v. *Hull Steam Fishing Co.*, 13 R. P. C. 206.

(*n*) *Sidebottom* v. *Fielden*, 8 R. P. C. 266.

(*o*) L. R. 1 Eq. 549.

(*p*) 8 L. T. (N.S.) 657.

(*q*) *Hull* v. *Bollard*, 1 H. & N. 134. See, however, *Carpenter* v. *Walker*, 1 Webst. 268 n.

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the invention was used "*by candle-makers generally in London and the vicinity thereof*" (*r*). In such a case the plaintiff is not harmed, because to prove a general user proof by one person would not be enough, and "the plaintiff has no reason to complain of generality of statement, for the more general it is the more the defendant must prove under it" (*s*).

So, also, where the objection points to the general use of a particular preparation by a limited class. Thus, where the patent was for making starch, an objection that the invention had been used by persons engaged in the manufacture of lace "at Nottingham" was held sufficient (*t*).

But even an allegation of general user must not be too wide. Thus, where the patent was for improvements in the construction of carriages, objections alleging user by "*carriage builders generally throughout Great Britain*," and user by "*various carriage-builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain*" were held insufficient (*u*).

And allegations of anticipation by *the general use of regenerative gas lamps*, and by the *general use* of the *W.* regenerative gas lamp, the particular kind of *W* lamp not being specified, were held insufficient (*x*).

When the defendants relied on an objection of general user, and had in answer to interrogatories described a particular arrangement as supporting that objection, and at the trial offered evidence of another method in support of the same objection, the case was ordered to stand over at the plaintiff's risk as to costs, but with liberty to the defendants to give particulars of further instances (*y*).

When the defendant desired to amend his objections by adding an objection that the alleged invention did not substantially differ from the contrivances in common use prior to the patent, he was allowed to amend, but was required to particularize the contrivances, and the place and time when and where they were used or known (*z*).

The best test of the sufficiency or insufficiency of objections will probably be found in the words of PARKE, B., in *Palmer* v. *Cooper* (*a*): "The defendant's particulars ought to give the plaintiff such information

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(*r*) *Palmer* v. *Wagstaff*, 8 Ex. 841.

(*s*) *Per* ALDERSON, B., *Palmer* v. *Wagstaff*, 8 Ex. 841. See also observations of ERSKINE, J., *Jones* v. *Berger*, 1 Webst. P. C. 547; *Bentley* v. *Keighley*, 7 M. & G. 552; 8 Scott (N.R.) 372.

(*t*) *Jones* v. *Berger*, 1 Webst. P. C. 549. See also *Palmer* v. *Cooper*, 9 Ex. 231.

(*u*) *Morgan* v. *Fuller* (2), L. R. 2 Eq. 297. And see *post*, p. 505.

(*x*) *Siemens* v. *Karo*, 8 R. P. C. 376.

(*y*) *Pascall* v. *Toope* (2), 8 R. P. C. 1.

(*z*) *Darrah* v. *Purser*, 6 R. P. C. 365.

(*a*) 9 Ex. 236.

as will enable him to make the necessary inquiries at the places named."

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An objection that the invention is not new is sufficient to enable a defendant to contend at the trial that one of two inventions described in the specification is not new (*b*).

Where two defendants were sued as being jointly liable, it was held, under the Act of 1852, that it was not necessary that particulars of objections should be delivered by both defendants, even though they defend separately, and that both might set up at the trial all the objections in the particulars (*c*); and the present Act seems to make no alteration in this respect.

An action against manufacturers and users in which no defence is delivered by the users cannot be set down against the latter alone for judgment in default of pleading (*d*).

Objections not in place of pleas.

It has been held that notices of objection cannot go beyond the pleas, and that such objections do not stand in the place of pleas (*e*); and where a defendant had only pleaded the general issue and want of novelty of the invention, and that the plaintiffs were not first and true inventors, he was not allowed to contend that the patent was illegal, although he had given notice of an objection to that effect (*f*).

And this is the form of pleading adopted in the schedule to the Rules of 1883, Appendix D., Sect. VI. But it has of late been usual to find in the defence no other plea as to the validity of the patent than a simple denial of validity of the patent "on the grounds stated in the particulars of objections delivered herewith," and this mode of pleading appears to be sufficient (*g*).

It has been usual in the common form of particulars of objections which has been in use for many years to preface the objections with the words "*the defendant besides denying that he has infringed the letters patent* relies on the following objections," etc. The use of the words in italics has been disapproved of (*h*).

"**Time and place.**"—It will be noticed that these words differ from the words of the corresponding section of the Act of 1852, which required the *place* and *manner* of prior publication or user to be stated.

(*b*) *Sugg* v. *Silber*, 2 Q. B. D. 493.

(*c*) *Smith* v. *Cropper*, 10 App. Cas. 249.

(*d*) *Actien Gesellschaft für Cartonnagen Industrie* v. *Remus*, 12 R. P. C. 94.

(*e*) *Macnamara* v. *Hulse*, 2 Webst. P. C. 128, n.; *Jones* v. *Berger*, 1 Webst. P. C. 544. See also *Chollet* v. *Hoffman*, 7 E. & B. 686.

(*f*) *Gillett* v. *Wilby*, 1 Webst. P. C. 270.

(*g*) See order of C. A. in *Kurtz* v. *Spence*, 36 Ch. D. 776.

(*h*) *Phillips* v. *Ivel Cycle Co.* 7 R. P. C. 77, 85.

Sect. 29 (2. 3) But under the present Act it has been held that a defendant desiring to raise the objection of want of novelty must state reasonably on what grounds in respect of want of novelty he disputes the patent, and must also state the time and place of the previous publication or user alleged by him (*i*).

NOTE

And pages and lines must be given, as under the old practice, when prior specifications (*k*), or printed books (*l*), are relied on. It appears, therefore, that the information necessary to satisfy the present Act is, in substance, the same as what was required under the Act of 1852.

Under the Act of 1852, it was held that, so far as regards date of user and place of user, defendants were bound to give the plaintiffs all the information they themselves had (*m*).

Where the defendants referred to certain machines as having been made or used at named places by named persons in particular years, and alleged these machines as anticipations of particular claims in the specification, the objections were held sufficient, notwithstanding allegations by the plaintiff that the present owner of some of the machines refused to allow inspection thereof, and that of others the defendants could not say whether they were still in existence (*n*).

When the objection was that the invention was published by the user by a named person "from 1832 to 1862," it was held that further particulars must be given, but that the defendants were not under the particulars to be tied to continuous user during that period (*o*).

Further and better particulars.

If the particulars delivered are insufficient, further and better particulars can be required (*p*). Where they are too general, it is the business of the parties who mean to object to them to procure an order for better particulars (*q*); and this is important, otherwise evidence within the literal meaning of the particulars may be admitted, although the particulars are, in fact, too general (*r*). There is a very large difference between a case where a judge has been applied to and has ordered further particulars, in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from "availing himself of an objection. If, wherever the court could order further particulars because the

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(*i*) *Fowler* v. *Gaul*, 3 R. P. C. 247, 250; *Boyd* v. *Horrocks*, 3 R. P. C. 287.

(*k*) *Fowler* v. *Gaul*, *ubi supra*; *Heathfield* v. *Greenway*, 11 R. P. C. 17.

(*l*) *Harris* v. *Rothwell*, 3 R. P. C. 243.

(*m*) *Curtis* v. *Platt*, 8 L. T. (N.S.) 657.

(*n*) *Boyd* v. *Horrocks*, 5 R. P. C. 561.

(*o*) *Smith* v. *Lang*, 7 R. P. C. 148.

(*p*) S. C. R. 1883, Order XIX., r. 7.

(*q*) *Per* POLLOCK, C. B., *Hall* v. *Ballard*, 1 H. & N. 134.

(*r*) See notes under sub-s. 4, *post*.

objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a judge for further particulars" (*s*). Sect. 29 (2, 3) NOTE.

Where in an action by a vendor for specific performance of a contract for the sale of patents the defendant alleged that by the contract he was only to pay if he satisfied himself that the patents were valid, and that he had satisfied himself of their invalidity, he was ordered to give particulars of objections to the validity of the patents (*t*).

In a threats action, where the plaintiff had delivered insufficient particulars of objections alleging a prior user thirty years ago, and the person alleged to have used the invention had in an affidavit in another action by the defendants exhibited certain specimens of articles made by him, the court ordered that the plaintiff should before putting in further particulars have a month to see the specimens, and required the defendants to undertake to give such consent as would be necessary for the plaintiff to have such access (*u*).

The application for further and better particulars should be made by summons at chambers (*x*). If the particulars delivered are insufficient, the party delivering them may be ordered to pay the costs of the application for better particulars (*y*).

If a defendant does not comply with an order for better particulars of objections, it would seem that the proper course is to apply that the insufficiently-stated objection may be struck out (*z*).

By r. 8 of the S. C. R. 1883, Order XIX., an order for particulars does not, except as mentioned in the rule, operate as a stay of proceedings or give any extension of time. Nor is the fact that the plaintiff has obtained an order for further and better particulars of objections any ground for giving him further time to reply (*a*).

Under an order to give further and better particulars of objections new instances of anticipation cannot be added without leave (*b*).

"**Previous publication or user.**" — The law as to previous publication has been thus stated by Lord BLACKBURN (*c*) :— Previous publication.

"The consideration for a patent is the communication to the public of a process that is new. In Hindmarch on Patents (*d*), it is laid down

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(*s*) *Per* MELLISH, L.J., *Sugg* v. *Silber*, 2 Q. B. D. 495.

(*t*) *Hazlehurst* v. *Rylands*, 9 R. P. C. 1.

(*u*) *Smith* v. *Lang*, 7 R. P. C. 148.

(*x*) See S. C. R. May, 1897, Order XXX. r. 1 (*a*) (*c*).

(*y*) *Grover and Baker Sewing Machine Co.* v. *Wilson*, W. N. 1870, p. 78; *Penn* v. *Bibby*, L. R. 1 Eq. 548.

(*z*) *Flower* v. *Lloyd*, 20 S. J. 860; Higgins, 311.

(*a*) *Boyd* v. *Farrar*, 5 R. P. C. 33, 36.

(*b*) *Aktiebolaget Separator* v. *Dairy Outfit Co.* 13 R. P. C. 725.

(*c*) *Patterson* v. *Gas Light and Coke Co.*, 3 App. Cas. 244.

(*d*) P. 33.

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that 'If the public once becomes possessed of an invention by any means whatever, no subsequent patent for it can be granted, either to the true or first inventor himself, or any other person; for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give.' This is, in my opinion, a correct statement of the law. It is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used has been made known to the public by a description in a work which has been publicly circulated (*Stead* v. *Williams* (*e*)), or in a specification duly enrolled (*Bush* v. *Fox* (*f*); *Betts* v. *Menzies* (*g*)), it avoids the patent, though it is not shown that it ever was actually put into use." So, also, if the invention has been published in a provisional specification (*h*).

The question to be asked in cases of alleged prior publication is, "Is it the fair conclusion from the evidence that some English people, under no obligation of secrecy (*i*) arising from confidence or good faith towards the patentee, knew of the invention at the date when the plaintiff took out his patent?" (*k*).

Previous publication in books.

In order to show that a patentee is not the true and first inventor of his patented invention, it is not necessary to show that he learnt it from a prior publication existing in this country. It is sufficient to show that the invention was so described, in some book or document in this country, as that some English people may be fairly supposed to have known of it (*l*). Thus, where the invention has been made public in England by a description contained in a work, whether written or printed, which has been published in England (*m*), or where a few copies of a foreign book containing an account of the same invention have been actually sold in England (*n*), this will invalidate a subsequent patent.

Publication in England in foreign books.

In the case of a book published in England, no evidence is necessary to show that the book was in fact read or referred to (*o*). But if the

(*e*) 7 M. & G. 818, 842; 2 Webst. 141.

(*f*) 5 H. L. C. 707.

(*g*) 10 H. L. C. 117.

(*h*) *Stoner* v. *Todd*, 4 Ch. D. 58; *Lawrence* v. *Perry*, 2 R. P. C. 179, 187.

(*i*) See *post*, p. 190.

(*k*) *Per* FRY, L.J., *Humpherson* v. *Syer*, 4 R. P. C. 407, 414; *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516.

(*l*) *Per* COTTON and LINDLEY, L.JJ., *Harris* v. *Rothwell*, 35 Ch. D. 429.

(*m*) *Household Co.* v. *Neilson*, 1 Webst. 673, 718, n.; *Heurteloup's Patent*, 1 Webst. 553; *Harris* v. *Rothwell*, 35 Ch. D. 416, 428.

(*n*) *Lang* v. *Gisborne*, 31 Beav. 133.

(*o*) *Harris* v. *Rothwell*, 35 Ch. D. 416, 428.

book relied on be a foreign work, it must be shown that it has been published in this country in such a way as to become part of the public stock of knowledge in this country (*p*). And, therefore, where the only publication proved is that a foreign book containing the alleged antecedent description has been deposited in a public library in this country, but is not there in such a position as to be accessible to the public; as, for instance, where an American book which was sent to the Patent Office Library was not entered in the donation book or in a catalogue, but was put into a private room (*q*), or on a shelf in a public corridor, or in a room where other American books were kept, not the principal room in the library (*r*), there is no sufficient publication (*s*). But in *Harris* v. *Rothwell* (*t*), where two foreign specifications alleged to anticipate the plaintiff's invention were in the Patent Office Library in their proper places there, and translations of their titles had been published among a list of German patents in the Commissioners of Patents Journal, this was held sufficient *primâ facie* evidence of publication, although it was not shown whether in fact anyone other than the librarian had seen them. And in this case it was held by LOPES, L.J., that the mere fact of the existence of the specifications in the library of the Patent Office, where they were unreservedly accessible to every one, was in itself conclusive evidence of a prior publication (*u*).

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NOTE.

And in *Pickard* v. *Prescott* (*x*), where the patent being dated July 24th, it was proved that an article describing a construction identical with that in the alleged invention was published in a French periodical for June in the same year, and that copies of the periodical were sold by a firm of booksellers having houses in London and Edinburgh to persons residing in England and Scotland shortly before July 24th, and one of these copies was stated in the seller's periodical-book to have been delivered on July 10th, though the recipient could not say when he first read the article in question, it was held that prior publication was established, and the patent was invalidated.

From the case of *Heurtéloup's Patent* (*y*), and some observations of JESSEL, M.R., in *Plimpton* v. *Malcolmson* (*z*), it would appear that if a foreign book has been in the British Museum a sufficient time to have been entered in the catalogue, the presumption is that it was read.

(*p*) See PEARSON, J., *Otto* v. *Steel*, 31 Ch. D. 243.

(*q*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531.

(*r*) *Plimpton* v. *Spiller*, 6 Ch. D. 412.

(*s*) See also *Harris* v. *Rothwell*, 35 Ch. D. 416, 431, *per* COTTON and LINDLEY, L.JJ.

(*t*) 35 Ch. D. 416.

(*u*) 35 Ch. D. 431.

(*x*) 7 R. P. C. 361; affirmed in H. L., [1892] A. C. 263; 9 R. P. C. 195.

(*y*) 1 Webst. 553.

(*z*) 3 Ch. D. 560.

Sect. 29 (2, 3) NOTE.

But in *Otto* v. *Steel* (*a*), PEARSON, J., refused to make that presumption, and declined to receive in evidence a book which, though in the British Museum, was not in the reading room, and could only be obtained by some person knowing of the book and asking for it, or by some person who, wishing to see works on a particular subject, had been taken to the section of the library where those works were to be found, and allowed to make his own selection, and which, though in the catalogue, was only catalogued under the name of the author (*b*).

And although, as a general rule, when it is said that a book is published in England it is assumed that it is publicly circulated, it may be that in fact it never was sold or circulated, or became part of the public knowledge, and if this were shown, the mere circumstance that it was published in the technical sense would not make its contents a publication which would vitiate a patent (*c*).

In *Lang* v. *Gisborne* (*d*), it was said by Lord ROMILLY, M.R., that as soon as an inventor informs the public of what his invention consists, and prints it in a book, which he sends to a publisher to sell, from the moment the book is exposed for sale in the bookseller's shop there becomes, in point of law, a complete publication of the invention. These observations are not, however, to be taken in a strict literal sense, but only in the sense that if a man publishes a book, that is, a large number of copies, and sends them to a bookseller for sale, and they are for a reasonable time exposed in the window, then if the other side cannot prove that one has not been sold, it may be reasonably inferred that some have been sold (*e*).

The mere fact that a French book was catalogued under the name of the author in a French catalogue, and under a general heading in another French catalogue, and that large numbers of those catalogues were disposed of to libraries and various persons in this country, was held to be no proof of publication in the absence of evidence that there was any copy of the book in this country except one in the British Museum catalogued only under the author's name (*f*).

But where it was shown that the book in question was actually consulted by one person in this country, that was held sufficient, even though only two copies were shown to be in the country, and of these one was irregularly catalogued in the library to which it belonged (*g*).

(*a*) 31 Ch. D. 241, 245.

(*b*) See also observations of JAMES, L.J., *Plimpton* v. *Spiller*, 6 Ch. D. 429.

(*c*) See *per* JESSEL, M.R., *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 559; and *per* BRETT, L.J., *Plimpton* v. *Spiller*, 6 Ch. D. 435; *Harris* v. *Rothwell*, 35 Ch. D. 416, 428.

(*d*) 31 Beav. 135.

(*e*) *Per* JESSEL, M. R., *Plimpton* v. *Malcolmson*, 3 Ch. D. 562.

(*f*) *Otto* v. *Steel*, 31 Ch. D. 241, 244.

(*g*) *United Telephone Co.* v. *Harrison*, 21 Ch. D. 721, 731.

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NOTE.

A foreign book not known in England will not invalidate a patent (*h*). But if the book be known in England it makes no difference whether it is English or in a foreign language (*i*), if the latter is not one of those remote languages with which very few people in England would be acquainted (*k*).

This proposition is assumed in the cases of *United Telephone Co.* v. *Harrison*, and *Otto* v. *Steel*, cited above, and was expressly laid down by CHITTY, J., and afterwards by the Court of Appeal, in *Harris* v. *Rothwell* (*l*), where it was held that two German specifications in the Patent Office Library were sufficient publication of the invention to avoid the patent.

Publication in an English specification.

If the anticipation relied on is a prior English specification filed in the Patent Office, no proof is required of other publication of it, or of its even having been actually seen by the public (*m*). This arises from the fact that the second of two patents must be bad in law (*n*).

Anticipation by specification or books.

The leading case on anticipation by prior specifications or printed books is *Hill* v. *Evans*, where the rule is thus stated by Lord WESTBURY, C. (*o*): "The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent." And again, "the information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication."

And in *Ehrlich* v. *Ihlee* (*p*) it was held that the prior description must be of such a character as to enable anyone, competent to make the machine

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(*h*) *Per* Lord BROUGHAM in *Household Co.* v. *Neilson*, 1 Webst. 718, n.; *per* Lord CAMPBELL, *Soames' Patent*, 1 Webst. 733.

(*i*) *Lang* v. *Gisborne*, 31 Beav. 133.

(*k*) *Per* CHITTY, J., *Harris* v. *Rothwell*, 35 Ch. D. 426.

(*l*) 35 Ch. D. 416.

(*m*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 557; *Harris* v. *Rothwell*, 35 Ch. D. 416, 428.

(*n*) See *per* COTTON and LINDLEY, L.JJ., in *Harris* v. *Rothwell*, *ubi supra*.

(*o*) 4 D. F. & J. 300, 301. See also *Neilson* v. *Betts*, L. R. 5 H. L. 1, 15, 24; *Von Heyden* v. *Neustadt*, 50 L. J. Ch. 126; *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 567, 568.

(*p*) 5 R. P. C. 437, 450, judgment of COTTON, L. J.

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for which protection is claimed by the patentee, to make it from the description given.

Note.

The rule as to anticipation in writing has also been stated as follows :—

"It is not sufficient to say that if a machine were made by a person who had read that writing, something in that machine would, if it had been really a machine used, have been by reason of that user an anticipation of the plaintiff's patent. You must go further where you allege that the anticipation is in writing, and in writing only, and you must show that a person conversant with such matters, reading that writing, would find in the writing alone a reasonably clear description of the plaintiff's invention. If it requires that a machine should be made in order that the anticipation may be seen, the subsequent inventor is not obliged, when his attention is called to a mere writing, to make a machine from it, in order to see what will be the effect of that machine. He has to find a description of his own invention on the face of that writing, construing that writing reasonably as describing an invention" (*q*).

Distinction between sufficiency of specification and prior publication.

Upon this question it has been said, by Grove, J., "there is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there is a distinction, but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication which, when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it perhaps to those in the trade who are most skilled—the higher class of skilled workmen) would enable them to understand it" (*r*).

Insufficient specification may be a prior publication.

And in *Anglo-American Brush Co.* v. *King, Brown & Co.* (*s*), it was said by Lord Watson that the sufficiency or insufficiency of the previous specification for the guidance of a skilled workman "does not afford a crucial test of prior publication. Every patentee as a condition of his exclusive privilege is bound to describe his invention in such detail as to enable a workman of ordinary skill to practise it, and the penalty

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(*q*) *Otto* v. *Linford*, 46 L. T. (N.S.) 39, 44, judgment of Brett, L.J. See also *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 532; *Shrewsbury and Talbot Cab Co.* v. *Stretton*, 13 R. P. C. 44, 52; *Thomson* v. *Batty*, 6 R. P. C. 84, 99.

(*r*) *Philpott* v. *Hanbury*, 2 R. P. C. 43.

(*s*) [1892] A. C. 367, 378.

of non-compliance with that condition is forfeiture of his privilege. His patent-right may be invalid by reason of non-compliance, but it certainly does not follow that his invention has not been published. His specification may, notwithstanding that defect, be sufficient to convey to men of science and employers of labour information which will enable them *without any exercise of inventive ingenuity to understand* his invention and to give a workman the specific directions which he failed to communicate. In that case I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill" (*t*).

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NOTE.

But it must not be assumed necessarily that information which is given in an unworkable patent, because in terms it is sufficiently described, is that kind of information which gives the world new knowledge (*u*).

In estimating the significance of a prior specification brought forward as an anticipation, it is necessary to consider what amount of information with respect to the subject of the specification is to be attributed to persons who had an opportunity of reading it when it was first published, and a previous specification on the same subject may be assumed to be within the knowledge of such persons. Thus, when in an action for infringement of a patent of 1878 for a series-shunt-wound dynamo electric machine a specification of Varley of 1876 was alleged as a prior publication, and there was no doubt that a reader acquainted only with series-winding would not attach the same meaning to the words as would naturally occur to one who was also familiar with the shunt, or with the shunt and series-shunt systems of winding, it was held that the reader of Varley's specification in 1876 must be assumed to be acquainted with a previous specification of Clark of 1875 which was for a shunt-wound machine, and this, notwithstanding eminent electricians deposed that they did not know of Clark's machine until after the date of plaintiff's patent (*x*).

A picture of a machine published in a book without description might be sufficient to avoid a subsequent patent (*y*). And it would seem that a worthless and abandoned patent may be an anticipation (*z*).

But "you must not give people mechanical problems and call them specifications" (*a*). Thus in the well-known roller skate case, where the

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(*t*) See also *Betts* v. *Neilson*, L. R. 3 Ch. 429, 432.

(*u*) *Per* BOWEN, L.J., *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 113, 125.

(*x*) *Anglo-American Brush Electric Light Co.* v. *King, Brown & Co.*, [1892] A. C. 367, 376, 377.

(*y*) *Herrburger* v. *Squire*, 6 R. P. C. 194.

(*z*) *Kaye* v. *Chubb*, 5 R. P. C. 641.

(*a*) *Per* JESSEL, M.R., *Plimpton* v. *Malcolmson*, 3 Ch. D. 576.

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only knowledge in England at the date of the patent was derived from a copy of an American journal containing a drawing of the skate with a copy of the claims of the American patent and a note by the editor very briefly describing the invention, and the expert witnesses differed as to the meaning of the letterpress and drawing, it was held that this was not sufficient publication to avoid the patent (*b*).

And where a specification for obtaining dyes from rhodamines described as the initial step the production of a potassium salt of rhodamine which was subsequently treated in a particular way, and it appeared that the potassium salt was non-existent, and chemically impossible, it was held that this was no anticipation of a subsequent patent which started from the unconverted rhodamine base, and was founded on a new discovery that rhodamine was itself capable of behaving as an acid, although the actual steps of the treatment of the rhodamine base were very similar to the treatment of the so-called potassium salt in the earlier specification (*c*).

The existence of a chemical patent wherein the combined effect of two or more chemicals is claimed in order to bring about a desired result does not constitute an anticipation of a subsequent discovery that by the use of any one of the named chemicals the desired result can be attained (*d*).

Distinction between technical and scientific literature as to anticipation.

With reference to prior publication alleged to anticipate a patent for a chemical invention, it is to be remembered that there are two distinct forms of literature on the subject: the systematic scientific literature and the technical literature; and the distinction is one very important to be borne in mind in dealing with such patents, since publications having reference to chemical science will be studied by scientific chemists, but, speaking generally, such publications are not sought after and studied by the practical working chemist (*e*).

And when it requires a "mosaic of extracts" from annals and treatises, spread over a series of years, to prove the want of novelty, the contention stands thereby self-condemned (*f*).

Prior user

But the public may have become possessed of the invention through its having been in use before the patent.

(*b*) *Plimpton* v. *Malcolmson*, *ubi supra*. See also *Lewis & Stirckler's Patent*, 14 R. P. C. 24.

(*c*) *Badische Anilin und Soda Fabrik* v. *La Société Chimique des Usines du Rhône*, 14 R. P. C. 875.

(*d*) *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, 256.

(*e*) See *per* BAGGALLAY, L.J., *Badische Anilin und Soda Fabrik* v. *Lerinstein*, 29 Ch. D. 384.

(*f*) *Per* JAMES, L. J., *Von Heyden* v. *Neustadt*, 50 L. J. Ch. 126. See also *Young* v. *Fernie*, 4 Giff. 577.

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There is a considerable difference between publication by prior user and publication in a book or specification. In the latter case, as we have seen, the invention must be so published as to become part of the public knowledge. But when it is said that a process has been disclosed or an invention has been disclosed by means of user, it is not necessary that such user should be a user by the public proper, provided only there is a user in public (*g*).

NOTE. Difference between anticipation by prior user and by specification.

It is doubtful whether the production of a machine made for a particular purpose, and which would accomplish when used results not thought of when it was made, would without any user be an anticipation; but "it is clear that the machine if used so that the public could ascertain what it would effect, would be an anticipation. But *that is quite different from producing as an anticipation a specification*, for you cannot tell, except from the language of the specification, what results the contemplated machine may accomplish" (*h*).

Public use.

The rule as to public use is thus stated by GROVE, J.:—"If the invention was in public use before, even by one person, the patent is bad. Mere private use in the closet, mere experimental working in a laboratory without publishing the invention, but keeping it a secret, with a view possibly of a patent being taken out, would not invalidate it. But if it is once publicly used or sold in a shop, or publicly used in a carriage, or on the person, or in any such way, then the public have a right to it, and the patent is bad" (*i*). By the publication of an invention is meant an addition to the stock of knowledge which the public either has or can acquire by consulting some source of information open to it. The word "publication" has not the same meaning when used with reference to patents as it has when used with reference to libels or slanders (*k*).

Meaning of "publication."

Private use or experiments.

Therefore, a mere private use, as the use in an observatory of certain object glasses for telescopes, there being no publication of the mode of construction or use (*l*); or mere experiments never communicated to the world, and laid by as forgotten things (*m*), will not avoid a subsequent patent.

(*g*) *Per* POLLOCK, B., *Croysdale* v. *Fisher*, 1 R. P. C. 14, 21; *per* ALDERSON, B., and Lord ABINGER, C. B *Carpenter* v. *Smith*, 1 Webst. 543.

(*h*) See *per* HOLKER, L.J., *Otto* v. *Linford*, 46 L. T. (N.S.) 39, 46.

(*i*) *Young* v. *Rosenthal*, 1 R. P. C. 29, 32.

(*k*) *Per* LINDLEY, L.J., *Gadd* v. *Mayor, etc. of Manchester*, 9 R. P. C. 517, 527. See also *Sunlight Incandescent Co.* v. *Incandescent Gas Light Co.*, 14 R. P. C. 757, 774.

(*l*) *Dollond* v. ——, 1 Carpmael, P. C. 28; 1 Webst. 43.

(*m*) *Cornish* v. *Keene*, 1 Webst. 508; *Galloway* v. *Bleaden*, 1 Webst. 529; *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241; *Humpherson* v. *Syer*, 4 R. P. C. 184, 188; *Mathews* v. *Parmenter*, 13 R. P. C. 514.

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NOTE.

And when a person communicated an invention (which another subsequently invented independently and patented) confidentially to third parties, who knew that he did not intend to publish it, and who did not themselves publish it; it was held that there was no publication which would avoid the subsequent patent (*n*).

And the use for a year in a cart on a public road of a peculiar construction of wheel, which was afterwards abandoned on account of defects (*o*), and the use in a workyard of a new form of pulley, which was afterwards thrown aside (*p*), and the use of a certain form of wood pavement as a carriageway (*q*), and the construction of a model of tramway crossings which was left for some time in the sheds of a tramway company, and was afterwards seen by persons to whom the designer of the model showed it in his private room, but of which no practical use had ever been made, and which was ultimately laid aside (*r*), were all held to be no bar to the validity of patents obtained by other inventors for the same or very similar articles, in which the old defects were for the first time remedied.

So, also, where a previous inventor had, before taking out a patent for purifying coal gas, used in large quantities oxides of iron, and had used oxides which were actually hydrated, but had not known that hydrated oxides produced the best results, and had, in fact, desired to render his oxides anhydrous, and the jury found that this user was by way of experiment; it was held that a subsequent patent granted to another person for the use of hydrated oxides for the like purpose was good (*s*).

The abandonment of an invention is a very strong presumption that it was only an experiment, not an invention completed (*t*).

Secret use of invention

Where there has been no more than a secret use of the invention by the inventor with a view to taking out a patent (*u*), or the manufacture for the inventor, and under injunctions as to secrecy, by a manufacturer (*x*), or by the inventor's own workmen (*y*), the patent will be good. But this will not be the case where the invention was

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(*n*) *Gadd* v. *Mayor, etc., of Manchester*, 9 R. P. C. 249, 517.

(*o*) *Jones* v. *Pearce*, 1 Webst. 124.

(*p*) *Tangye* v. *Stott*, W. N. 1866, p. 68.

(*q*) *Stead* v. *Williams*, 2 Webst. 135.

(*r*) *Winby* v. *Manchester, etc., Tramways Co.*, 6 R. P. C. 359.

(*s*) *Hills* v. *London Gaslight Co.*, 5 H. & N. 312. See also *Otto* v. *Linford*, 46 L. T. (N.S.) 39.

(*t*) See *per* Lord BROUGHAM, *Household Co.* v. *Neilson*, 1 Webst. 713; *Morgan* v. *Windover*, 5 R. P. C. 295, 303.

(*u*) *Smith* v. *Davidson*, 19 C. B. 690. See also *Bentley* v. *Fleming*, 1 Car. & K. 587.

(*x*) *Morgan* v. *Seaward*, 1 Webst. 187; *Useful Patents Co.* v. *Rylands*, 2 R. P. C. 255; *Humpherson* v. *Syer*, 4 R. P. C. 407; *Kurtz* v. *Spence*, 5 R. P. C. 161.

(*y*) *Betts* v. *Menzies*, 1 E. & E. 1008.

communicated to a third person in a manner which, both in law and equity, allowed him to do what he liked with the information (*z*). And the public exhibition of a lifeboat with a collapsible gunwale, where no precautions as to secrecy were taken, and accounts of the exhibition appeared in a newspaper, was held to invalidate a subsequent patent (*a*).

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NOTE.

Where the invention was disclosed to public officers who could not keep it secret without a breach of duty, the disclosure was considered as made to the public, and a subsequent patent was held invalid (*b*).

Disclosure to public officers.

The question may arise whether the public sale of an article which in no way discloses the process employed in its manufacture will of itself invalidate a subsequent patent for the process.

Previous sale of article made by secret process.

Where the sale has been by the person who afterwards becomes the patentee the patent is void, because if the inventor could sell the invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent, he might have practically a monopoly for a much longer period than fourteen years (*c*).

Previous sale by patentee.

Thus, in *Wood* v. *Zimmer* (*d*), where the patent was for a method of making verdigris, it appeared that the patentee had sold the article in the public market four months before the date of the patent, and the patent was held invalid.

So also in *Germ Milling Co.* v. *Robinson* (*e*), where the action was for infringement of a patent for improvements in the manufacture of meal and flour from wheat and other grain, the patentee, in his examination-in-chief, stated that he had made flour according to his process before the date of the patent, and had sold such flour in the ordinary course of his business, and on this evidence the action was dismissed.

If the sale prior to the patent has been by some person other than the subsequent patentee different considerations apply, and there appears to be a difference of judicial opinion as to the effect of such a sale on the validity of the patent.

Previous sale by persons other than patentee.

Thus, in *Hancock* v. *Somervell* (*f*), an action for infringement of a patent for improvements in the preparation of caoutchouc, it was shown by way of anticipation that shoes made of the prepared material had been sold in England previously to the patent, and Sir E. VAUGHAN

(*z*) See *per* BOWEN, L.J., *Humphrson* v. *Syer*, 4 R. P. C. 407, 413.

(*a*) *Lifeboat Co.* v. *Chambers*, 8 R. P. C. 418.

(*b*) *Patterson* v. *Gas Light & Coke Co.*, 3 App. Cas. 239, 245.

(*c*) See *per* PARKE, B., *Morgan* v. *Seaward*, 1 Webst. 187, 194. See also *per* BOWEN, L.J., *Germ Milling Co.* v. *Robinson* (No. 2), 3 R. P. C. 400, 408.

(*d*) 1 Webst. 44.

(*e*) 3 R. P. C. 254, 259, 408.

(*f*) 39 Newton's London Journal, 158, 165, Higgins 236, cited in Johnson's Pat. Man. 40.

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NOTE.

WILLIAMS, J., directed the jury as follows: "If you should come to the conclusion upon the facts that the material was in use before the date of the patent, then the question resolves itself into this,— what is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that, notwithstanding it were so, the invention remained still a matter to be discovered, why then, in my opinion, the plaintiff's case would not be affected by the circumstance of the material being in public use. But if, on the other hand, you should think not only that the material was in public use (and I should here say that I do not think it is necessary the use should be actually for sale,—if it were in public use it need not be sold—it would be sufficient, for instance, if if it were in use, handed about the country for the purpose of attracting customers),—if you should think also that, the material being so in use it was so palpable how you could make it when you got the material, that substantially, the disclosure of the material was a disclosure of the means of making it,—if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have just been describing to you."

In the recent case of *The Sunlight Incandescent Gas Lamp Co.* v. *The Incandescent Gaslight Co.* (*g*), the patent was for a method of treating certain mantles for producing light by incandescence known as the "*Welsbach* mantles" in a particular manner for the purpose of avoiding danger of breakage in handling and packing, and so that the protecting material could be burnt off without injuring the mantle. It appeared that one C., a foreigner, had brought into this country certain mantles performing the same functions as the *Welsbach* mantle, but made of a different material, and strengthened by means substantially the same as the patented process, and with the same object, and had exhibited and burnt his mantles in public before the date of the patent. It was shown, however, that the burning off of the protecting material was done by the exhibitor only when he wanted to change his mantle, not showing people what he was doing, and that all that the public saw was the good result of the incandescence. On these facts it was held that there had been no publication of the plaintiff's process which would invalidate the patent.

On the other hand, in *Heath* v. *Smith* (*h*), which was an invention of a process for making steel, it was shown that previously to the patent the process had been used by five firms, of whom three had used the process openly, and the other two in secret. The patent was held bad on the ground of the previous publication by the three firms, but

(*g*) 14 R. P. C. 757.

(*h*) 2 Webst. 258, 278; 3 E. & B. 256, 273.

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NOTE.

ERLE, J., said he was disposed to go further, and that if one party only had used the process and had brought out the article for profit and kept the method entirely secret he was not prepared to say that then the patent would have been valid. And in the same case Lord CAMPBELL, C.J., added: "If we had held this patent valid, the five firms would all have been liable to an action for exercising the invention after the patent had been taken out. Nothing in the statute gives an exception in such a case. So that if we had held a person entitled to a patent for the discovery of a process openly practised by others for their own profit, but without a public announcement of the method, the action would lie against them; there is no ground for contending that there is anything exempting such parties from liability. Now, see what that comes to. If any man makes a discovery and uses it without taking out a patent, and does not announce it by sound of trumpet, or calling in the public as spectators, he must suspend the use of his discovery if another person subsequently makes the same discovery and takes out a patent for it. That would be the consequence of the principle for which the plaintiff is driven to contend."

In the case of *Cornish* v. *Keene* (*i*), it was said by TINDAL, C.J., that Patent if the defendants had shown that they practised the invention and produced the same result in their factory before the patent was obtained, they could not be prevented by the subsequent patent from going on with that which they had done. The question whether it would be a good test of the validity of a patent to say that a person who had been doing certain things in England could be stopped by the patent, was raised in *The Sunlight Incandescent Gas Lamp Co.* v. *The Incandescent Gaslight Co.* cited above, but was expressly left undecided, as in that case the patent applied only to *Welsbach* mantles, and could not therefore prevent the person who had previously used the process from continuing to apply it to his own mantle.

cannot stop persons from continuing what they had done before.

The experimental use of a machine by the inventor, though more or less a user in public, is not necessarily such a dedication to the public as to defeat subsequent patents for it. Thus the patent was sustained where an inventor lent his machine to a friend, to be used in his mill, in order that he might discover, by testing its utility, whether it was worth while to patent it (*k*). And in *Honiball* v. *Bloomer* (*l*), a case of an anchor, afterwards patented, which was previously used on board ship, it was said by MARTIN, B., that if it had been put on the ship for

Experimental use by inventor.

(*i*) 1 Webst. 501, 511. And see *post*, p. 195.

(*k*) *Bentley* v. *Fleming*, 1 Car. & K. 587; *Mathews* v. *Parmenter*, 13 R. P. C. 514.

(*l*) 2 Webst. 200.

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the purpose of trying whether it would answer, and did not answer, and was returned on that ground, that would not interfere with the patent (*m*).

And the fact that the inventor derives profit from an experiment, which, if made at all, must be made on a large scale, and in the presence of others, does not of itself make the experiment a dedication to the public (*n*).

But if the user in public is not for the simple purpose of testing, but for the purpose of carrying out a contract, the invention cannot afterwards be patented (*o*).

Exhibition of useless machine.

The mere exhibition of a useless machine, which turns out a failure, will not affect the right of a patentee who has made a successful machine, though there may be a degree of similarity between some of the details of the two machines (*p*).

So, also, the mere exhibition to a few persons of a model brought from abroad, no machine having been made from it, and the very persons who had seen the model having afterwards bought and used the patented machines, was not held sufficient public use to invalidate the patent (*q*).

The publication by an inventor that a particular result is desirable is no anticipation of a subsequent patent for obtaining that result (*r*).

It has been doubted whether the mere preparation of a plan submitted to directors of a company, not intended to go beyond the board-room and the office of the engineer and architect consulted by the board, would be an anticipation sufficient to invalidate a subseqent patent (*s*).

What public use avoids patent

If the invention has been publicly used before the patent, the patent is void, even though the user be by one person only (*t*), or be of only one specimen of the patented article, as the use of a lock on a gate (*u*), or the use of one anchor on a particular ship (*x*), or a fire-grate

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(*m*) See also *per* Lord LYNDHURST, L.C., *Household Co.* v. *Neilson*, 1 Webst. 708.

(*n*) *Re Newall and Elliott*, 4 C. B. (N.S.) 269, 293; *Moryan* v. *Seaward*, 1 Webst. 194.

(*o*) *Adamson's Patent*, 6 D.M.&G. 420; 25 L. J. Ch. 456.

(*p*) *Per* JAMES, L.J., *Murray* v. *Clayton*, L. R. 7 Ch. 581; and see *Barlow* v. *Baylis*, Griffin, P. C. 44; *Daw* v. *Eley*, L. R. 3 Eq. 496; *Pneumatic Tyre Co.* v. *East London Rubber Co.*, 14 R. P. C. 77, 103.

(*q*) *Lewis* v. *Marling*, 1 Webst. 493, 497.

(*r*) *Thomson* v. *Batty*, 6 R. P. C. 84.

(*s*) *Tickelpenny* v. *Army & Navy Co-operative Society*, 5 R. P. C. 405, 410.

(*t*) *Per* CRESSWELL, J., *Stead* v. *Williams*, 2 Webst. 136; *Heath* v. *Smith*, 2 Webst. 278.

(*u*) *Carpenter* v. *Smith*, 1 Webst. 530, 534. See, however, observations of STUART, V.-C., on this case. *Young* v. *Fernie*, 4 Giff. 577.

(*x*) *Honiball* v. *Bloomer*, 10 Ex. 538; *Honiball's Patent*, 2 Webst. 201, 209.

in the hall of a house (*y*), or the use by one man on public roads, and for business or pleasure, of a tricycle invented by himself (*z*). In all these cases the prior user was held sufficient to invalidate the patent. Sect. 29 (2, 3) NOTE.

There has been no decision on the question whether if an invention had been formerly used and abandoned many years ago, and the whole thing lost sight of and not known to the public, a new inventor could have a patent. The question was stated, but expressly left undecided in the case of *The Household Co.* v. *Neilson*; it was, however, suggested by Lord BROUGHAM, in that case, that it was like a new discovery (*a*).

Use in a public place need not be proved.

Public use, sufficient to defeat a patent, may be shown without its being necessary to prove use in an actually public place, as in a market place. It is sufficient if it be without concealment, as where the article was openly manufactured (*b*), or exhibited (*c*) in a shop, all the workmen knowing of the method, or when the article (a lifeboat with collapsible gunwale) was publicly exhibited in a shipbuilding yard with no precautions for secrecy, and accounts of the exhibition had appeared in the newspapers (*d*). And this will be the case if the article has been manufactured openly, even though not a single piece has been actually sold (*e*).

A person who has himself practised any process cannot be deprived, by any subsequent patent, from going on with what he has done before (*f*).

And, therefore, where, in an action for infringement of a patent for imitation sealskins, defendants showed that they had themselves made the article openly in their workshop, though only in a small quantity, and by way of a pattern, and though they had, in fact, never made any in pieces till after the plaintiff's patent, it was held that the plaintiff's patent was invalid (*g*).

Prior user in a colony does not invalidate an English patent (*h*).

(*y*) *Re Taylor's Patent*, 13 R. P. C. 482.

(*z*) *Brereton* v. *Richardson*, 1 R. P. C. 177.

(*a*) 1 Webst. 717. See, however, observations of COLERIDGE, C.J., in *Morgan* v. *Windover*, 5 R. P. C. 306.

(*b*) *Heath* v. *Smith*, 2 Webst. 268; *Croysdale* v. *Fisher*, 1 R. P. C. 17; *Lister* v. *Norton*, 3 R. P. C. 199; *Podmore* v. *Wright*, 5 R. P. C. 380; *Westley Richards* v. *Perkes*, 10 R. P. C. 181.

(*c*) *Humpherson* v. *Syer*, 4 R. P. C. 407.

(*d*) *Lifeboat Co.* v. *Chambers*, 8 R. P. C. 418.

(*e*) *Per* Lord CHELMSFORD, C., *Betts* v. *Neilson*, L. R. 3 Ch. 436.

(*f*) *Per* TINDAL, C.J., *Cornish* v. *Keene*, 1 Webst. 511. See also *Heath* v. *Smith*, 2 Webst. 268, 279; 3 E. & B. 273; *Kay* v. *Marshall*, 2 Webst. 82; *Ralston* v. *Smith*, 11 H. L. C. 223.

(*g*) *Lister* v. *Norton*, 3 R. P. C. 199, 210.

(*h*) *Rolls* v. *Isaacs*, 19 Ch. D 268.

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NOTE.

If the invention has been once publicly used, it is not necessary in order to defeat a subsequent patent that the user should be continuous down to the time of the patent (*i*).

Public sale.

The public sale of an article before the date of the patent is evidence of the invention having been used and exercised for the purposes of commerce, and not simply for purpose of experiment (*k*). Therefore, where before the patent even a single specimen of the article is sold (*l*), the patent is void, and it is immaterial whether the articles sold were made abroad or in England (*m*).

And the result will be the same even though the articles are made and sold in this country for export, and at once sent abroad (*n*) ; or the sale is a mere experiment to ascertain if the goods would stand wear, or that buyers would take to the goods (*o*).

Offering for sale.

The exhibition, with a view to obtain orders, of the articles subsequently patented (*p*), or the deposit of the articles in a warehouse for sale (*q*), is sufficient to defeat the patent, even though no actual sale is proved.

Subject-matter—A common objection to the validity of a patent is want of subject-matter. The form which this objection generally takes is that in the patentee's contrivance there is not sufficient "invention" to sustain the patent. "If a patentee would succeed it is necessary for him to show not merely newness, in the sense of doing a thing which has not been done before, but he must show newness in the shape of novelty, by producing a thing which requires some exertion of mind that would properly be called invention" (*r*).

Difference between invention and discovery.

An invention is not the same thing as a discovery. A man who discovers that a known machine can produce effects that no one before him knew could be produced by it may make a great and useful discovery, but if he does no more his discovery is not a patentable

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(*i*) *Household Co.* v. *Neilson*, 1 Webst. 709 ; 9 Cl. & F. 788, correcting an inference which had been drawn from certain expressions in the judgment of PATTESON, J., in *Jones* v. *Pearce*, 1 Webst. 123. See also *Tangye* v. *Stott*, W. N. 1866, p. 68.

(*k*) *Wood* v. *Zimmer*, 1 Webst. 44 ; *Germ Milling Co.* v. *Robinson* (No. 2), 3 R. P. C. 405.

(*l*) *Honiball* v, *Bloomer*, 2 Webst. 199. See also *Germ Milling Co.* v. *Robinson* (No. 2), 3 R. P. C. 399 ; *Hollins* v. *Capper*, 5 R. P. C. 289.

(*m*) *Jensen* v. *Smith*, 2 R. P. C. 249.

(*n*) *Carpenter* v. *Smith*, 1 Webst. 541.

(*o*) *Lister* v. *Norton*, 3 R. P. C. 199, 207.

(*p*) *Ibid.*

(*q*) *Mullins* v. *Hart*, 3 Car. & K. 297.

(*r*) *Per* WILLES, J., *Tatham* v. *Dania*, Griffin, P. C. 213. See also *Blakey* v. *Latham*, 6 R. P. C. 184, 187, and observations of COTTON, L.J., *Williams* v. *Nye*, 7 R. P. C. 62, 67. See also *Pascall* v. *Toope* (2), 8 R. P. C. 1.

invention. He has added nothing but knowledge to what previously existed. A patentee must do something more; he must make some addition not only to knowledge but to previously known inventions, and must so use his knowledge and ingenuity as to produce either a new and useful thing or result, or a new and useful method of producing an old thing or result (*s*). Sect. 29 (2, 3) NOTE.

And in *Lancashire Explosives Co.* v. *The Roburite Explosives Co.* (*t*), RIGBY, L. J. said, "Invention consists in many cases in putting together items of common knowledge which no one else has ever thought of combining."

The question of invention is in each case a question of fact depending on a true view of all the circumstances of the particular case, and cannot be governed by a finding of fact on a totally different invention by another tribunal (*u*).

Patents for new application of old machines to analogous purposes bad.

A leading case on this subject is *Harwood* v. *The Great Northern Rail. Co.* (*x*). In that case, the patent was for what were called fish-joints for connecting the rails of railways. The invention consisted in forming a groove in the sides of each fish, adapted for receiving the heads of the bolts employed for securing such fishes. It was proved that the same contrivance had been used for the purpose of connecting timbers placed vertically upon one another; and it was held that there could not be a patent "for a well-known mechanical contrivance, merely when it was applied in the manner or to a purpose which was not quite the same but is analogous to the manner or purpose in or for which it had been hitherto notoriously used," and that there being no novelty in the application, the patent was held invalid (*y*).

On these grounds, a patent for an improvement in finishing yarns of wool or hair by the action of rotary beaters or burnishers, it being shown that the same method had been previously known for finishing cotton and linen yarns (*z*), was held invalid. So, also, the construction of a caisson for working under water, the same apparatus having been used for working on land, to diminish the influx of water (*a*); or the

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(*s*) *Per* LINDLEY, L.J., *Lane Fox* v. *Kensington, etc. Co.*, [1892] 3 Ch. 424, 428.

(*t*) 12 R. P. C. 471, 482. See also *per* STUART, V.-C., *Young* v. *Fernie*, 4 Giff. at p. 611.

(*u*) *Lyon* v. *Goddard*, 10 R. P. C. 121, 335, 346; 11 R. P. C. 354.

(*x*) 11 H. L. C. 654.

(*y*) See *per* LINDLEY, L.J. *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 524; *Moser* v. *Marsden*, 10 R. P. C. 358; *Lane Fox* v. *Kensington, etc.*, [1892] 3 Ch. 424; *Wood* v *Raphael*, 13 R. P. C. 733; *Leadbeater* v. *Kitchin*, 7 R. P. C. 235. For a careful discussion of all the cases, see judgment of FITZGIBBON, L.J., *Pirrie* v. *York Street, etc. Co.* 11 R. P. C. 447.

(*z*) *Brook* v. *Aston*, 8 E. & B. 478. See also *Losh* v. *Hague*, 1 Webst. 200; *Tatham* v. *Dania*, Griffin, P.C. 213.

(*a*) *Bush* v. *Fox*, 5 H. L. C. 709. See also *Longbottom* v. *Shaw*, 6 R. P. C. 147; *Pow* v. *Taunton*, 9 Jur. (o.s.) 1056.

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construction of iron frames for ships adapted to an external covering of timber planking, the construction of ships with frames partly of iron and partly of wood and with an iron coating on iron frames being previously known (*b*); or the use of a mandril for forming bottle cases of straw, the like use for producing given forms of pliable materials being old (*c*),—were held insufficient subject-matter for patents.

And, where in a carriage certain springs known as C springs, and admitted to be old, had been used fixed to the back of the carriage and to the axle of the back wheel, and these springs were taken by the patentee and used by him in a particular way in the front part of his carriage, it was held, that there was not sufficient invention to sustain the patent (*d*).

And the mode of making embossed metal by pressing it between a suitable punch and a yielding support instead of the ordinary matrix, the use of a yielding substance for the matrix being known for flexible materials (*e*); and the use in oil spray lamps of the steam on the surface of water to neutralize certain back pressure, the use in oil vapour lamps of the vapour of oil on the surface of oil to neutralize a like back pressure being known (*f*), were held not good subject-matter.

Use of known application in same article for new purposes.

The use for a new purpose of a known appliance, applied in a known way to the same article to which it was formerly applied, is not patentable (*g*).

Thus the mere placing on the front of a lock a known mechanism for moving the catch, which mechanism was formerly at the side (*h*), and the use of split ferrules soldered along the split for securing elastic tyres on bicycles, such use being known in various kinds of wire work for joints (*i*), and the application to boiler tubes of a water joint, well known as applied to hot water coils (*k*), and the shaping of the heels of socks by adding widenings to the heels, widening being an old process as applied to other parts of the sock (*l*), were all held to be no subject-matter.

(*b*) *Jordan* v. *Moore*, L. R. 1 C. P. 624. See also *Rowcliffe* v. *Longford Wire, etc. Co.* 4 R. P. C. 281. See also *Ormson* v. *Clarke*, 13 C. B. (N.S.) 337; 14 C. B. (N.S.) 475; *Newsum* v. *Mann*, 7 R. P. C. 307.

(*c*) *Patent Bottle Envelope Co.* v. *Seymer*, 5 C. B. (N.S.) 164. See also *Longbottom* v. *Shaw*, 6 R. P. C. 143; 8 R. P. C. 333; *re Edmonds' Patent*, 6 R. P. C. 355, 357.

(*d*) *Morgan* v. *Windover*, 7 R.P.C. 131 (H. L.).

(*e*) *Embossed Metal Plate Co.* v. *Saupé and Busch*, 8 R. P. C. 355.

(*f*) *Rose's Patents Co.* v. *Braby*, 11 R. P. C. 198.

(*g*) *Elias* v. *Gravesend Tin Plate Co.* 7 R. P. C. 455; *Deutsche Nähmaschinen Fabrik* v. *Pfaff*, 7 R. P. C. 16, 251.

(*h*) *Tucker* v. *Kaye*, 8 R. P. C. 58.

(*i*) *Shaw* v. *Barton*, 12 R. P. C. 282.

(*k*) *Baker* v. *Kinnell*, 9 R. P. C. 441.

(*l*) *Sudbury* v. *Lee*, 11 R. P. C. 58.

And where in oil boxes a piston actuated by a screw was used for forcing the grease into a joint, the omission of the piston and the making the screw fill the whole of the cavity was held not to show sufficient invention to sustain the patent (*m*).

Mere substitution of one material for another in known article.

And where the alleged invention was the substitution of double-angle iron for two pieces of single-angle iron in the formation of joints to gas holders (*n*), or the substitution of steel hoops for whalebone hoops in a petticoat (*o*), or the replacing of a slide by a hinge in a glass lamp (*p*), or the substitution of a pivot for a hinge in a nail-making machine (*q*), or the use in bottles of a spherical barrel cock previously used in tea urns (*r*), or the substitution of clinker for granite in artificial stone (*s*), the patent was held void.

And when a mincing machine consisting of a cutting part and a filling part was known, and an improved form of the cutting part was also known, it was held that the mere substitution in the machine of the improved for the old cutting part was not good subject-matter for a patent (*t*).

New material to produce known article.

So, also, the use of a new material to produce a known article, as the use of Russian tops, or similar wool, in the manufacture of chignons, which were formerly made from mohair, is not a good subject-matter for a patent (*u*).

Test as to patents for application of old machines.

In all these cases the test appears to be "whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study" (*x*). "It must not be the obvious or natural suggestion of what was previously known" (*y*). The question in each case is whether the new application has invention in it, whether it is something novel, something which entitles the man who so applies the old appliance to a new purpose to describe himself as an inventor (*z*).

(*m*) *Jensen* v. *Smith*, 2 R. P. C. 249.

(*n*) *Horton* v. *Mabon*, 16 C. B. (N.S.) 141.

(*o*) *Thompson* v. *James*, 32 Beav. 570.

(*p*) *Parkes* v. *Stevens*, L. R. 8 Eq. 358, 367.

(*q*) *United Horse Shoe Nail Co.* v. *Swedish Horse Nail Co.* 6 R. P. C. 1, 8.

(*r*) *Hazlehurst* v. *Rylands*, 9 R. P. C. 1.

(*s*) *Adamant Stone and Paving Co.* v. *Corporation of Liverpool*, 14 R. P. C. 18.

(*t*) *Williams* v. *Nye*, 7 R. P. C. 37, 62.

(*u*) *Rushton* v. *Crawley*, L. R. 10 Eq. 522, and see observations of Lord WATSON, *Thomson* v. *American Braided Wire Co.* 6 R. P. C. 525.

(*x*) *Per* Lord CHELMSFORD, *Penn* v. *Bibby*, L. R. 2 Ch. 136. See also *per* LINDLEY, L.J. *Blakey* v. *Latham*, 6 R. P. C. 187.

(*y*) *Per* LINDLEY, L.J., *Blakey* v. *Latham*, 6 R. P. C. 189.

(*z*) *Per* CHARLES, J., *Young* v. *Morris*, 11 R. P. C. 617, 623. See also *per* Lord DAVEY, *Rickmann* v. *Thierry*, 14 R. P. C. 105. 121.

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And the objection of "analogous purpose" will not prevail if that analogous purpose cannot be fulfilled without a substantial variation in the instrument itself, or a distinct method of application requiring the exercise of the inventive faculties (*a*).

There may be cases in which a thing is used which would be identically the old one to produce a new product altogether, but applied to something so totally different that there is an obvious invention in it. Thus, it being known that macaroni pipe could be made by spinning flour into a pipe, an invention of spinning red hot iron, in the same way as the flour was spun into pipes for macaroni, would have been a patentable invention (*b*).

The use in wet spinning of flax of a flexible tube of paper on which the yarn was supported when spun, and to which it would adhere when dried, the tube being placed on a bobbin which revolved on the spindle was held good subject-matter for a patent, although these paper tubes had long been used in the dry spinning of cotton and other yarns, but for a different purpose (*c*).

And the adaptation of a filter-press to the manufacture of artificial stone from cement, or for making slabs of clay, filter-presses being well known for the purpose of removing water from cement and clay amongst other substances, but not for moulding such substances, and this mode of manufacture of artificial stone being shown to possess many advantages over the known methods, was held to involve sufficient invention and utility to support the patent (*d*).

And where the patent was for an invention to apply fillets of wood in the bearings of propellers in steamships, and the only examples of an old use proved were the use of wood in grindstones and water wheels for supporting the bearings, the patent was upheld (*e*).

So also when the invention was for a means of protecting from injury mantles for incandescent lighting which were of an extraordinary fragility of structure, and of a peculiar earthy constitution, it was held that a previous process of protecting the cotton wick of a moderator lamp by treating it in a manner similar to that in which the mantles were treated by the patentee, was too far from the plaintiff's invention to invalidate the patent (*f*).

(*a*) *Per* KEKEWICH, J., *Morgan* v. *Windover*, 4 R. P. C. 426, 427.

(*b*) See *per* BLACKBURN, J., *Bamlett* v. *Picksley*, Griffin, P. C. 40, 42.

(*c*) *Pirrie* v. *York Street Flax Spinning Co.* 10 R. P. C. 34; affirmed 11 R. P. C. 429.

(*d*) *Adamant Stone and Paving Co. Ltd.* v. *Corporation of Liverpool*, 14 R. P. C. 19.

(*e*) *Penn* v. *Bibby*, *ubi supra*.

(*f*) *Sunlight Incandescent, etc., Co.* v. *Incandescent Gas Light Co.* 14 R. P. C. 757, 773.

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The rule, however, as to the application of old contrivances to analogous purposes does not necessarily apply to inventions in chemistry (*g*).

NOTE.

Rule does not necessarily apply to chemical cases.

And in an action for infringement of a chemical patent it was held in the House of Lords that it was no objection to the patent to say that, even though the particular substance patented was unknown, similar bodies, arrived at by similar processes, were well known, and that chemical analogy would at once indicate the supposed invention. "Analogy does not go a long way in chemistry" (*h*).

But where the use of naphthaline in solution had been used for enriching gas, but in that form had certain disadvantages, and naphthaline in a solid form was also known, it was held that a patent for enriching gas by means of solid naphthaline could not be sustained (*i*). And when in a patent for treating cotton oil mucilage so as to obtain soap stock, the plaintiff claimed the employment of chlorinated alkaline leys, or free chlorine gas, on an emulsion of or saponified fats or oils, and transforming them by destroying the colouring matter contained therein, and it was shewn that these agents had been used for the same purpose on identical, or if not identical, on exactly analogous substances, the patent was held void (*k*).

Rule does not apply if article entirely new

If the new invention is an entirely new article, the above considerations will not apply. Thus, in the well-known case of *Crane* v. *Price* (*l*), where the invention was the use of anthracite with hot-air blast for the smelting of iron, the use of the hot-air blast being known, and the use of anthracite with the cold blast being also known, but the use of the two together for the manufacture of iron being new, the patent was sustained, and Sir N. C. TINDAL, C. J., said :—

Combination patents.

"If the result produced by such a combination is either a new article or a better article or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent. . . . . There are numerous instances of patents which have been granted, where the invention consisted in no more than in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those

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(*g*) *Young* v. *Fernie*, 4 Giff. 577.

(*h*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 12 App. Cas. 710, 723, judgment of Lord HERSCHELL. See also *Farbenfabriken* v. *Bowker*, 8 R. P. C. 389.

(*i*) *Albo-Carbon Co.* v. *Kidd*, 4 R. P. C. 535.

(*k*) *Wilson* v. *Union Oil Mills Co.* 9 R. P. C. 57.

(*l*) 1 Webst. 409.

Sect. 29 (2, 3) effects so as to be more economically or beneficially enjoyed by the public" (*m*).

NOTE. Thus, in *Cornish* v. *Keene* (*n*), where the use of elastic threads of india-rubber previously covered by filaments wound round them was old, and the use of yarn, of cotton, or other non-elastic material was old, but the placing them alternately side by side in a warp, and combining them by a weft when in extreme tension and deprived of their elasticity, was new, and the result, viz., a cloth, in which the non-elastic threads formed a limit up to which the elastic threads might be stretched, but beyond which they could not, was a new article, the invention was held good subject-matter for a patent. See also *Dowling* v. *Billington* (*o*), where a patent for making mattresses in a particular way by the use of old machinery, the mattresses thus made being new and useful, was upheld.

The adaptation to raising and lowering gas-tanks of means described in previous patents for an analogous purpose in floating docks and pontoons was held good subject-matter within the principle of *Penn* v. *Bibby*, there being ingenuity required to overcome practical difficulties in the application of the method to gas tanks (*p*).

And in *Hayward* v. *Hamilton* (*q*), where the invention was for a pavement light, consisting of an arrangement of prisms in frames, so as to deflect the light in a particular direction, the patent was sustained, although the manner of using the prism was old, and the particular mode in which the pavement light was made was also old; and the ground of the decision was that the plaintiff had made a claim for a new pavement light, made by combining together the old frame, the old flange, and perhaps the old prism, which old portions had never been combined together before, so as to produce the article claimed by the patentee. In this case, BRAMWELL, L.J., said:—"It seems to me that the plaintiff really is an inventor; he has found out something. He makes an article that was not made before. This particular case may be no doubt upon the verge, but one cannot help making this remark, that it is very strange, if it is no invention, that it has never been done before. Why has it never been done before? Why, because nobody else found it out, which I take to be equivalent to invention" (*r*).

(*m*) See also *Murray* v. *Clayton*, L. R. 7 Ch. 584; *Lyon* v. *Goddard*, 10 R. P. C. 121, 335; 11 R. P. C. 354; *Young* v. *Fernie*, 4 Giff. 577.

(*n*) 1 Webst. 501, 517. See also *Vorwork* v. *Evans*, 7 R.P.C. 265, 271.

(*o*) 7 R. P. C. 191.

(*p*) *Gadd* v. *Mayor of Manchester*, 9 R.P.C. 517; 10 R. P. C. 334.

(*q*) Griffin, P. C. 115. See also *Ducketts* v. *Whitehead*, 12 R. P. C. 187, 376; *Fawcett* v. *Homan*, 13 R. P. C. 393.

(*r*) See, however, on this point observations in *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 125; *Gosnell* v. *Bishop*, 5 R. P. C. 168; *Blakey* v. *Latham*, 6 R.P.C. 187.

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NOTE.

And in *Siddell* v. *Vickers* (*s*), it was said by COTTON, L.J., that none of the cases which have held that a patent cannot be claimed for applying an old machine for an analogous purpose, will apply where there is a new machine, although that new machine does contain, as new machines must do, old and well-known mechanical apliances.

On this ground a patent for a particular method (to be used in the manufacture of ensilage) of compressing fodder in a pit by means of chains, was sustained (*t*); as was also a patent for a bustle, in which the only novelty was the application of rolls of tubular braided wire, new and useful effects being thereby produced (*u*).

And where in an invention for turning forgings the use of a chain and wheel was old, and the use of a ratchet wheel for turning forgings was also old, it was held that the combination of these elements into a portable appliance, which enabled work to be done which could not be done before, was good subject-matter for a patent (*x*).

And where the invention consisted in producing ornamental designs on waterproof fabrics, by printing them in colours on a farina-coated fabric "by suitable means, such, for example, as those employed in calico printing," and then vulcanizing, it was held that since the plaintiff by his new combination of old processes produced a new and useful article of commerce, which had never been produced before, the objection of want of subject-matter failed (*y*).

New alloy of metals.

In *Muntz* v. *Foster* (*z*), the well-known case of the patent for metal sheathing for ships, where the invention was an alloy of zinc and copper in certain proportions, the patent was held good; and Sir N. C. TINDAL, C.J., said:—"If it was shown, as possibly it might be, that sheets had been made of metal before in the same proportions which he (the patentee) has pointed out, but if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal as there would be in discovering an unknown quality which a natural earth or stone possessed."

New recipes.

The discovery that the mixture of two or more simple substances in certain definite proportions will form a compound valuable for medical

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(*s*) 5 R. P. C. 430.

(*t*) *Reynolds* v. *Amos*, 3 R. P. C. 215.

(*u*) *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 113; affirmed by the House of Lords, 6 R. P. C. p. 518.

(*x*) *Siddell* v. *Vickers*, 39 Ch. D. 92; affirmed 15 App. Cas. 496.

(*y*) *Moseley* v. *Victoria Rubber Co.* 4 R. P. C. 241.

(*z*) 2 Webst. 103.

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or other purposes affords good ground for a patent (*a*). Thus, for instance, the use for preserving animal substances of bi-sulphate of lime in a medium of gelatine would be good subject-matter (*b*).

The term "Patent medicines," in the Pharmacy Act, 1868 (*c*), means only medicines which are the subject of letters patent, and does not extend to proprietary medicines (*d*).

New combination of materials.

And where the invention consisted in the manufacture of pile fabrics in imitation of sealskins, by a combination of silk and mohair in the raw state (that is, the materials were blended previous to spinning), and the patentee had by observation of the structure of the natural sealskin and by careful experiments ascertained that the above mixture would produce certain beneficial results existing in the natural article, but not found in any then-known imitation, it was held, that there was good subject-matter for the patent; although it was proved that the same combination had been well known for some years in what were known as Bradford dress goods, but which were a smooth material wholly different from pile fabrics (*e*).

New discovery invoking a particular law of nature.

And the introduction into an old combination of a new shape of one of the old elements of that combination which invokes a law of nature otherwise left on one side, may be the good subject of a patent; and, therefore, where it appeared that in the patentee's electric lamp a carbon filament was used, whereas in a previous lamp a rod and not a filament of carbon had been adopted, and the patentee had used the filament for a definite purpose, and by the diminution of the sectional area made a physical law subserve the end he had in view, the patent was sustained (*f*)

New test in chemical process.

When in an action on a patent for the production of colouring matter it was shown that the process of sulphonation was known, and it was also known that this sulphonation admitted of degrees, the higher degrees being obtained by increase of the elements of time, strength of acid or temperature, it was held that a claim for the preparation of certain sulpho-acids which had certain peculiar properties and were new, the preparation process consisting essentially in the application of a certain

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(*a*) *Bewley* v. *Hancock*, 6 D. M. G. 391.

(*b*) See *per* Lord CAIRNS, L.C. *Bailey* v. *Roberton*, 3 App. Cas. 1062, 1063.

(*c*) 31 & 32 Vict. c. 121.

(*d*) *Pharmaceutical Society* v. *Piper*, [1893] 1 Q. B. 686.

(*e*) *Lister* v. *Norton*, 3 R. P. C 199, 206.

(*f*) *Edison, etc. Co.* v. *Woodhouse* (first action), 4 R. P. C. 79, 92, 93; *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 517.

new test, whereby it was at once shown when the proper degrees of sulphonation had been reached, was good subject-matter for a patent (*g*).

NOTE. How far long unsatisfied demand taken into consideration on question of invention.

Where there has been a long unsatisfied demand, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained unsupplied is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle, which otherwise seems, from the long unsatisfied demand, to have existed somewhere or in some shape (*h*).

Immediate success of the new article, how far test of invention.

It is an important element, in the consideration whether there has been an invention or not, if the thing never was done in the memory of man, down to a particular point, and at the moment it is done it is a great success as regards utility and as regards value in the market (*i*). And where the use in musical instruments of circular perforated discs for the purpose of actuating valves and so producing notes was known, and the use of endless perforated bands for actuating the levers of such valves was known, a patent for a portable organ, in which the levers were actuated by means of a perforated disc, was upheld, it being shown that, immediately upon its introduction, there was an enormous sale which drove the endless band instrument out of the market (*k*).

Very little invention will sustain a patent.

If there is any invention a very little is sufficient to sustain a patent. Where a slight alteration in the combination "turns that which was practically useless before into that which is very useful and important," judges have considered that, though the invention was small, yet the result was so great as to be fairly the subject of a patent (*l*). Thus, the substitution in a duplex lamp of a round wick for a flat wick (*m*); and the manufacturing gelatine by reducing the skin into shavings by an instrument resembling a carpenter's plane (*n*),—were held to be good subject-matter for patents.

And where the patented invention differed from a previously known hand camera with folding sides in having the folding sides hinge bound,

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(*g*) *Badische Anilin und Soda Fabrik* v. *Dawson*, 6 R. P. C. 387.

(*h*) *Per* BOWEN, L.J., *Gosnell* v. *Bishop*, 5 R. P. C. 158.

(*i*) *Per* BOWEN, L.J., *American Braided Wire Co.* v. *Thomson & Co.* 5 R. P. C. 125, and see *Ehrlich* v. *Ihlee*, 5 R. P. C. 205, judgment of KEKEWICH, J.; and remarks of Lord ESHER, M.R. in *Edison Bell Phonograph, etc. Co.* v. *Smith*, 11 R. P. C. 398. See also *Dowling* v. *Billington*, 7 R. P. C. 191, 204; *Ducketts* v. *Whitehead*, 12 R. P. C. 376, 379, 381.

(*k*) *Ehrlich* v. *Ihlee*, 5 R. P. C. 437.

(*l*) *Per* JESSEL, M.R., *Hinks* v. *Safety Lighting Co.*, 4 Ch. D. 615, 616. See also *Re Betts' Patent*, 1 Moo. P. C. (N.S.) 49, and observations of COTTON, L.J., *Williams* v. *Nye*, 7 R. P. C. 62, 67.

(*m*) *Hinks* v. *Safety Lighting Co.*, *ubi supra*.

(*n*) *Warrington* v. *Dale*, 7 Ex. 888.

Sect. 29 (2, 3) giving extra rigidity to the front, this was held to be sufficient invention to support the patent (*o*).

NOTE. And in *Edison, etc. Co.* v. *Holland* (*p*), where the main difference between the Edison electric lamp and that previously made by Swan was that the rod or filament in the Swan lamp was carbonized after being put into shape, and it was proved that the difference introduced by Edison had changed failure into success, the patent was upheld.

But while no smallness or simplicity will prevent a patent being good, mere novelty of manufacture or usefulness in the application of known materials to analogous uses will not necessarily establish invention within the meaning of the patent law (*q*). And if the alleged invention is simply the application of a well-known thing to an analogous use the mere fact that it is accompanied by advantages not thought of or practised before is no answer to the objection that there is no invention (*r*).

An alleged invention may, on the face of it, be insufficient subject-matter for a patent; as where the patent was for an improved box for the parcels post, the invention consisting in two boxes or cases placed one within the other, the space between the one and the other being provided with a packing such as that described in the specification, which packing was shown to be old (*s*); or for the placing of grooves in a particular manner along the length of a handle of a bat (*t*), or the use of a siphon bend for the purpose of keeping a supply of steam in a coil of pipe (*u*).

And where the specification claimed a flexible comb for securing ladies' hats in position and a short comb of the same form was known which, if made longer, would have been flexible, it was held that there was not sufficient invention to form subject-matter for a patent (*v*).

Utility.—Want of utility in the invention is another common objection to a patent. The statute of James says nothing about utility, but utility has been engrafted into it because of the words in that statute that the letters patent "be not contrary to law or mischievous to the State by raising of prices of commodities at home or generally inconvenient," that is to say it has been found by experience that it is

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(*o*) *Perry* v. *Société des Lunetiers*, 13 R. P. C. 671. See also *Scott* v. *Hamling*, 14 R. P. C. 123.

(*p*) 6 R. P. C. 243, 277.

(*q*) *Riehmann* v. *Thierry*, 14 R.P.C. 105, 115 (H. L.).

(*r*) *Morgan* v. *Windover*, 7 R.P.C. 131, 134, 138.

(*s*) *Jackson* v. *Needle*, 2 R. P. C. 194.

(*t*) *Slazenger* v. *Feltham*, 6 R. P. C. 233. See also *Herrburger* v. *Squire* 6 R. P. C. 194.

(*u*) *Rose's Patents Co.* v. *Braby*, 11 R. P. C. 198.

(*v*) *Savage* v. *Harris*, 13 R. P. C. 364.

mischievous to the State to grant patents which are not useful as well as new (*x*). Sect. 29 (2, 3)

NOTE.

Upon this question, it is settled that the slightest amount of utility is sufficient to sustain a patent (*y*); and in law, utility means "an invention better than the preceding knowledge of the trade as to a particular fabric. It does not mean abstract utility" (*z*).

"Utility is a question of degree, and always has reference to some object. Useful for what? is a question which must be always asked, and the answer must be, Useful for the purposes indicated by the patentee" (*a*).

The element of commercial pecuniary success has no relation to the question of utility in patent law (*b*), and it is not a correct test of utility to inquire whether the invented product was at the time of the patent likely to be in commercial demand, or capable of being produced at a cost which would make it a profitable commercial speculation to manufacture it (*c*). But an interrogatory asking whether the patentee had not found it necessary to introduce modifications into the patented process in order to enable it to be worked successfully for commercial purposes is relevant to the issue of utility since the answer may be a step towards the defendant's proof of that issue (*d*).

And the patent may be good even though none of the patented machines have ever been sold if there is evidence that they will work (*e*).

If one part of an invention is impracticable and useless the patent is void (*f*). But where there is general utility, that is, utility of the invention as a whole, the patentee is not bound to prove that each part of the invention is equally useful (*g*).

(*x*) *Per* LINDLEY, L.J. *Elias* v. *Grovesend Tinplate Co.*, 7 R. P. C. 467.

(*y*) *Per* GROVE, J., *Philpott* v. *Hanbury*, 2 R. P. C. 37.

(*z*) *Young* v. *Rosenthal*, 1 R. P. C. 34. GROVE, J. See also p. 41.

(*a*) *Per* LINDLEY, L.J., *Lane-Fox* v. *Kensington, etc., Co.*, [1892] 3 Ch. 431.

(*b*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 12 App. Cas. 710, 712, judgment of Lord HALSBURY, C., *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 450. *Sunlight Incandescent Co.* v. *Incandescent Gas Light Co.* 14 R. P. C. 757, 775.

(*c*) *Badische, etc. Fabrik* v. *Levinstein*, 12 App. Cas. 710.

(*d*) *Rylands* v. *Ashley's, etc. Co.* 7 R. P. C. 175.

(*e*) *Otto* v. *Linford*, 46 L. T. (N.S.) 39; Goodeve, P.C. 349; *Renard* v. *Levinstein*, quoted by JESSEL, M.R., in *Otto* v. *Linford*, *ubi supra*; *United Telephone Co.* v. *Bassano*, 3 R. P. C. 295, 313; *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 450; *Edison, etc. Co.* v. *Holland*, 6 R. P. C. 243, 277.

(*f*) *Morgan* v. *Seaward*, 1 Webst. 196; *United Horse Shoe and Nail Co.* v. *Stewart*, 2 R. P. C. 122, 132; *United Horse Shoe and Nail Co.* v. *Swedish Horse Nail Co.* 6 R. P. C. 1.

(*g*) *Per* KEKEWICH, J., *Ehrlich* v. *Ihlee*, 5 R. P. C. 203.

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The fact that the defendant has attempted to infringe is of itself evidence of the utility of the invention (*h*).

NOTE.

And in the case of a mechanical musical instrument, the fact that since the introduction of the new machine thousands had been sold, and the old machines had become a drug in the market, was held to be sufficient proof of utility (*i*).

But in an invention for locking the catch rods in railway signals, the mechanical impossibility of going wrong by anything short of violence or malice was held to be an absolute condition of usefulness, and since this did not exist the patent was held bad (*k*). And where in an invention for points and crossings for tramways the drawing of the specification showed a point which the court held on the evidence to be a right-hand and not a left-hand point, and it was shown that a right-hand point was practically valueless, it was held that the invention was not useful and that the patent was invalid (*l*). And where the invention differed only from an earlier one by an ingredient which did neither harm nor good, it was held that there was not sufficient utility to support a patent (*m*). And when a method of punching blanks for nails was shown to be useless for its avowed purpose and to cause waste of material, the patent was held void (*n*).

The burden of proving utility is not always on the patentee. If a *primâ facie* case is made that the invention is not useful, it is for the patentee to prove that it is useful (*o*).

An invention may be useful as indicating the direction in which further progress is to be expected, and yet that same invention may be useless for any other purposes, useless, that is, as an invention without further developments and improvements which have not occurred to the patentee. And when this appeared to be the case a patent for the invention was held invalid (*p*).

The circumstance that the patentee takes out a subsequent patent for an improvement on the first invention is no ground for inferring that the first invention was useless (*q*).

(*h*) *Lucas* v. *Miller*, 2 R. P. C. 158, 160. See also *Badische Anilin und Soda Fabrik* v. *Levinstein*, 12 App. Cas. 710, 712; *United Horse Shoe and Nail Co.* v. *Stewart*, 13 App. Cas. 401, 407; *Reynolds* v. *Amos*, 3 R. P. C. 215.

(*i*) *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 449.

(*k*) *Easterbrook* v. *Great Western Rail. Co.* 2 R. P. C. 207.

(*l*) *Winby* v. *Manchester, etc. Co.* 8 R. P. C. 61.

(*m*) *Lawrence* v. *Perry*, 2 R. P. C. 180, 184.

(*n*) *United Horse Shoe and Nail Co.* v. *Swedish Horse Nail Co.* 6 R. P. C. 1.

(*o*) *Ehrlich* v. *Ihlee*, *ubi supra*, Judgment of COTTON, L.J.

(*p*) *Lane-Fox* v. *Kensington, etc. Co.*, [1892] 3 Ch. 424, 431.

(*q*) *Per* BRETT, L.J., *Otto* v. *Linford*, 46 L. T. (N.S.) 39; *Thomson* v. *Batty*, 6 R. P. C. 84, 100; *Edison, etc. Co.* v. *Holland*, 6 R. P. C. 243, 277.

SUB-SECTION (4). Sect. 29 (4).

NOTE.

"Except by leave of the court or a judge."—These words are an addition to the Act of 1852 (s. 41), which was peremptory that no evidence should be given which was not contained in the particulars.

And under that Act a defendant was not allowed at the trial to adduce evidence of prior user not disclosed by his particulars of objection, even though such evidence had only come to his knowledge since the particulars were delivered. In such a case the right course was to apply at once, on learning the new evidence, for leave to amend the particulars (*r*).

But under this sub-section it is in the discretion of the judge to allow evidence to go beyond the particulars actually delivered, and this is different from the power of allowing particulars to be amended, which is given by the next sub-section (*s*).

Notwithstanding, however, the discretion given to the judge, it will always be prudent to apply before the trial for leave to amend by adding new objections, since the court will always protect the plaintiff from surprise, and may refuse at the trial to give leave under this section, or to allow the particulars to be amended (*t*). Objections to an amended specification that the amendment made was not the amendment advertised, or that the amendment was made pending proceedings and in contravention of s. 18 (10) of the Act ought to appear in the particulars of objections (*u*).

A plaintiff's witness may, in cross-examination, be asked questions in a general form as to his knowledge of user of the invention prior to the patent, although this may not be mentioned in the objections, but the counsel for the defendant is not entitled to inquire of the plaintiff's witnesses as to any specific instance of prior user of which he has not given notice (*x*). And where at the trial evidence was given of a method which appeared completely to anticipate the plaintiff's invention, but no particulars of this had been given, the court at the plaintiff's request allowed the case to stand over but at the plaintiff's risk as to costs, the defendants being also at liberty to give particulars of further instances of user of this method (*y*).

But if the evidence is within the literal meaning of the words of the particulars, however general the statement the evidence will be received

Evidence within literal meaning of

(*r*) *Daw* v. *Eley*, L. R. 1 Eq. 38.
(*s*) *Britain* v. *Hirsch*, 5 R. P. C. 226, 231.
(*t*) See *Moss* v. *Malings*, 33 Ch. D. 603.
(*u*) *Farbenfabriken* v. *Bowker*, 8 R. P. C. 389.
(*x*) *Penn* v. *Bibby*, L. R. 2 Ch. 127, 137.
(*y*) *Pascall* v. *Toope*, 7 R. P. C. 125.

Sect. 29 (4).

NOTE. particulars admitted.

at the trial (*z*). The only question then is, whether the words of the notice are sufficiently large to include the objection (*a*). Thus, where particulars of breaches alleged that the defendant had at divers times between specified dates infringed by the manufacture or sale or use of the patented article, and in particular alleged sales to two specified persons, and the defendant, in answer to interrogatories, admitted a sale to a third person, the plaintiff was allowed to give evidence at the trial of the transactions with that third person (*b*).

And where the particulars of objections alleged that the invention had *been publicly used in corn-mills*, evidence of user in Cheshire was admitted (*c*).

Where, however, a defendant had been ordered to amend his particulars of objections by stating the names and dates of the specifications relied upon, or *that they should be excluded*, and the defendant amended by giving a notice for all the plaintiff's specifications "*between 1 Jan. 1840 and 20 Mar. 1850*," it was held at the trial that the order had not been complied with, and a specification granted in 1849 was not admitted in evidence (*d*).

Where specific acts of infringement were stated in the particulars, and the defence denied infringement at all, and the plaintiffs having proved their case, the defendants went into evidence on the wider issue raised by them, it was held that the Act of 1852, s. 41, did not apply to such a case, and that as the defendants had not confined themselves to meeting the case set up against them, the plaintiffs were at liberty to adduce evidence in reply by giving instances of infringement other than those alleged in their particulars (*e*).

Plaintiff's evidence in support of patent.

If the novelty or effect of the invention be disputed, the plaintiff must show in what his invention consists, and that he produced the effect proposed by his patent in the manner proposed. Slight evidence of this on his part is sufficient, and it is then incumbent on the defendant to falsify the specification (*f*). It will be sufficient for the plaintiff to call persons of science or workmen who say that the specification is intelligible to them, and that they can make the invention without further instruction than the specification (*g*).

(*z*) *Per* POLLOCK, C.B., *Hull* v. *Bollard*, 1 H. & N. 134; *Curtis* v. *Platt*, 35 L. J. (N.S.) Ch. 852, 868; and see remarks of MELLISH, L.J., *Sugg* v. *Silber*, 2 Q. B. D. 495.

(*a*) *Per* ALDERSON, B., *Neilson* v. *Harford*, 1 Webst. 332. See also p. 370.

(*b*) *Sykes* v. *Howarth*, 12 Ch. D 826; 48 L, J. Ch. 769.

(*c*) *Hull* v. *Bollard*, *ubi supra*.

(*d*) *Lister* v. *Leather*, 3 Jur. (N.S.) 811.

(*e*) *Adair* v. *Young*, W. N. 1879, p. 8.

(*f*) *Turner* v. *Winter*, 1 Webst. 81; *Westley Richards* v. *Perkes*, 10 R. P. C. 181, 186.

(*g*) *Cornish* v. *Keene*, 1 Webst. 503.

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NOTE.

Evidence of patentee as to invention.

In *Crossley* v. *Potter* (*h*), the parol evidence of the patentee was held admissible to prove that the patent was not obtained for some of the things claimed in the specification. And the ground of the decision was that there must be some means of getting at the fact of what the invention was, and that the specification could not be conclusive evidence, as it might have been fraudulently prepared. And on the patentee being examined it turned out that the patentee was the inventor of a loom for weaving coach lace, and knew nothing about carpet weaving, and that before specifying he had sold the patent to other parties, who drew the specification and described the machinery as being applicable to the weaving of carpets as well as of coach lace. But in the *Badische Anilin und Soda Fabrik* v. *Levinstein* (*i*), it was held, in the House of Lords, that neither the actual inventor nor any other witness could be called to prove what the real invention was, and that this was a question which could only be answered from a critical examination of the specification. And in *Kaye* v. *Chubb* (*k*), the Court of Appeal, upon an objection that the plaintiff's invention had been anticipated by an earlier patentee, refused to consider as conclusive the evidence of the latter tending to show that, when he framed his specification, he did not intend it to have the effect now attributed to it, and that he never saw that it had that effect, and the court drew its own conclusion from the prior specification.

Where the defendant denies the novelty of the invention, the affirmative of the issue thus raised rests with him (*l*). And if a specification is alleged as an anticipation, evidence should be called to explain it (*m*). And even if there is identity of language between two specifications, it cannot be predicated that both describe the same external object, unless it is ascertained that the terms of art used in the one have the same signification and denote the same external objects at the date of the one specification as they do at the date of the other (*n*).

Evidence in reply.

The plaintiff can only make a *primâ facie* case as to novelty by calling persons conversant with the subject to show that they had not heard of the invention before the date of the patent. That is enough

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(*h*) Macr. P. C. 253, 255. See also *Bateman* v. *Gray*, Macr. P. C. 111. See, however, *Hinks* v. *Safety Lighting Co.*, L. J. No. Ca. 1876, p. 213.

(*i*) 12 App. Cas. 717, judgment of Lord HERSCHELL.

(*k*) 4 R. P. C. 289, 297, 298.

(*l*) *Penn* v. *Jack*, L. R. 2 Eq. 314; *Minter* v. *Wells*, 1 Webst. P. C. 129; *Peroni* v. *Hudson*, 1 R. P. C. 261; *Westley Richards*, v. *Perkes*, 10 R. P. C. 181, 186.

(*m*) See observations of BACON, V.-C., *Hooking* v. *Fraser*, 3 R. P. C. 6, 7. See also *Borill* v. *Smith*, Griffin, L. O. C. 52.

(*n*) *Betts* v. *Menzies*, 10 H. L. C. 177.

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to call on the other side (*o*), and, therefore, the plaintiff will be allowed to call evidence in reply, for the purpose of rebutting the case set up by the defendants (*p*). And where the defendants' evidence had gone further than was justified by the particulars of objection, the trial was, after the defendants' evidence was closed, ordered to stand over, in order to give the plaintiff the opportunity of rebutting this evidence, the defendants being at the same time allowed to amend their objections, so as to include the evidence they had given (*q*).

And where it appeared that there was a point relevant to the issue, which had not been thoroughly "threshed out" at the trial, and which did not affect the credit of any of the witnesses, the plaintiff was allowed to adduce fresh evidence after the evidence had been given and counsel's speeches on both sides delivered, and judgment had been reserved (*r*).

Where, however, a plaintiff has given a part of his evidence on the issue of novelty, and at the commencement of his case has had his attention called to a prior specification, he cannot, for the purpose of giving evidence as to the contents of it, recall, in reply, any witness who, when he gave his evidence, was acquainted with the specification in question (*s*).

When no affidavit of documents had been required by plaintiff, and at a late stage of a trial it appeared that defendant had received a report from a patent agent, which report was not produced, the plaintiff was not allowed to recall a witness to be cross-examined as to the contents of the report (*t*).

And when the plaintiff's witness, the patentee, gave evidence which showed the patent invalid, a motion for a new trial, on the ground that the witness had made a slip, was refused (*u*).

A defendant, after cross-examination of plaintiff was concluded, was not allowed to recall him to put to him a prior user, it not being shown that the matter had only been recently discovered, and could not with reasonable diligence have been discovered before (*x*).

And after the evidence of the defendant has been summed up, he will not be allowed to adduce further evidence in answer to that given by the plaintiff in reply (*y*).

(*o*) *Galloway* v. *Bleaden*, 1 Webst. P. C. 526; *Cornish* v. *Keene*, 1 Webst. P. C. 509; *Amory* v. *Brown*, L. R. 8 Eq. 663; *Harris* v. *Rothwell*, 35 Ch. D. 416, 427; *Westley Richards* v. *Perkes*, 10 R. P. C. 181, 186.

(*p*) *Penn* v. *Jack*, L. R. 2 Eq. 314.

(*q*) *Blakey* v. *Latham*, 6 R. P. C. 29, 36.

(*r*) *Boyd* v. *Horrocks*, 5 R. P. C. 558.

(*s*) *Tetley* v. *Easton*, Macr. P. C. 61.

(*t*) *Sugg* v. *Bray*, 54 L. J. Ch. (N.S.) 132.

(*u*) *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 399.

(*x*) *Moss* v. *Malings*, 3 R. P. C. 373.

(*y*) *Penn* v. *Jack*, L. R. 2 Eq. 314.

If the defendant has put in a defence, but does not appear at the trial, the plaintiff must prove his case. And for this purpose it is sufficient for the plaintiff to prove the specification and infringement (*z*). Sect. 29 (4). NOTE.

Infringement.—The question of infringement is one of mixed law and fact, and, when the facts are ascertained, the question is one of law for the court (*a*).

In ordinary cases the burden of proving infringement lies upon the plaintiff (*b*), and the patentee is bound to prove, not merely the user of the invention by the defendant, but also that such user was unauthorized; and, therefore, where in an action to restrain the sale of a patented article the plaintiff proved the sale, but did not prove that the article complained of had not been made by himself or his agent, the bill was dismissed (*c*). Evidence of infringement.

But when the thing complained of is manufactured abroad, and the plaintiff has been unable to obtain inspection of the defendant's process, and can, therefore, only produce *primâ facie* evidence of infringement, it seems that it is the duty of the defendant to give evidence of a negative character, to show that the process used was of a different character from that which had been patented (*d*). Where onus on defendant.

And when the defendant pleaded that he had not infringed, and in the alternative that the subject-matter of the sale complained of was purchased from a person with whom the plaintiff had agreed not to take proceedings in respect of the said goods, it was held that the burden of proof of the alternative fact was on the defendant. And with regard to the defence of non-infringement, the plaintiffs having proved that the defendant had sold the patented article, it was also held that when that fact was proved it lay on the defendant to show how and why it was that he was selling it (*e*).

When the plaintiffs merely proved a sale of the infringing article, but did not prove that they had not made it themselves, and the defendant did not call evidence, and objected that the plaintiffs had not proved infringement, but declined to call evidence, the plaintiffs were allowed to call further evidence to show that they had not made the article (*f*).

(*z*) *Peroni* v. *Hudson*, 1 R. P. C. 261; S. C. R. 1883, Ord. XXXVI. r. 31.

(*a*) *Seed* v. *Higgins*, 8 H. L. C. 565; *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 229, 237, 244.

(*b*) *Neilson* v. *Betts*. L. R. 5 H. L. 1, 11.

(*c*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

(*d*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*e*) *Badische Anilin und Soda Fabrik* v. *Dawson*, 6 R. P. C. 387.

(*f*) *Farbenfabriken* v. *Bowker*, 8 R. P. C. 389.

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NOTE

Evidence that an order was given in England, which order was executed in England, for making articles by the same mode for which the plaintiffs had obtained their patent, which articles were afterwards received by the defendant, is sufficient to satisfy an allegation that he made those articles (*g*).

So also where, in an action for infringement of a method of improving lace and net by passing it over a flame of gas in a gassing machine, it was proved that the lace left with the defendant to be dressed had been returned in the state to which it would have been brought by the use of the plaintiff's process, and that similar lace had been offered for sale by the defendant, and that the defendant had one of the patented machines in his possession, it was held there was sufficient evidence of infringement (*h*).

But when the article, which was admitted to be the same as the plaintiff's, had been made by the defendant in its present form at the express request of the plaintiff's agent who had given the order for it, it was held that the defendant had not infringed (*i*).

Where a trade secret is alleged by the defendant, and there has been no inspection by the plaintiff, similarity of structure in the patented article and the things produced by the defendant is *primâ facie* evidence of infringement (*k*).

The above cases, however, will not apply when it is clear on the evidence that the articles complained of may have been produced by machinery which involved no infringement of the plaintiff's patent (*l*).

And an admission by the defendants that they had worked according to the specification of a certain patent, the specification being susceptible of two constructions, one of which would not infringe the plaintiff's patent, was held insufficient evidence of infringement (*m*).

Sale or importation.

The sale (*n*) in this country of the patented article, even if made abroad (*o*), and sold to a foreign customer (*p*), is an infringement. So, also, is the importation from abroad and sale in this country of products made according to the patented process (*q*).

(*g*) *Gibson* v. *Brand*, 1 Webst. P. C. 631.

(*h*) *Hall* v. *Boot*, 1 Webst. P. C. 103.

(*i*) *Kelly* v. *Batchelar*, 10 R. P. C. 289. See also *Hennessy* v. *Kennett*, Seb. Dig. p. 331.

(*k*) *Huddart* v. *Grimshaw*, 1 Webst. P. C. 91. See also *Davenport* v. *Richards*, 3 L. T. (N.S.) 503.

(*l*) *Cartsburn Sugar Refining Co.* v. *Sharp*, 1 R. P. C. 181.

(*m*) *Winby* v. *Manchester, etc. Steam Tramways Co.* 7 R. P. C. 30.

(*n*) *Walton* v. *Lavater*, 8 C. B. (N.S.) 190.

(*o*) *Walton* v. *Lavater*, 8 C. B. (N.S.) 185.

(*p*) See *per* KAY, J., *United Telephone Co.* v. *Sharples*, 29 Ch. D. 164.

(*q*) *Elmslie* v. *Boursier*, L. R. 9 Eq. 217; *Wright* v. *Hitchcock*, L. R. 5 Ex. 37; *Von Heyden* v. *Neustadt*, 14 Ch. D. 230 (C. A.); *Cartsburn Sugar Refining Co.* v. *Sharp*, 1 R. P. C. 181.

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Where an English dealer wrote to a foreign manufacturer asking the latter to send him by post a certain quantity of an infringing article, and the foreigner sent it to a forwarding agent abroad to be held at the English dealer's disposal, this was held by the Court of Appeal to be *primâ facie* a sale in England, and leave was given to serve a concurrent writ in an action against the English dealer and the foreigner, and to serve notice of it on the foreigner out of the jurisdiction (*r*). Upon the case coming on for trial, it appeared that the foreign forwarding agents had forwarded the article by post, and in the Court of Appeal the transaction was treated as if the foreign manufacturer had himself posted the article. It was held by the majority of the court that the foreign manufacturer had done nothing in this country to infringe the patent, and judgment was entered for him in the action (*s*). And this decision was affirmed by the House of Lords (*t*).

Exposure or offering for sale.

In *Minter* v. *Williams* (*u*), mere exposure for sale of infringing articles was held not to be an infringement. But in *Oxley* v. *Holden* (*x*), where the defendant had made articles according to the invention, and his traveller had offered them for sale, but had not sold any, it was held there had been a user of the patent.

A loan, without any intention to sell or invade the patent (*y*), is not an infringement. And the mere offer to supply "swivelling" pumps, the patent not claiming every kind of swivelling pump, unaccompanied by any evidence of positive infringement, was held not to be sufficient to support an application for an injunction (*z*).

Sale by patentee makes article free in hands of purchaser.

The sale by a patentee of an article made under the patent, and sold without any restriction on the buyer, and whether the article be made under an English or a foreign patent, gives the purchaser an absolute right to deal with that which he so buys in any way he thinks fit, which includes selling in any country where there is a patent in the possession of and owned by the vendor (*a*). And a purchaser from a patentee without notice of an exclusive licence granted for a limited district, cannot be restrained by the licensee from selling within the district (*b*).

So, also, the re-sale of an article purchased from a licensee is no infringement (*c*), even though the licence be for a limited area, and the purchaser from the licensee sells outside that area (*d*).

(*r*) *Badische Anilin und Soda Fabrik* v. *Johnson*, [1896] 1 Ch. 25.
(*s*) [1897] 2 Ch. 322.
(*t*) [1898] A. C. 200.
(*u*) 4 A. & E. 251.
(*x*) 8 C. B. (N.S.) 666.
(*y*) *United Telephone Co.* v. *Henry*, 2 R. P. C. 11.
(*z*) *Gwynne* v. *Drysdale*, 2 R. P. C. 160. *S.C.*, on appeal, 3 R. P. C. 65.
(*a*) See *per* COTTON, L. J., *Société Anonyme des Manufactures de Glaces* v *Tilghman's Patent Sand Blast Company*, 25 Ch. D. 9; *Betts* v. *Willmott*, L. R. 6 Ch. 239.
(*b*) *Heap* v. *Hartley*, 5 R.P.C. 603.
(*c*) *Thomas* v. *Hunt*, 17 C. B. (N.S.) 183.
(*d*) *Smith* v. *Buchanan*, 26 S. J. 347.

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NOTE.

But licensor may impose conditions.

It is, however, open to the licensor to impose his own conditions on the user of the patented article, and if these are brought to the knowledge of the purchaser at the time of sale, he is bound by the conditions (*e*).

But it is otherwise if the purchaser buys without knowledge of the conditions, and therefore when certain mantles for incandescent gas lighting were sold to an agent of the purchaser and consigned directly to the purchaser, and nothing was said about conditions on the occasion of the sale to the agent, and the purchaser on opening the parcel learnt for the first time that each mantle was enclosed in a box with a label stating certain conditions under which alone it might be used ; it was held he was not bound by the conditions, and was justified in pasting his own labels on the boxes and re-selling them without restriction (*f*).

A licence to exercise the invention in a foreign country does not imply permission to sell the article in England in violation of an English patent of the same patentee (*g*).

The sale of the patented article implies no warranty that the patent is valid, or that the purchaser may use the machine as against another patentee (*h*).

Making for amusement or experiment.

The making of patented articles merely for amusement or as a model (*i*), or by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose for which a patent has been granted, but with a view of improving upon the invention, or with the view of seeing whether an improvement can be made or not (*k*), is not an invasion of the exclusive rights granted by the patent (*l*).

But where defendants had purchased certain infringing machines which had been erected at their works upon the understanding that they were only to be paid for if successful, and the machines were in use for several months, it was held that the user was not experimental, and was an infringement (*m*).

Manufacture for sale.

The manufacture for the purpose of sale is an infringement, even though the article is never actually sold (*n*).

Manufacture and sale of component parts.

The mere manufacture and sale of component parts of an infringing machine (*o*), or the supply of articles with the intention that they shall

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(*e*) *Incandescent Light Co.* v. *Cantelo*, 12 R. P. C. 262.

(*f*) *Incandescent Light Co.* v. *Cantelo, ubi supra.*

(*g*) *Société Anonyme, etc.* v. *Tilghman's, etc.*, 25 Ch. D. 1.

(*h*) *Monforts* v. *Marsden*, 12 R. P. C. 266.

(*i*) *Jones* v. *Pearce*, 1 Webst. 124.

(*k*) *Frearson* v. *Loe*, 9 Ch. D. 66 ; *Muntz* v. *Foster*, 2 Webst. 101.

(*l*) See also *Higgs* v. *Goodwin*, E. B. & E. 529.

(*m*) *Proctor* v. *Bayley*, 6 R. P. C. 106, 42 Ch. D. 390.

(*n*) *Muntz* v. *Foster*, 2 Webst. 101.

(*o*) *M'Cormick* v. *Gray*, 7 H. & N. 25 ; *Savage* v. *Brindle*, 13 R.P.C. 266.

be used in infringing the patent, is not an infringement (*p*). But an injunction granted to restrain the sale of a complete machine would, it seems, be violated by the sale of the component parts of the machine in such a way that they might be put together by any one (*q*).

Repairing patented instruments.

And repairing patented instruments by restoring essential parts of the combination (*r*), or the possession of infringing machines for instruction of and use by pupils (*s*) is an infringement.

User for new purpose.

If a combination of machinery originally directed to one purpose is made to minister to another and additional purpose, the user of it for that additional purpose is an infringement of the patent for the combination (*t*).

User, active or passive.

User of the patented article in this country, whether active, as on board a foreign ship in British waters (*u*), or passive, as when bottles capsuled with a capsule made of the patented material were sent from Scotland to England for the purpose of being exported from England (*x*), is an infringement.

In the case of machinery the prohibition extends to the product of the machinery (*y*).

Infringement of combination patents.

In *Lister* v. *Leather* (*z*), it was said that a patent for a whole combination may be infringed by taking part, provided it is a new and material part of the combination. Upon this case it has been observed by JAMES, V.-C., that it had been thought to establish that a patent for a combination would be a distinct patent for everything that is new and material and went to make up the invention, but that the judgment gave no warrant for such a contention, and that all that was meant was that "you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—is it really and substantially a part of the invention . . . Supposing that a clock was now for the first time invented, and patented as a machine for measuring and indicating time, a man could not evade the patentee's right by substituting a spring for a weight, or by leaving out the whole of the striking apparatus" (*a*).

(*p*) *Townsend* v. *Haworth*, 12 Ch. D. 831, n.; more fully reported 48 L. J. Ch. (N.S.) 770; Higgins, 165, 168.

(*q*) *United Telephone Co.* v. *Dale*, 25 Ch. D. 778.

(*r*) *United Telephone Co.* v. *Nelson*, W. N. 1887, 193.

(*s*) *United Telephone Company* v. *Sharples*, 29 Ch. D. 164.

(*t*) *Per* Lord WESTBURY, *Cannington* v. *Nuttall*, L. R. 5 H. L. 205, 230. See also *Pneumatic Tyre Co.* v. *East London Rubber Co.* 14 R.P.C. 77, 103, 573.

(*u*) *Caldwell* v. *Van Vlissengen*, 9 Hare, 415.

(*x*) *Neilson* v. *Betts*, 5 H. L. 1.

(*y*) *Townsend* v. *Haworth*, *ubi supra*.

(*z*) 8 E. & B. 1004, 1023.

(*a*) *Parkes* v. *Stevens*, L. R. 8 Eq. 367; *Winby* v. *Manchester, etc. Co.* 6 R. P. C. 359, 365.

Sect. 29 (4) NOTE.

There is, or may be, in a patent for a combination, an essence or substance of the invention underlying the mere accident of form, and that invention may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination (*b*).

No infringement of the equity of a patent.

Upon this subject, it was observed by Lord CAIRNS, C., in *Dudgeon* v. *Thomson* (*c*): "There is, by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist and yet the thing protected by the specification be taken notwithstanding" (*d*).

"Pith and marrow" taken.

And it might well be that if the instrument patented consisted of twelve different steps producing in the result the improved article, an infringer who took eight or nine of those steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four, or five steps that he might not actually have taken and represented in his machine (*e*). The question in such a case is, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variation or by mechanical equivalent the substance of it, so as to produce the same result by practically the same means?" (*f*)

Mechanical or manufacturing equivalents.

Therefore, where the defendant takes two out of the three parts of a combination, with a colourable variation of the third (*g*), or takes mechanical equivalents for the plaintiff's invention and adds an improvement (*h*), or, while omitting some parts of the plaintiff's

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(*b*) *Per* JAMES, L.J., *Clark* v. *Adie*, L. R. 10 Ch. 675.

(*c*) 3 App. Cas. 34, 44.

(*d*) See also the remarks of the same learned judge on the words "colourable imitation," 3 App. Cas. p. 43.

(*e*) *Per* Lord CAIRNS, C., *Clark* v. *Adie*, 2 App. Cas. 320; *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 456; *Moore* v. *Thomson*, 7 R. P. C. 325, 335; *Jardine* v. *King*, *Mendham*, *etc.* 13 R. P. C. 411.

(*f*) *Per* COTTON, L.J., *Proctor* v *Bennis*, 36 Ch. D. 754. See also *Dudgeon* v. *Thomson*, 3 App. Cas. 34, 43.

(*g*) *Murray* v. *Clayton*, L. R. 7 Ch. 570, 585; *Kaye* v. *Chubb*, 5 R. P. C. 641; *Ticket Punch*, *etc. Co.* v. *Colley's Patents*, 12 R. P. C. 181.

(*h*) *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 454.

machine and adding certain things to it, takes the substance and essence of the plaintiff's combination (*i*), or uses a manufacturing equivalent for a *step* of the process not of the essence of the invention, and takes every other step claimed (*k*), in all these cases there is infringement. But where there is a combination of three things, all of which are essential, it is not an infringement to take two of the elements of the combination and combine them with a new and different element (*l*). Thus, in *Murray* v. *Clayton* (*m*), where the invention was for a brick-making machine, and the claim was in effect for a combination of plate, wires, and movable board, an arrangement consisting of the same elements, but in which the wires were made to move against the clay instead of the clay being pushed against the wires, was held an infringement, and restrained by injunction, while an arrangement in other respects like the patentee's but in which the bricks were transferred by the hand of a workman instead of by the action of the machine, was held to be no breach of the injunction (*n*).

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And again, where, in a patent for fastening boiler tubes into the boiler, the patentee claimed the combination in an expanding tool of a roller, roller stock, and expanding instrument, "operating in combination substantially as set forth," and the rollers were three parallel perfect cylinders, and the expanding instrument a tapering plug placed in the centre of the rollers, it was held by the House of Lords that a tool for the same purpose in which the rollers were tapering cylinders, and the centre part was not a tapering plug, but a cylinder, and the whole was worked not as in the patentee's instrument by pressing out the cylinders against the inner surface of the tube, but by the whole working into the tube as a rotating wedge, was a different combination, and no infringement of the patent (*o*).

In order to constitute an infringement, if the defendant has taken a new and material part of the combination he must also have applied it to a purpose similar or analogous to that which the plaintiff's combination was intended to effect (*p*).

In *Curtis* v. *Platt* (*q*), it was held that if the invention "be nothing more than a particular means to attain to a given result, which is

Curtis v. *Platt*. Particular means to

(*i*) *Proctor* v. *Bennis*, 36 Ch. D. 740, 755; *Incandescent Gas Light Co.* v. *The De Mare Incandescent, etc. Co.* 13 R. P. C. 559.

(*k*) *Benno Jaffé, etc. Fabrik* v. *Richardson*, 11 R. P. C. 93, 261, 273.

(*l*) *Dudgeon* v. *Thomson*, 3 App. Cas. 34, 51, 55.

(*m*) L. R. 7 Ch. 570; 10 Ch. 675 n.

(*n*) See also *Garrard* v. *Edge*, 6 R. P. C. 372, 375, 567.

(*o*) *Dudgeon* v. *Thomson*, *ubi supra*. See also *Nordenfelt* v. *Gardner*, 1 R. P. C. 61.

(*p*) *Lister* v. *Eastwood*, 9 L. T. (N.S.) 766.

(*q*) 3 Ch. D. 135, n.; *per* Lord WESTBURY, C.; 35 L. J. Ch. 852.

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NOTE. produce a known result.

perfectly well known, then you can no more say that the invention of one distinct set of means interferes with the invention of another than you could say, originally, that there ought not to be patents for the invention of distinct means to an end"; and where the patent was for a particular arrangement of old parts whereby one-half of a certain clutch-box was connected with, and acted upon, certain parts of mechanism for effecting changes in the action of a spinning mule, and there had been other patents for that object, it was held that a contrivance for the same object, being an arrangement of the same elements in a different combination, with a different effect on the clutch-box, and with a different result, was not an infringement (*r*).

Narrow construction given to such a patent.

In this case, Lord HATHERLEY, then V.-C., said, "Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect."

Real meaning of *Curtis* v *Platt*.

The case of *Curtis* v. *Platt* has been said to have laid down the principle that where an invention is claimed for improvements in machinery consisting only in a combination, there the patentee must be held to the description which he gives of the particular means by which his invention is to be carried into effect, and that the doctrine of mechanical equivalents cannot apply. The real meaning, however, of that case is, "that where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims, and the mode which he points out of effecting the improvement" (*s*).

And the case of *Curtis* v. *Platt* does not apply to a case where there is not only novelty in the machine, but novelty in the result to be

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(*r*) *Curtis* v. *Platt*, 3 Ch. D. 135, n.; *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 297; *Ticket Punch Register Co.* v. *Colley's Patents*, 12 R. P. C. 1, 171.

(*s*) *Per* COTTON, L.J., *Proctor* v. *Bennis*, 36 Ch. D. 756, 757, 758. See also 764. *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 453. See also *Boyd* v. *Horrocks*, 6 R. P. C. 152; *Jahnoke* v. *Bell*, 9 R. P. C. 94; *Tweedale* v. *Ashworth*, 9 R. P. C. 121; *Nettlefolds* v. *Reynolds*, 9 R. P. C. 270; *Ticket Punch Register Co.* v. *Colley's Patents*, 12 R. P. C. 1; *Brown* v. *Jackson* [1895] A. C. 446.

produced by that machine (*t*). And the rule was not applied in a case where, though the difference between the old mechanical arrangements and those of the plaintiffs was not great, yet the plaintiffs' machine was characterised by greater simplicity and directness of action (*u*). Sect. 29 (4). NOTE.

A claim for a weighing machine, in which an old weighing machine was combined with old coin-receiving mechanism in such a way as to produce a certain specified effect, was held not to be infringed by an apparatus in which the same old machines were combined but in which the coin-receiving mechanism was made to perform a different operation with a different result (*v*).

If the defendants have taken the plaintiff's invention they infringe, even although they may have added to that invention something which is an improvement (*x*). "The superadding of ingenuity to a robbery does not make the operation justifiable" (*y*).

Where the patent was for the use of carbonate of manganese in the process of making steel, and it was not known at the date of the patent that coal tar and black oxide of manganese would be chemical equivalents for the carbonate of manganese, it was held by the House of Lords that the use of coal tar and black oxide of manganese was not an infringement (*z*). Chemical equivalents.

And where a patentee claims the combination of two chemical substances named and specified, he cannot extend the protection of his patent to a combination of other substances than those which he has specified because such other combination may be found to produce a substance having substantially the same qualities and capable of employment in the same way. But there may be cases where a chemical compound patented would protect against the manufacture of the compound in which some one of the ingredients differed where there had been a substitution for one chemical ingredient of that which was known to all chemists to be a mere chemical substitute for the other producing the same reactions, so that any chemist would know that merely to change this particular ingredient and substitute the other would make no real difference in the compound (*a*).

(*t*) *Proctor* v. *Bennis*, 36 Ch. D. 758.

(*u*) *Boyd* v. *Horrocks*, 9 R. P. C. 77.

(*v*) *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 113, 297; 5 Times R. 359.

(*x*) *Ehrlich* v. *Ihlee*, 5 R.P.C. 454; *Hayward* v. *Hamilton*, Griffin, P. C. 115, 124; *Automatic Weighing Machine Co.* v. *National Exhibitions Co.* 8 R. P. C. 345; 9 R. P. C. 41; *Wenham Gas Co.* v. *Champion, etc. Co.* 9 R. P. C. 49, 56; *Proctor* v. *Bennis*, 36 Ch. D. 764 (BOWEN, L.J.).

(*y*) *Wenham Gas Co.* v. *Champion, etc. Co.* 9 R. P. C. 49, 56, judgment of BOWEN, L.J.

(*z*) *Unwin* v. *Heath*, 5 H. L. 545.

(*a*) *Per* Lord HALSBURY, L.C., *Nobel's Explosives Co.* v. *Anderson*, 12 R. P. C. at p. 167. See also *Incandescent Gas Light Co.* v. *Sunlight, etc. Co.* 13 R. P. C. 333.

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NOTE.

Trade secret.

Where a defendant stated that the alleged infringement was his own secret process, PEARSON, J., allowed him to refuse answering questions on cross-examination which might disclose his process, but at the close of the evidence continued the trial *in camerâ* for the purpose of hearing the defendant state his process, which he elected to do. And in giving judgment for the plaintiff his Lordship avoided stating the alleged secret, and ordered the shorthand notes of the proceedings in court where the case was being heard in private to be impounded in court until there should be an appeal or until further order (*b*).

Expert evidence.

The evidence of scientific witnesses is admissible only as proof of facts. It is for them to indicate and elucidate the machinery, and to point out what resemblances there may be in the machinery, and what differences there are, but it is not for them to say one infringes the other, and one is substantially the same as the other, when all the materials are before the court (*c*).

Nor is it for expert witnesses to say what is the nature of the invention; this must be ascertained from the specification the interpretation of which is for the judge and not for any expert (*d*).

But the evidence of experts is legitimate and important in order to inform the court what are and what are not equivalent mechanical devices (*e*), and to explain technical terms, to show the practical working of machinery, and to point out what is old and what is new in the specification (*f*).

And the court may form an opinion from admitted models, which are evidence similar to documentary evidence (*g*); and models being examples of the class of machines in question may, in order to explain counsel's argument, be handed up and looked at, although not in evidence (*h*).

Where expert evidence is explanatory only, and the first witness is not substantially broken down in cross-examination, there is no need to call further expert witnesses (*i*).

For a form of letter of request to a German court to examine witnesses in the trial of an action for infringement of patent, see *Lister* v. *Norton* (*k*).

(*b*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 170.

(*c*) GROVE, J., *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 245; *Seed* v. *Higgins*, 8 H. L. C. 565; *Borill* v. *Smith*, Griffin, L. O. C. 52; *Brooks* v. *Steele*, 14 R. P. C. 73.

(*d*) *Brooks* v. *Steele*, 14 R. P. C. 46, 73.

(*e*) *Ticket Punch Register Co.* v. *Colley's Patents*, 12 R. P. C. 171, 186.

(*f*) *Brooks* v. *Steele*, 14 R. P. C. 46, 73.

(*g*) See cases in previous note (*c*).

(*h*) *Boyd* v. *Horrocks*, 6 R. P. C. 152, 154.

(*i*) *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 113.

(*k*) 2 R. P. C. 135.

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The court looks with suspicion upon evidence which is only brought into existence for the purpose of a cause (*l*), as, for instance, experiments conducted with a view of making evidence for the trial (*m*), or experiments (*n*), or drawings (*o*), made in the course of the trial.

In a chemical case, it is not in the least conclusive against the sufficiency of the directions in the specification that a few experiments, made truly by great chemists, but not by practical manufacturers or workmen, have produced unsatisfactory results. The evidence of those who do succeed is always of more force than the evidence of those who do not succeed. Test tube experiments are not nearly so satisfactory as those on a commercial scale, and a chemical patent dealing with very subtle and delicate reactions is entitled to the benefit of being tested by the results of its working in the hands of persons not merely practised in chemistry generally, but having acquired the necessary familiarity with the processes (*p*).

Shorthand notes of the evidence taken by the solicitor's clerk cannot be referred to in the Court of Appeal (*q*).

A *bonâ fide* agreement by a manufacturer of infringing articles to indemnify a purchaser from him against an action by the patentee is not necessarily void as against public policy (*r*).

SUB-SECTION (5).

Amendment of particulars allowed at any stage.

The court will, at any time during the progress of a patent action, allow the defendant to raise a fresh issue on the discovery of facts which could not, with due diligence, have been discovered before (*s*); and has even permitted a defendant, during the progress of the trial, to give short notice of motion for leave to amend his particulars of objections so as to admit the fresh evidence (*t*).

But if the application is made during the trial, there must be evidence to justify the application to be allowed to give such notice, and it is a sufficient ground for refusing it that it is not shown that the alleged new facts could not, with reasonable diligence, have been discovered earlier (*u*).

(*l*) *Betts* v. *Neilson*, L. R. 3 Ch. 433.

(*m*) *Young* v. *Fernie*, 4 Giff. 609.

(*n*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 576.

(*o*) *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 382, 404, FIELD, J.

(*p*) See *per* WILLS, J., *Badische Anilin und Soda Fabrik* v. *La Société Chimique des Usines du Rhône*, 14 R. P. C. 875, 890, 891.

(*q*) *Ellington* v. *Clark*, 38 Ch. D. 332.

(*r*) *Townsend* v. *Hauworth*, Higgins, pp. 166, 167.

(*s*) *Holste* v. *Robertson*, 4 Ch. D. 9; *Otto* v. *Steel*, 2 R. P. C. 139.

(*t*) *Renard* v. *Levinstein*, 13 W. R. 229; *S.C.* 11 L. T. (N.S.) 505. See also *Daw* v. *Eley*, L. R. 1 Eq. 38; *Allen* v. *Horton*, 10 R. P. C. 412; *Badische Anilin und Soda Fabrik* v. *Société Chimique*, *etc.*, *ubi supra*.

(*u*) *Moss* v. *Malings*, 33 Ch. D. 603. See also *Edison Electric Light Co.* v. *Shippey*, 4 R. P. C. 471.

Sect. 29 (5). NOTE.

The Court of Appeal under Order LVIII., r. 4, may amend particulars of objections after a trial with a view to the introduction of fresh evidence on the appeal (*x*).

Terms on which amendment allowed.

The defendant will, however, have to pay the costs of and occasioned by any such application (*y*). And where a defendant, after amending his objections in compliance with an order to that effect, applied for leave to re-amend by adding certain instances of prior user, leave was granted, but on the terms that the defendant paid the costs of the application, and the additional costs occasioned by the re-amendment were reserved (*z*).

So, also, where a cause was in the paper for hearing, a defendant was allowed, on application after notice to the plaintiff, to adduce evidence by affidavit of prior user discovered after the cause was in the paper, but upon terms ensuring to the plaintiff an opportunity of filing affidavits in answer, the costs of and consequent on the application being reserved (*a*).

In *Edison Telephone Co.* v. *India Rubber Co.* (*b*), where the application was not made till after the day of trial had been fixed, the court gave the plaintiffs a time within which to elect whether they would discontinue the action, and ordered the defendants in the event of discontinuance to pay all costs incurred by the plaintiffs since delivery of the original particulars of objections; and only allowed the objections to be amended in the event of the plaintiffs not electing to discontinue, the defendants being also ordered to pay the costs of the application. And this form of order is the proper order in an ordinary case (*c*).

And the mere fact that the plaintiff was aware that there was such an objection as that now sought to be introduced, though he did not know what the effect of the objection was, is not sufficient to justify a departure from this form of order (*d*).

The order should also provide that the plaintiff should, in any event, have the costs of and consequent upon the amendment being made at this stage of the proceedings (*e*).

(*x*) *Shoe Machinery Co.* v. *Cutlan*, [1896] 1 Ch. 108; *Pirrie* v. *York Street Flax Spinning Co.* 11 R. P. C. 429, 431.

(*y*) *Renard* v. *Levinstein*, *ubi supra*.

(*z*) *Penn* v. *Bibby*, L. R. 1 Eq. 548.

(*a*) *Wilson* v. *Gann*, W. N. 1875, 78.

(*b*) 17 Ch. D. 137, Seton 559, following *Baird* v. *Moule's Earth Closet Co.* (M.R. Feb. 3, 1876), and *Aveling* v. *Maclaren* (C. P. D. Dec. 23, 1880); the two latter orders are printed 17 Ch. D. 139.

(*c*) *Per* CHITTY, J., *Ehrlich* v. *Ihlee*, 4 R. P. C. 115. See also *Parker* v. *Maignen's Filtre Rapide Co.* 5 R. P. C. 207; *Solvo Laundry Supply Co.* v. *Mackie*, 10 R. P. C. 68.

(*d*) *Ehrlich* v. *Ihlee*, *ubi supra*.

(*e*) *Ibid.* The order in this case is printed 4 R. P. C. 118.

Sect. 29 (5).

If the plaintiff states at once that he does not intend to discontinue the action the order will simply provide that the costs of the application and all costs occasioned by the amendment and costs unnecessarily caused to the plaintiff by reason of the amendment being made at the last stage of the proceedings, should be the plaintiff's in any event (*f*).

Note.

But there is nothing in the practice above mentioned to take away from the judge the absolute discretion which he has under the present sub-section of the Act (*g*).

And where in the course of the trial evidence was given of an anticipation not in the particulars of objections, which appeared to destroy the plaintiff's case, and at his request the action was ordered to stand over, an order in the form of *Edison Telephone Co.* v. *India Rubber Co.* was refused (*h*).

Where the court is of opinion that the new objection is on the face of it unsustainable, leave to amend will be refused (*i*).

It is the usual practice, when applying for leave to amend objections, to state the particular amendments which it is desired to make. (See the various cases on amendments cited above).

Under an order for further and better particulars new instances cannot be added without leave (*k*).

On new trial further particulars allowed.

Where a new trial has been directed the defendant will be allowed to bring forward further particulars on which to found, at the new trial, evidence of prior user not given at the first trial (*l*).

A plaintiff has been allowed to amend his statement of claim at the trial, so as to charge as custom-house agents defendants who had been originally sued as importers, but who, as it appeared for the first time on their own evidence, were, in fact, custom-house agents only. The plaintiff, however, was not allowed to adduce fresh evidence, but the defendant had liberty to amend his defence and adduce fresh evidence (*m*).

Sub-section (6).

Costs of particulars.

"Shall not be allowed any costs, etc., unless," etc.—The corresponding section (*n*) of the Act of 1852 provided that in taxing the costs of any action for infringing letters patent regard should be had to the particulars delivered in such action, and that the plaintiff and defendant

(*f*) *Parker* v. *Maignen's Filtre Rapide Co.*, 5 R. P. C. 207.

(*g*) *Woolley* v. *Broad*, [1892] 2 Q. B. 317; 9 R. P. C. 429.

(*h*) *Pascall* v. *Toope*, 7 R. P. C. 125.

(*i*) *Holste* v. *Robertson*, 4 Ch. D. 9.

(*k*) *Aktiebolaget Separator* v. *Dairy Outfit Co.* 13 R. P. C. 725.

(*l*) *Bovill* v. *Goodier*, 36 L. J. (N.S.) Ch. 360.

(*m*) *Nobel's Explosives Co.* v. *Jones*, 42 L. T. (N.S.) 754.

(*n*) Section 43.

Sect. 29 (6). respectively should not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively without regard to the general costs of the cause.

NOTE.

The present sub-section adds the words "to have been reasonable and proper," and alters the requirement of a certificate by "the judge before whom the trial was had" to the requirement of a certificate by "the court or a judge." These alterations, it will be seen, have produced an important change in the practice as to costs of particulars.

Practice under Act of 1852.

The provisions of the Act of 1852 were held to apply only where there had been a trial, and where there was no trial matters were left as if there had been no such enactment; and, therefore, when a plaintiff abandoned his action, after having given notice of trial, the defendant was held entitled to the costs of preparing his particulars of objections and evidence in support of them (*o*). But if there were a trial and the plaintiff was non-suited, it was held at common law that the defendant was not entitled to any costs in respect of his particulars of objections unless the judge certified that they had been proved (*p*). And in a case where the patent was held void the court refused to certify that the plaintiff had proved his particulars of breaches, even though it was of opinion, on the evidence, that the defendant had infringed (*q*).

New practice.

The present sub-section has altered the old practice, and its operation is not limited to cases where the action is brought on for trial and tried (*r*).

In some cases the court, while refusing a certificate, has given liberty to apply as to the costs of the particulars of objections (*s*), or has reserved the question of costs and certificate till the matter has been before the taxing-master (*t*). But the taxing-masters decline to go into the question of the costs of particulars without a certificate (*u*). And it is now settled that the provisions of this sub-section are express and that

If no certificate no costs of particulars

(*o*) *Greares* v. *The Eastern Counties Rail. Co.*, 1 Ell. & Ell. 961; *S. C.* 28 L. J. (N.S.) Q. B. 290; *Batley* v. *Kynock*, L. R. 20 Eq. 632.

(*p*) *Honiball* v. *Bloomer*, 10 Ex. 538; *S. C.* 24 L. J. (N.S.) Ex. 11. As to this case, see observations of BRISTOWE, V.-C., in *Parnell* v. *Mort, Liddell & Co.*, 1 R. P. C. 4, and BOWEN, L.J., *S. C.* on appeal, 29 Ch. D. 329; 2 R. P. C. 60; 33 W. R. 481.

(*q*) *United Telephone Co.* v. *Harrison*, 21 Ch. D. 720.

(*r*) *Middleton* v. *Bradley*, [1895] 2 Ch. 716; *Wilcox and Gibbs* v. *Janes*, [1897] 2 Ch. 71. A contrary view had been expressed in *Rothwell* v. *King*, 4 R. P. C. 397.

(*s*) *Rowcliffe* v. *Longford, etc. Co.* 4 R. P. C. 288.

(*t*) *Mandleberg* v. *Morley*, 11 R. P. C. 1.

(*u*) See *Mandleberg* v. *Morley*, 12 R. P. C. 35; *Middleton* v. *Bradley*, *ubi supra*.

when no certificate has been given the costs of particulars cannot be allowed (*x*). Sect. 29 (6).

NOTE.

And this rule was held to apply even when in an action to restrain infringement of a patent and the issue of certain circulars, the plaintiff after the defendant had delivered defence and particulars of objections amended his statement of claim, and abandoned the case as to infringement and subsequently discontinued the whole action (*y*).

But when the plaintiff after the close of the pleadings applied for leave to discontinue, he was only allowed to do so on paying the costs of objections as if the same had been certified to be reasonable and proper (*z*).

When plaintiff's case fails.

If the case of the plaintiff fails on any one point, the general rule is that the court will not go into the other objections merely for the purpose of seeing whether a certificate under this sub-section shall be given (*a*).

Thus, where the action failed by reason of the invalidity of the patent being proved by one of the plaintiff's witnesses, and judgment was given for the defendants without their being called on for their defence, it was held, under this present sub-section, by STIRLING, J., that the judge must be satisfied, having regard to the knowledge he had acquired in the conduct of the case, that the particulars were reasonable and proper, and that it was not his duty either to put himself back into the position in which the advisers of the defendants were when they framed the particulars of objections, or, on the other hand, to carry himself forward by having additional evidence brought before him. And a certificate was accordingly granted to the defendants in respect of certain particulars of objections specified by the judge; but, inasmuch as the plaintiffs were held not entitled to costs at all, a certificate that they had proved their particulars of breaches was refused (*b*).

In the *Albo-Carbon Light Co.* v. *Kidd* (*c*), where the defendants succeeded on an objection as to subject-matter without being called upon, a certificate that they had proved their objections was granted, not extending, however, to those objections which it was for them to prove and which they had not proved. And, in a similar case, the court refused to certify that the defendant's objections, which he had

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(*x*) *Longbottom* v. *Shaw*, 43 Ch. D. 46; *Middleton* v. *Bradley*, [1895] 2 Ch. 716.

(*y*) *Middleton* v. *Bradley*, *ubi supra*.

(*z*) *Boake, Roberts & Co.* v. *Stevenson*, 12 R. P. C. 228; *Bethell* v. *Gage*, 14 R. P. C. 699.

(*a*) *Boyd* v. *Horrocks*, 6 R. P. C. 152; *Longbottom* v. *Shaw*, 6 R. P. C. 143, 147; *Newsum* v. *Mann*, 7 R. P. C. 310; *Dairy* v. *Bailey*, 8 R. P. C. 166.

(*b*) *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 254.

(*c*) 4 R. P. C. 535.

Sect. 29 (6). NOTE.

no opportunity of proving, were reasonable and proper, upon the ground that, for the present, the judgment of the court must be assumed to be right; and in that case the objections were unnecessary (*d*).

And when the plaintiff, on the action coming on for trial, submitted to have it dismissed with costs, without the case being heard, it was held that no certificate that the defendant's objections were reasonable and proper could be given (*e*).

There may, however, be cases where the matter is decided against the plaintiff without calling on the defendant's counsel, and yet the court, relying upon the evidence obtained by the defendant in cross-examining the plaintiff's witnesses, may think it right to look at the particulars of objections and allow the costs of such particulars of objections as were in fact made out by the cross-examination (*f*).

Thus, where a patent was held bad on evidence of prior user of an article put to the plaintiff in cross-examination, which evidence the defendant was allowed to give at once without waiting for the close of the plaintiff's case, a certificate was given to the defendant that his particulars of objections were reasonable and proper, limited, however to the anticipation put to the plaintiff in cross-examination (*g*).

And the costs of particulars of prior user, useful as showing the state of knowledge at the date of the patent, were allowed, although the patentee's case broke down on the point of subject-matter (*h*).

Action discontinued.

And even when there has been no trial and the action has been discontinued, it may be that there has been a motion on which evidence may have been given which would give the court materials for determining whether the particulars of objection were reasonable, or it may be that there has been some other interlocutory application, perhaps with reference to the particulars themselves, upon which the court may have had an opportunity of forming an opinion on the subject (*i*).

But if the action is discontinued before the close of the pleadings, and there is no evidence before the court as to the nature of the patent, the court cannot go into the case merely to see whether a certificate can be given that the particulars of objections are reasonable and proper (*k*).

(*d*) *Longbottom* v. *Shaw*, 5 R. P. C. 497; 6 R. P. C. 147. See also *Oddy* v. *Smith*, 5 R. P. C. 503; *Boyd* v. *Horrocks*, 6 R. P. C. 152, 162; *Fairfax* v. *Lyons*, 8 R. P. C. 401, 410.

(*e*) *Mandleberg* v. *Morley*, 12 R. P. C. 35.

(*f*) *Per* KAY, J., *Longbottom* v. *Shaw*, 43 Ch. D. 46, 51.

(*g*) *Badham* v. *Bird*, 5 R. P. C. 238; and see *Griffin* v. *Fearer*, 6 R. P. C. 396; *Phillips* v. *Ivel Cycle Co.*, 7 R. P. C. 77; *Dairy* v. *Bailey*, 8 R. P. C. 166; *Nuttall* v. *Hargreaves*, 8 R. P. C. 273, 276; *Heyes* v. *Hallmark*, 9 R. P. C. 25.

(*h*) *Dege's Patent*, 12 R. P. C. 448. See also *Nobel's Explosives Co.* v. *Anderson*, 11 R. P. C. 115, 128.

(*i*) *Per* STIRLING, J., *Middleton* v. *Bradley*, [1895] 2 Ch. 716, 718. And see *Brooks* v. *Steele*, 14 R. P. C. 46 (stated *post*, p. 230).

(*k*) *Wilcox and Gibbs* v. *Janes*, [1897] 2 Ch. 71.

Sect. 29 (6).

NOTE.

Where an action for infringement was dismissed on the ground of non-infringement, the court not deciding the question of validity of the patent, and no certificate under this sub-section was given to the defendant, it was held that the plaintiff could not, under Order lxv. r. 27, sub-r. 20, have his costs of meeting the defendant's objections on the ground that they were "improper, vexatious, or unnecessary." In such a case the plaintiff ought to ask the court to direct the taxing-master to see whether the proceedings have been "improper, etc.," and to order that the plaintiff shall have the costs of such improper proceedings (*l*).

Costs of vexatious proceedings.

Where certain specifications and prior users were mentioned in the objections, but not insisted on, or not considered material at the trial, a certificate as to these was refused (*m*). And in *Singer* v. *Rudge Cycle Co.* (*n*), the certificate that the defendant had proved his objections as to want of novelty was accompanied by an expression of the opinion of the court that he was not, in the costs of the particulars of objections, to have the costs of specifications other than those actually used at the trial.

Unnecessary matters in particulars.

And where the particulars alleged four breaches, and only three were proved at the trial, the certificate was confined to the breaches actually proved (*o*).

Costs of *specifications* put in evidence.

The costs of all specifications put in evidence may be allowed, not merely those which were proved to be anticipations (*p*).

So, also, where prior specifications were put in evidence, and were of assistance to the court, the costs were allowed to the defendant, although in the result the court only found non-infringement, and gave no opinion as to the validity of the patent (*q*).

But where the patent is upheld, the mere fact that some of the objections have compelled the court to put a narrow construction on the specification, and to hold that there is no infringement, will not enable the court to give the defendant the costs of these objections (*r*).

Certificate by Court of Appeal.

The Court of Appeal is not the judge pointed at by this section, but where the judgment of the court below is reversed the Court of Appeal will make such an order as the judge who heard the case ought

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(*l*) *Garrard* v. *Edge*, 44 Ch. D. 224, 235.

(*m*) *Lawrence* v. *Perry*, 2 R. P. C. 179. See also *Pooley* v. *Pointon*, 2 R. P. C. 167; *Binnington* v. *Hill*, 8 R. P. C. 326; *Fairfax* v. *Lyons*, 8 R. P. C. 401, 410.

(*n*) 11 R. P. C. 585.

(*o*) *Cole* v. *Saqui*, 5 R. P. C. 489.

(*p*) *Crosthwaite* v. *Moorwood*, 11 R. P. C. 555, 562.

(*q*) *Nettlefolds* v. *Reynolds*, 9 R. P. C. 270, 290. See also *Jardine* v. *King Mendham & Co.*, 13 R. P. C. 411.

(*r*) *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 342, 360.

Sect. 29 (6). to have made, and therefore will, when proper, certify under this section (*s*). So, also, the certificate may be granted by the House of Lords (*t*).

NOTE.

Thus, where the action was dismissed in the court below, without hearing the defendant's evidence, on the ground that the alleged invention was not subject-matter for a patent, and the Court of Appeal, after hearing the defendant's evidence, affirmed the decision; the Court of Appeal gave a certificate that all the objections were reasonable and proper (*u*).

And when the court below had upheld the patent, and granted an injunction, and the decision was reversed in the Court of Appeal, on the ground that the patent was invalid, the Court of Appeal granted a certificate that the particulars of objections were proven, or were reasonable and proper (*x*).

Where the decisions of the judge of first instance and of the Court of Appeal, both of which upheld the patent, were reversed by the House of Lords, a certificate that certain of the objections were reasonable and proper was, on the application of the defendant, given by the judge who tried the case (*y*).

"**Reasonable and proper.**"—It is not necessary that the particulars should be proved, or could have been proved. The judge need only certify that they are reasonable and proper (*z*).

When the court of first instance dismissed the action, and gave a certificate that the objections were reasonable and proper, and the Court of Appeal held the second claim of the specification good but that the patent was invalid because the first claim was too wide, it was held, that as it could not have been said that the particulars would have been unreasonable if the specification had contained only the first claim, the certificate of the judge below was right, and the appeal was dismissed with costs (*a*).

When a plaintiff by his statement of claim alleged infringement of six patents, and defendants put in particulars of objections to them all, and the plaintiff subsequently abandoned his case as to three patents, and the defendants succeeded in the action, a certificate that the

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(*s*) *Cole* v. *Saqui*, 40 Ch. D. 132; *Humpherson* v. *Syer*, 4 R. P. C. 407, 416. See also *Shoe Machinery Co.* v. *Cutlan*, [1896] 1 Ch. 108.

(*t*) *Morris* v. *Young*, 12 R. P. C. 455, 465.

(*u*) *Deutsche Nähmaschinen Fabrik* v. *Pfaff*, 7 R. P. C. 251, 257.

(*x*) *Cole* v. *Saqui*, 40 Ch. D. 132; *Humpherson* v. *Syer*, 4 R. P. C. 407, 416.

(*y*) *Morgan* v. *Windover*, 7 R.P.C. 446.

(*z*) *Phillips* v. *Ivel Cycle Co.* 7 R. P. C. 77, 84; *Heyes* v. *Hallmark*, 9 R. P. C. 25.

(*a*) *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 303.

objections to all the patents were reasonable and proper was given, except as to certain particulars relating to the contested patents which had not been urged at the trial. And it was held that the abandonment by the plaintiff of part of his case ought not to operate to deprive the defendants of any costs properly incurred by them in resisting the claim as originally made (*b*). Sect. 29 (6). NOTE.

When an important objection, on which the defendant succeeded, was only added during the trial, the action was dismissed without costs, and a certificate under this section was refused (*c*).

Section 43 of the Act of 1852 applied only to the courts of common law, which had no discretion as to costs, but the Court of Chancery had always such a discretion, and was, therefore, not bound to follow that section, and the Acts which gave common law jurisdiction to the Court of Chancery were not intended to fetter this discretion (*d*). Costs irrespective of certificate.

And, accordingly, in the Court of Chancery costs were given irrespective of any certificate under the above section (*e*); and in a case in the Court of the County Palatine of Lancaster, where the Vice-Chancellor had virtually non-suited the plaintiff, the costs of the defendants' particulars of objections were allowed, though no certificate was asked or given (*f*).

But since the Judicature Acts, the judges of the Common Law Division, as well as the judges of the Chancery Division, have an absolute discretion as to costs, and there is nothing to exclude any particular actions from that discretion (*g*), and it will be seen that in both divisions costs have been given in patent actions without reference to any certificate of proof of the particulars.

And now, subject to the Judicature Acts, and rules of court thereunder, and to the express provisions of any statute, the costs of and incident to all proceedings in the Supreme Court are in the discretion of the court or judge, and a judge has full power to determine by whom and to what extent such costs shall be paid (*h*).

By S. C. R. 1883, Order lxv. r. 2, it is provided that where issues of fact and law are raised upon a claim or counter-claim, the costs of the

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(*b*) *Brooks* v. *Steele*, 14 R. P. C. 46, 72.

(*c*) *Allen* v. *Horton*, 10 R. P. C. 412.

(*d*) *Parnell* v. *Mort Liddell and Co.* 29 Ch. D. 325, 329. See also *Garnett* v. *Bradley*, 3 App. Cas. 944.

(*e*) See Seton, p. 565; Pemberton, 484.

(*f*) *Parnell* v. *Mort Liddell and Co.*, *ubi supra*.

(*g*) S. C. R. 1883, Order LXV. r. 1, extending Order LV. r. 1 of 1875. BOWEN, L.J. *Parnell* v. *Mort Liddell and Co.*, *ubi supra*.

(*h*) 53 & 54 Vict. c. 44, s. 5.

Sect. 29 (6). several issues both in law and fact shall, unless otherwise ordered, follow the event.

NOTE.

Apportionment of costs of separate issues.

There are several cases, some before the enactment of the last-mentioned rule, in which the court has dealt with the costs of patent actions according to the result of the issues. Thus, where a plaintiff succeeded on the issue as to validity of the patent, but failed as to infringement, the costs were apportioned (*i*). In a similar case, the Court of Appeal gave the defendants the general costs of the trial and appeal, but, as to the suggested want of novelty in the plaintiff's invention, gave no costs on either side (*k*). In another like case the action was dismissed with costs, but the Court of Appeal directed that the plaintiff should be allowed any costs which he had incurred by reason of the pleas of want of novelty beyond what he would have incurred if those pleas had not been put on the record (*l*).

The court has also given one party the costs of the issue of validity, and the other those of the issue of infringement, giving no general costs of the action to either party (*m*).

And where, the plaintiff having succeeded on the validity of the patent but having failed on the question of infringement, the court gave the defendant the general costs of the action, the defendant has nevertheless been ordered to pay the costs of his particulars of objections (*n*).

Where the plaintiff sued on two patents, and there were various findings on the different claims in the respective patents, the ultimate result being in favour of the plaintiff on the validity of the patents, but in favour of the defendants on the question of infringement, it was ordered that the costs should abide the event of the several findings, and that, save as aforesaid, the defendants should have their costs of suit from the plaintiff (*o*).

But in *Boyd* v. *Horrocks* (*p*), when the court of first instance had held in favour of the plaintiff, both on the question of validity of the patent and infringement, and the Court of Appeal, without going into the question of validity, reversed the judgment as to infringement, with costs, and gave liberty to the defendants to apply for repayment of a

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(*i*) *Simmonds* v. *Hitchman*, 29 Ch. D. 417, n.; Eng. Rep. Jan. to Mar. 1881, p. xvi. See the order in the Appendix, *post*.

(*k*) *Needham* v. *Johnson*, 1 R.P.C. 49, 59.

(*l*) *Nordenfelt* v. *Gardner*, 1 R. P. C. 61.

(*m*) *Scott* v. *Hamling*, 14 R. P. C. 123.

(*n*) *Sunlight Incandescent Co.* v. *Incandescent Gas Light Co.* 14 R. P. C. 757, 776.

(*o*) *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 229, 254. See also *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 113, 120, 297; *Tweedale* v. *Ashworth*, 7 R. P. C. 426.

(*p*) 6 R. P. C. 528.

sum of costs which they had paid into court pending the appeal, it was held by the Vice-Chancellor of the County Palatine of Lancaster that, as the defendants had done no wrong at all, there ought not to be any apportionment of costs. Sect. 29 (6). NOTE.

In the foregoing cases the plaintiff succeeded in establishing the validity of his patent, but the principle of apportionment of costs has been applied also where the defendant succeeds on this issue, and fails on that of infringement. Apportionment of costs where patent invalid.

Thus, in *Wegmann* v. *Corcoran* (*q*), where, in an action for alleged infringement of two patents, the defendants denied the validity of both patents upon the usual grounds, and also denied infringement, and at the trial the plaintiffs abandoned the action entirely as to one patent, and the defendants only argued on the other patent the question of insufficiency of specification, on which they succeeded, and the action was dismissed with general costs of action, it was held, under the Act of 1852, that the defendants were to have from the plaintiffs their costs of the particulars of objections and particulars of breaches in the case of the patent on which the action was abandoned, and that the plaintiffs should have from the defendants the costs of the particulars of breaches of the other patent (*q*).

Where the plaintiffs sued on two patents and succeeded as to one only, the action was dismissed with costs as to one patent, and an injunction was granted with costs as to the other (*r*).

Where the jury found that the defendants had infringed, but that the invention was neither new nor useful, judgment was given for the defendants, with the general costs of the action, and it was held that the plaintiffs were entitled to a certificate that they had proved their particulars of breaches, but (apparently on account of certain special circumstances in the case) so as to entitle them only to the costs of delivering such particulars and subpœnaing the witnesses in support thereof; and the defendants were held entitled to a certificate that they had proved their objections except in regard to certain matters specified (*s*).

The general question was considered, since the present Act, by the Court of Appeal in the *Badische Anilin und Soda Fabrik* v. *Levinstein* (*t*), where the action was tried in 1883, and was therefore under the Act of 1852. In that case it was said that the rule adopted General rule as to apportionment of costs.

(*q*) 27 W. R. 357, 362.

(*r*) *United Telephone Co.* v. *Harrison*, 21 Ch. D. 747. See also *Hocking* v. *Fraser*, 3 R. P. C. 7; *Edison, etc. Co.* v. *Woodhouse* (first action), 3 R. P. C. 167. *Shrewsbury, etc. Co.* v. *Sterckx*, 12 R. P. C. 336, 342.

(*s*) *Young* v. *Rosenthal*, 1 R. P. C. 29, 41.

(*t*) 29 Ch. D. 366, 418.

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in *Wegmann* v. *Corcoran* (cited above), was in accordance with the provisions of the present Act, and it was held that without laying down any hard and fast line, or fettering the discretion of the Court of Appeal or other the judges in other cases, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong, was a sound principle to act upon, and the result of the action being that the patent was invalid, but that the defendant was held to have infringed, it was ordered that the defendant should pay to the plaintiffs the costs occasioned by the issues raised by the particulars of breaches, but that the plaintiffs should pay to the defendant all the other costs of the action, and there should be a set-off in respect of costs (*u*).

And when at the trial the defendant admitted infringement, though he had pleaded non-infringement, and the court found against the patent, the costs were not apportioned (*v*).

And in *Pooley* v. *Pointon* (*x*), where the patent was held void, but the plaintiff succeeded on the issue as to infringement, the plaintiff was held entitled not only to the costs of the latter issue, but also to the costs of an objection that the plaintiff was not the inventor, which was not the objection on which the patent was invalidated.

When in a threats action under s. 32 the plaintiff pleaded non-infringement and invalidity of the defendants' patent and at the trial gave up the latter issue and the jury found that he had not infringed and an injunction was granted, the costs of the issue of validity were allowed to the defendants, the general costs of the action being given to the plaintiff (*y*).

And in *Lister* v. *Norton* (*z*), where the patent was held invalid on the ground of prior user, but the defendants had alleged want of subject-matter, insufficiency of the specification, and that plaintiff was not first and true inventor, and had also impeached the validity of the patent on a legal point, on all of which grounds they failed, the costs of all these issues were given to the plaintiff. And in the same case when infringement was admitted but not till a late stage of the action, it was held that the plaintiff was to have the costs of the issue of infringement up to the date of the admission.

(*u*) The order made is set out in 29 Ch. D. p. 420. As to proper form of order when costs are apportioned, see *Shoe Machinery Co.* v. *Cutlan* (No. 2), 13 R. P. C. 395.

(*v*) *Westley Richards* v. *Perkes*, 10 R. P. C. 181, 194.

(*x*) 2 R. P. C. 167. See also *Laurie* v. *Baker*, 2 R. P. C. 213; *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 113, 120; *Phillips* v. *Ivel Cycle Co.* 7 R. P. C. 77; *Binnington* v. *Hill*, 8 R. P. C. 326; *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Sydicate*, 11 R. P. C. 638.

(*y*) *Ungar* v. *Sugg*, 6 R. P. C. 337.

(*z*) 3 R. P. C. 199, 211.

But this course is not always followed; and where the patent is held invalid, the court has refused to apportion the costs (*a*).

NOTE.

Costs not always apportioned.

Sometimes, where it appears that if the costs are apportioned one party would have to pay as much as he would be entitled to receive, the court, in order to avoid a troublesome and difficult apportionment of costs on taxation, will cut the knot by giving no costs to either party (*b*).

And in *Monnet* v. *Beck* (*c*), where the defendants, though succeeding in the action, had raised certain issues on which they had failed, the court directed the taxation of costs to proceed as if the defendants had succeeded on everything, and gave the defendants two-thirds of the sum so arrived at.

Where the Court of Appeal had held the patent bad, and also that there was no infringement, and on appeal to the House of Lords the patent was held to be valid, but the judgment as to infringement was affirmed, the appeal was dismissed; but as the plaintiff had obtained an important result in his favour, no costs of the appeal were given (*d*).

The costs of particular issues allowed to any party include the costs of appeal as well as the costs in the court below (*e*).

"Certified by the court or a judge."—See notes under s. 31, *post*.

The certificate under this sub-section, if not applied for at the trial, may be given on an application made within a reasonable time afterwards (*f*).

It seems that the certificate cannot be given on the trial of a petition for revocation of a patent (*g*).

"General costs of the case."—The rule as to costs has thus been stated by JESSEL, M.R.:—"Where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, no omission or neglect which would induce the court to deprive him of his costs, the court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts; for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or an oppressive or vexatious mode of conducting the

General rule as to costs.

(*a*) *Edison, etc. Co.* v. *Holland*, 5 R. P. C. 459, 483; *Blakey* v. *Latham*, 6 R. P. C. 38, 186, 190; *Kaye* v. *Chubb*, 4 R. P. C. 289, 303.

(*b*) *Sugg* v. *Bray*, 2 R. P. C. 223, 248.

(*c*) 14 R. P. C. 777, 852.

(*d*) *Moore* v. *Bennett*, 1 R. P. C. 129.

(*e*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 29 Ch. D. 366, 420.

(*f*) *Rowcliffe* v. *Morris*, 3 R. P. C. 147.

(*g*) *Re Gaulard and Gibbs' Patent*, 5 R. P. C. 525, 537.

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proceedings, or other misconduct which will induce the court to refuse costs ; but where there is nothing of the kind, the rule is plain and well settled, and is as I have stated it" (*h*).

No ground for refusing costs that defendant acted in ignorance, or had no notice of intended proceedings.

Thus, it is no ground for refusing the plaintiff his costs that the defendant acted in ignorance of the plaintiff's rights (*i*), or never intended to do wrong (*k*). Nor will the plaintiff be refused costs because, before suing, he made no application to the defendant (*l*). It has never been laid down that a plaintiff entitled to relief must, before commencing proceedings, apply to the defendant, and ascertain previously whether he will without suit do all that is required (*m*).

When defendant offers to submit.

Sometimes a person infringing a patent will, on complaint being made, offer to discontinue the infringement, and account for the profits he has made. A question then arises as to whether the patentee is bound to accept this promise, or is entitled to take proceedings for an injunction.

In *Losh* v. *Hague* (*n*), SHADWELL, V.-C., said :—"I do not think it enough on a question of injunction for the defendant to say why he has done the thing complained of, but will not do it again. That is not the point, because if a threat had been used, and the defendant revokes the threat, that I can understand as making the plaintiff satisfied ; but if once the thing complained of has been done, I apprehend this court interferes, notwithstanding any promise the defendant may make not to offend again."

And in *Geary* v. *Norton* (*o*), Sir J. L. KNIGHT-BRUCE, V.-C., asked "whether it had ever been decided where a right of this kind had been invaded, and the invading party says he is doing wrong and will do so no more, that the party complaining is barred as to his costs on filing a bill to have the protection of an injunction rather than the promise of the person." And in that case, where the defendant had before bill filed merely promised not to repeat the infringement, the plaintiff was held entitled to his costs of suit.

(*h*) *Cooper* v. *Whittingham*, 15 Ch. D. 504. See also *Edelsten* v. *Edelsten*, 1 D. J. & S. 185, 204.

(*i*) *Burgess* v. *Hills*, 26 Ben. 244 ; *Collins' Co.* v. *Walker*, 7 W. R. 222 ; *Cooper* v. *Whittingham*, 15 Ch. D. 505 ; *Upmann* v. *Forrester*, 24 Ch. D. 231.

(*k*) *Cooper* v. *Whittingham*, 15 Ch. D. 507. See also *Davenport* v. *Rylands*, L. R. 1 Eq. 303.

(*l*) *Burgess* v. *Hatcley*, 26 Ben. 249 ; *Upmann* v. *Forrester*, 24 Ch. D. 231 ; *Wittman* v. *Oppenheim*, 27 Ch. D. 260.

(*m*) *Per* LORD ROMILLY, M.R., *Upmann* v. *Elkan*, L. R. 12 Eq. 146 ; *Cooper* v. *Whittingham*, 15 Ch. D. 505 ; *Upmann* v. *Forrester*, 24 Ch. D. 236 ; *Fennessy* v. *Day*, 55 L. T. (N.S.) 161.

(*n*) 1 Webst. P. C. 200.

(*o*) 1 De G. & Sm. 9. And see remarks of COTTON, L.J. on this case, *Proctor* v. *Bayley*, 42 Ch. D. 390, 400.

And when defendants, before suit, offered to remove certain parts of the machine which were alleged to be infringements, but did not offer to undertake never to use them again, it was held that the offer was insufficient, and that plaintiffs were entitled to the protection of an injunction, and that defendants must pay the costs of the action (*p*).

But an injunction ought not to be granted when the defendant has discontinued the wrongful acts and there is no ground to apprehend that they will be repeated. And, therefore, where infringing machines had been used by the defendants, but had been taken down and disused five years, and removed from defendants' premises three years before the action, and there was no ground for inferring an intention to continue the use, it was held in an action for infringement, and notwithstanding that the defendants denied that they had infringed, that the plaintiffs were not entitled to an injunction (*q*).

And in *Scott* v. *Hull Steam Fishing, etc. Co.* (*r*), where the court held that there was no further intention to use the invention, nominal damages were given with liberty to apply for an injunction if necessary. And where the infringement was small and the defendants offered to give an undertaking not to infringe, the injunction was refused (*s*).

What costs innocent infringer must pay.

In *Upmann* v. *Elkan* (*t*), a trade mark case, Lord ROMILLY, M.R., said that "a party using a forged trade mark, though innocently, is liable for the costs of setting that right up to the time when he first knew of the forgery; but if, after that time, he stops, and is willing to undertake not to go any further with the use of the mark, he is not liable for further costs." And again, "It is his duty at once to give the plaintiff all the information required, and to undertake that the goods shall not be removed or dealt with till the spurious brand has been removed, and to offer facilities for that purpose. If, after that, the person injured file a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit he will not get from such defendants the costs of the suit, and he may have to pay them."

A plaintiff was not, under the old Chancery practice, bound to accept the defendant's affidavit as to the profits made by him, and had a right to an answer from the defendant, and might have his costs up to and including the answer (*u*).

(*p*) *United Telephone Co.* v. *London and Globe Telephone Co.*, 1 R. P. C. 117.

(*q*) *Proctor* v. *Bayley*, 42 Ch. D. 390; *Leahy* v. *Glover*, 10 R. P. C. 141 (H. L.).

(*r*) 14 R. P. C. 143.

(*s*) *Jenkins* v. *Hope*, 13 R. P. C. 57.

(*t*) L. R. 12 Eq. 144, 145; affirmed L. R. 7 Ch. 131. See also *Wittman* v. *Oppenheim*, 27 Ch. D. 260.

(*u*) *Colburn* v. *Simms*, 2 Ha. 543.

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And a plaintiff is also entitled in strictness to an account of profits at the hearing of the cause, though if the court thinks the conduct of the plaintiff has been oppressive, it will only give such an account at the plaintiff's peril (*x*).

And the plaintiff may have his costs, even though the injunction is submitted to, and the plaintiff waives the account at the hearing (*y*).

But if plaintiff's conduct oppressive or improper, he may be refused costs.

But where a defendant who had in ignorance infringed the plaintiff's patent offered before suit to discontinue the infringement, and to pay the amount of profits made, and to sell the stock to the plaintiff or to take it to pieces, and the plaintiff insisted on taking the account and on the destruction of the stock in hand, and a signed apology, and, on this being refused, instituted a suit for injunction and account, the court, although the defendant submitted at the hearing to a perpetual injunction, gave the plaintiff no costs (*z*)

In a trade libel case where the plaintiff obtained only nominal damages he was ordered to pay the costs of the action (*a*).

If, after the commencement of the action, the defendant offers to submit to all the relief to which the plaintiff is entitled, the plaintiff will not have the costs of the subsequent prosecution of the suit (*b*).

And in a trade mark case where the defendant, who had innocently infringed, offered immediately after service of the writ in an action brought without previous notice an undertaking in terms of the indorsement on the writ, and to withdraw the goods marked with the spurious mark from sale, and the plaintiff nevertheless moved for an injunction, it was held that the motion was unnecessary, the undertaking being as good as an injunction, but that the plaintiff was entitled to a small sum for costs, *e.g.*, for the costs of the writ, and 5*l.* only was allowed him for costs (*c*).

Where defendant was a retailer who had innocently bought a small quantity of cigarettes made by a third person, and marked with a close imitation of the plaintiffs' trade mark, and the plaintiffs without previous notice brought an action for infringement, and the defendant thereupon returned the spurious goods to the makers, and submitted to any order the court might make, but contended that he ought not to pay costs, it was held that the defendant was not bound to pay costs (*d*).

(*x*) *Nunn* v. *D'Albuquerque*, 34 Bea. 595.

(*y*) *Burgess* v. *Hateley*, 26 Bea. 249; *Burgess* v. *Hills*, 26 Bea. 244; *Upmann* v. *Forrester*, 24 Ch. D. 236.

(*z*) *Nunn* v. *D'Albuquerque*, 34 Bea. 595. See also *Hudson* v. *Bennett*, 14 W. R. 911; *Smith* v. *Roberts*, 5 R. P. C. 611.

(*a*) *Dicks* v. *Brooks*, 15 Ch. D. 41.

(*b*) *Colburn* v. *Simms*, 2 Ha. 543.

(*c*) *Carnuchо* v. *Highmore*, L. J. No. Cas. 1883, p. 15.

(*d*) *American Tobacco Co.* v. *Guest*, [1892] 1 Ch. 630.

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NOTE.

And where the allegation of infringement failed, the circumstance that the defendant had before action infringed the patent, but had discontinued that infringement, was held (the defendant offering to pay what was reasonable in respect of the former infringement) to be no reason for not making the plaintiffs pay the costs of the action (*e*).

And may be made to pay costs.

Where, on an appeal to the House of Lords, the respondent continued the appeal after the appellant had offered to give him all to which he was entitled, the respondent, though successful, was ordered to pay the costs of the appeal subsequent to the date of the offer (*f*).

And in a designs case the court, considering that some very unscrupulous evidence had been given on the part of the plaintiffs, who succeeded in the action, only gave the plaintiffs two-thirds of their taxed costs (*g*).

And when before action on a patent which had been upheld in a previous action the defendant offered to give any proper undertaking not to infringe the patent, and the plaintiff nevertheless moved for an injunction, it was held that the motion was unnecessary, and, on the defendants undertaking not to use the machine until trial or further order, the costs of the motion were ordered to be paid by the plaintiff (*h*).

And if the defendant offers to submit to an injunction to be obtained by summons in chambers, and the plaintiff moves for an injunction and succeeds, the costs payable by the defendant may be limited to what they would have been if the application had been made for an order by consent in chambers (*i*).

What defendant should do to avoid costs.

But the defendant, in order to avoid costs, must offer to pay the plaintiff's costs of suit already incurred or the plaintiff may bring the cause to a hearing, and the defendant will then have to pay the costs (*k*), —*à fortiori* if the defendant has actually refused to pay costs (*l*).

Where a defendant who has before suit promised not to infringe again raises after suit objections to the patent, which he afterwards abandons, he may be refused his costs, although the court dismisses the bill (*m*).

(*e*) *Fletcher* v. *Glasgow Gas Commissioners*, 4 R. P. C. 386, a Scotch case.

(*f*) *De Vitre* v. *Betts*, L. R. 6 H. L. 319, 326.

(*g*) *Sherwood* v. *Decorative Tile Co.*, 4 R. P. C. 207.

(*h*) *Lyon* v. *The Mayor, etc. of Newcastle-on-Tyne*, 11 R. P. C. 218; *Snuggs* v. *Seyd, etc. Co.*, [1894] W. N. 95.

(*i*) *Slazenger* v. *Pigott*, 12 R.P.C. 439.

(*k*) *Burgess* v. *Hately*, 26 Bea. 249; *Fradella* v. *Weller*, 2 R. & M. 247; *Geary* v. *Norton*, 1 De G. & Sm. 9, 12.

(*l*) *Burgess* v. *Hills*, 26 Bea. 248.

(*m*) *Betts* v. *Willmott*, 18 W. R. 946.

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NOTE.

A person charged with infringement who desires to submit before suit ought to offer to pay the plaintiff's costs of consulting his solicitor (*n*).

Defendant bankrupt, trustees defending, and failing.

Where a defendant became bankrupt after the commencement of proceedings, and then delivered a defence, but did not appear at the trial, and his trustees in bankruptcy were made defendants, and an account of profits was asked against them, though there was no allegation that they had manufactured, and the trustees put in no defence, but appeared at the trial and objected that the amount to be found under the account was not proveable in the bankruptcy, and cross-examined witnesses in order to show no infringement, it was held that the plaintiff succeeding in the action, the trustees must pay the costs (*o*).

Directors of company.

The directors of a limited company may be made personally liable to the costs of an action against the company to restrain infringement of a patent, even though they may show that the acts complained of were done by workmen contrary to orders (*p*).

Married woman.

In the case of a married woman ordered to pay costs, the costs were ordered to be paid out of her separate property and not otherwise, with liberty to apply for payment out of any property subject to a restraint on anticipation (*q*).

It seems that the court will not make an order for costs when it is probable that proceedings in the cause may afterwards take place which will affect the decision of the court upon the question of costs, and therefore when a bill to restrain infringement of a patent was, under the old chancery practice, retained at the hearing, to give the plaintiff an opportunity of trying the right at law, the court refused to make an order as to the costs of the evidence which had been adduced, and which costs were claimed by the plaintiff on the ground that the defendant had not required him to establish his title at law before the hearing (*r*).

When defendant succeeded on an objection to the patent introduced only by amendment at the trial the action was dismissed without costs (*s*).

(*n*) *Nunn* v. *D'Albuquerque*, 34 Bea. 596.

(*o*) *Watson* v. *Holliday*, 20 Ch. D. 780; affirmed, 31 W. R. 536.

(*p*) *Betts* v. *De Vitre*, 11 Jur. (N.S.) 9; affirmed, L. R. 3 Ch. 429, 442; 6 H. L. 319. See as to this *Att.-Gen.* v. *Vestry of Bermondsey*, 23 Ch. D. 60; *Mathias* v. *Yetts*, 46 L. T. 497.

(*q*) *Savage* v. *Harris*, 13 R. P. C. 364, 375.

(*r*) *Ward* v. *Key*, 10 Jur. 792.

(*s*) *Allen* v. *Horton*, 10 R. P. C. 412, 416.

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NOTE.

Lien for costs.

In a trade mark case the plaintiff has been held entitled to a lien for his costs on the goods complained of (*t*). But this decision has since been questioned (*u*).

Action due to mistake of judge.

Where the prosecution of an action which fails is due to the mistake of the judge, or where the action is founded on the authority of decisions which are afterwards reversed, the action will be dismissed without costs (*x*).

Costs on dismissal for want of prosecution

Where the plaintiff obtained an injunction on motion, and the bill was ultimately dismissed with costs for want of prosecution, the defendant was held to be entitled to the costs of the motion (*y*).

Motion for injunction ordered to stand to trial.

So also where the motion for injunction was ordered to stand over till after the trial, and the plaintiff succeeded on the issue as to infringement, but failed as to the validity of the patent, the bill was ultimately dismissed with costs (*z*).

Where the motion for injunction was ordered to stand to the hearing, and at the hearing a decree was made for a perpetual injunction, and the defendant was ordered to pay the costs of the suit, it was held that the costs of the motion were costs in the cause (*a*). So also when the motion had been refused on the ground of delay, and the costs had been reserved (*b*).

And when the action was dismissed with costs at the trial, it was held that the judgment carried with it the costs of a motion for injunction which stood over until the trial, and was not then brought on (*c*).

And the judges of the Chancery Division have now directed that *where interlocutory applications have been ordered to stand to the trial* and are not then mentioned to the judge, the costs of such applications are to be treated as costs in the action and taxed accordingly, and need not be mentioned in the judgment. And where interlocutory applications have been disposed of, but the costs have been reserved, such costs are not to be mentioned in the judgment or order, or allowed on taxation without the special direction of the judge (*d*).

(*t*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140; affirmed, 7 Ch. 131; *Moet* v. *Pickering*, 6 Ch. D. 770.

(*u*) *Moet* v. *Pickering*, 8 Ch. D. 372.

(*x*) *Lister* v. *Leather*, 1 De G. & J. 361; 3 Jur. (N.S.) 849.

(*y*) *Stevens* v. *Keating*, 1 Mac. & G. 659.

(*z*) *Betts* v. *Clifford*, 1 J. & H. 74.

(*a*) *Mounsey* v. *Earl of Lonsdale*, L. R. 6 Ch. 141.

(*b*) *Thomson* v. *Batty*, 6 R. P. C. 84, 101.

(*c*) *Gosnell* v. *Bishop*, 38 Ch. D. 385.

(*d*) *British Natural Premium Provident Association* v. *Bywater*, [1897] 2 Ch. 531.

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In the absence of a direction to the contrary the costs of an appeal include the costs of the shorthand writer's notes of the judgment (*c*).

NOTE.

Staying proceedings for costs pending appeal.

Application to stay proceedings for costs pending an appeal must be made in the first instance to the court below (*f*), and if not made at the moment of giving judgment should be supported by an affidavit showing special circumstances (*g*).

The general rule is that the applicant must pay the costs of an application to stay proceedings pending an appeal (*h*); but where on an application by defendant to stay pending an appeal the proceedings under an account ordered on the trial of an action for infringement of patent, the proceedings were stayed, but the appeal was advanced, the court, considering that the plaintiff had obtained a benefit by the order, directed the costs of the application to be costs in the appeal (*i*).

And see *post* under s. 30, p. 278.

Taxation of costs.

Costs for "luxuries" not allowed.

On taxation of costs as between party and party, the only costs chargeable are such as are necessary to enable the adverse party to conduct the litigation and no more. Any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them (*k*).

Therefore, in a suit to restrain infringement of a patent in which the plaintiff failed, the costs of drawings and sections explanatory of the exhibits to the defendant's affidavits, which were only required for the purpose of being affixed to the margin of copies of the evidence supplied to counsel, were disallowed, and this notwithstanding the plaintiff himself took advantage of, and asked for copies of, the drawings (*l*).

Scientific witnesses.

But proper remuneration to scientific witnesses will be allowed (*m*), and also the expense of preparing a model for the trial (*n*). The models, however, will not be ordered to be given to the party who fails in the action, though he is ordered to pay the costs of them (*o*). Such remuneration will include, in proper cases, fees to the scientific witnesses for qualifying themselves to give evidence (*p*), and fees,

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(*e*) *Eland* v. *Medland*, 41 Ch. D. 493.

(*f*) *Otto* v. *Linford*, 18 Ch. D. 394; *Cropper* v. *Smith*, 24 Ch. D. 305.

(*g*) *Tuck* v. *Southern Counties Deposit Bank*, 42 Ch. D. 471.

(*h*) *Merry* v. *Nickalls*, L. R. 8 Ch. 205; *Cooper* v. *Cooper*, 2 Ch. D. 493.

(*i*) *Adair* v. *Young*, 11 Ch. D. 136.

(*k*) *Per* Sir R. MALINS, V.-C., *Smith* v. *Buller*, L. R. 19 Eq. 473.

(*l*) *Smith* v. *Buller*, L. R. 19 Eq. 473.

(*m*) *Batley* v. *Kynock*, L. R. 20 Eq. 632.

(*n*) *Batley* v. *Kynock*, *ubi supra*; *Musgrave* v. *Hicks*, 3 R. P. C. 49, 54.

(*o*) *Horrocks* v. *Stubbs*, 3 R. P. C. 221, 246.

(*p*) *Thomson* v. *Moore*, 25 L. R. Ir. 98.

although very large, have been allowed for experiments made for the purpose of supporting the plaintiff's case at the trial and meeting the case made against the plaintiff at the trial (*q*).

But special fees to scientific witnesses of peculiar eminence have been disallowed, and the costs of their assistants have also been disallowed as part of such witnesses' fees (*r*).

The costs of reference by the court to an expert will be costs in the cause (*s*).

Costs of inquiries reserved

The costs of an inquiry as to damages or account of profits should be reserved, so that the judge may have control over them (*t*), and the rule is the same when the action is undefended (*u*). In *Shaw* v. *Jones* (*x*) when it was referred to the referee to take the account of profits, the court gave him jurisdiction over the costs of the reference.

Costs of preparing for trial.

The rule at common law was not to give to a defendant costs of preparing for trial until after notice of trial had been given (*y*); and in *Curtis* v. *Platt* (*z*), where a defendant had obtained further time to plead upon terms that the action should be put down for trial, and that short notice of trial should be given, and the pleas were delivered, and the plaintiff then discontinued the action before issue joined or notice of trial given, it was held by the Court of Common Pleas that the defendant's costs incurred before notice of trial could not be allowed; and with reference to the defendant's contention that as notice of objections were delivered with the pleas, the expenses ought to be allowed as accessory to those objections, WILLES, J., after observing that he was not satisfied that these expenses were so connected, said:—"One instance has been given, the looking into specifications of patents of a similar character, but the validity of such a claim would depend on whether the defendant knew, when he delivered the objections, the particulars of the invention, or whether he was merely making speculative inquiries. I have strong doubts whether such expenses should be allowed at all."

However, in *Batley* v. *Kynock* (*a*), where the plaintiff shortly before the hearing dismissed his bill with costs, and the taxing-master had

(*q*) *Leonhardt* v. *Kalle*, 12 R. P. C. 306.

(*r*) *Thomson* v. *Moore*, *ubi supra*.

(*s*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 176.

(*t*) *Slack* v. *Midland Rail. Co.*, 16 Ch. D. 81. See also *Cole* v. *Saqui*, 5 R. P. C. 489, 497; *Needham* v. *Oxley*, Seton, 4th ed. 353; *Hill* v. *Evans*, 4 D. F. J. 288, 309.

(*u*) *United Telephone Co.* v. *Fleming* (2), 3 R. P. C. 282; *Same* v. *Faulkner*, *ibid.*

(*x*) 6 R. P. C. 328.

(*y*) *Freeman* v. *Springham*, 14 C. B. (N.S.) 197.

(*z*) 10 Jur. (N.S.) 823; *S. C.* 33 L. J. (N.S.) C. P. 255.

(*a*) L. R. 20 Eq. 632.

Sect. 29 (6). allowed to the defendant the expenses of drawing particulars of objections (*b*) and settling same by counsel, on the ground that the defendant, by the course taken by the plaintiff dismissing his own bill, had no opportunity of applying for the certificate, Sir JAMES BACON, V.-C., refused to review the taxing-master's decision, and said that up to the moment when the plaintiff chose to dismiss his own bill the defendant was bound to be on the *qui vive*, and to be prepared with every sort of defence he could lawfully use. But his Lordship intimated that if complaint is made that the charge is unreasonable, or that the defences are too long, too numerous, or too manifestly untenable on the face of them, the taxing-master ought to take such a complaint into consideration.

NOTE.

Costs in consolidated actions.

It is said that at common law, where several actions are consolidated, all the defendants are liable to the plaintiff for the costs of the action that is tried, and that they stand together in the relation of joint defendants so as to be liable to contribution for these costs (*c*). But where a number of actions had been brought by different plaintiffs against the same defendant, and one action was selected as a test action to try all the questions, it was held that in the absence of agreement the plaintiff in the test action had no right to be indemnified against costs by the other plaintiffs (*d*).

Costs on the higher scale.

The fact that defendant submits to an injunction is not a "special ground" within S. C. R. Order LXV. r. 9, for allowing costs on the higher scale (*e*); and costs on the higher scale were refused where defendant did not appear at the trial, though plaintiff succeeded in the action (*f*). "Costs on the higher scale ought only to be given in cases of very unusual difficulty requiring skill, antiquarian research, and things of that kind" (*g*).

Where the case has involved long examination, preparation of models, and the calling of expert evidence, costs on the higher scale have been allowed to the plaintiff (*h*) or the defendant (*i*) succeeding in the action (*k*).

(*b*) The report speaks of particulars of breaches, but this is clearly a clerical error.

(*c*) Lush's Practice, 3rd. ed. 965.

(*d*) *Amos* v. *Chadwick*, 9 Ch. D. 459.

(*e*) *Hudson* v. *Osgerby*, 32 W. R. 566.

(*f*) *Peroni* v. *Hudson*, 1 R. P. C. 261.

(*g*) See *per* LINDLEY, L.J., *Gadd* v. *Mayor, etc. of Manchester*, 9 R. P. C. 535.

(*h*) *Wenham* v. *May*, 4 R. P. C. 310; *Hopkinson* v. *St. James's, etc. Co.*, 10 R. P. C. 46, 62.

(*i*) *Ellington* v. *Clark*, 5 R. P. C. 319, 328.

(*k*) See also *Westinghouse* v. *L. & Y. Rail. Co.*, 1 R. P. C. 98, 103; *Easterbrook* v *G. W. Rail. Co.*, 2 R. P. C. 212; *Watling* v. *Stevens*, 3 R. P. C. 33, 43; *Otto* v. *Steel*, 3 R. P. C. 120; *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241, 251; *Kaye* v. *Chubb*, 4 R. P. C. 289.

And the Court of Appeal has given costs on the higher scale, although the judge in the court below refused them, and the Court of Appeal gave no decision upon one of the points on which the plaintiff had succeeded in the court below (*l*). [Sect. 29 (6). NOTE.

Where, in an action under s. 32 of this Act, the validity of the patent was tried, costs on the higher scale were allowed (*m*).

In *Crampton* v. *The Patents Investment Co.* (*n*), costs on the higher scale were refused at the trial, but the question was reserved till after taxation with liberty to apply after taxation, if the party to whom the costs were given could show that he had suffered any injustice by the costs being taxed on the lower scale.

Costs on appeal against an interlocutory injunction were allowed on the lower scale only, though an important question was raised (*o*).

30. In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit. Order for inspection, etc., in action.

This is substantially a re-enactment of the corresponding section of the Act of 1852 (*p*); but that section, although said by Lord CAMPBELL to have been intended to vest in the Courts of Common Law the power as to these matters theretofore exclusively exercised by Courts of Equity (*q*), does not seem to have had the effect of enabling the plaintiff at common law to obtain such full relief, either by way of injunction (*r*) or inspection as he could have in equity (*s*). But now, by the Judicature Act, 1873, all the jurisdiction which could be exercised by all or any of the old Courts of Common Law and Chancery is transferred to the High Court of Justice, and by s. 25 (11) it is provided that in case of conflict between the rules of equity and the rules of common law the rules of equity shall prevail.

(*l*) *Ellington* v. *Clark*, 5 R. P. C. 319, 328.

(*m*) *Kurtz* v. *Spence*, 5 R. P. C. 161; *Ungar* v. *Sugg*, 6 R. P. C. 337.

(*n*) 5 R. P. C. 404.

(*o*) *Grafton* v. *Watson*, 51 L. T. (N.S.) 143.

(*p*) 15 & 16 Vict. c. 83, s. 42.

(*q*) *Holland* v. *Fox*, 3 E. & B. 977; *S.C.* 1 Jur. (N.S.) 13.

(*r*) *Gittins* v. *Symes*, 15 C. B. 362.

(*s*) Compare *Patent Type Founding Co.* v. *Lloyd*, 5 H. & N. 192 (where the Court of Law refused to permit a portion of certain type alleged to have been made in infringement of a patent to be carried away for analysis) with *Patent Type Founding Co.* v. *Walter*, Johnson, 727, where Sir W. P. WOOD, V.-C. allowed this to be done. See also *Vidi* v. *Smith*, 3 E. & B. 969; *S. C.* 1 Jur. (N.S.) 15.

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NOTE.

By s. 25 (8) of the same Act an injunction may be granted by an interlocutory order of the court in all cases in which it shall appear to the court to be just and convenient that such order should be made, and any such order may be made either unconditionally or on such terms and conditions as the court shall think just. And by S. C. R. 1883, Order L. r. 12, it is provided that in any cause or matter in which an injunction has been or might have been claimed, the plaintiff may, before or after judgment, apply for an injunction to restrain the defendant or respondent from the repetition or continuance of the wrongful act or breach of contract complained of, or from the commission of any injury or breach of contract of a like kind relating to the same property or right, or arising out of the same contract, and the court or a judge may grant the injunction either upon or without terms as may be just.

By Rule 3 of the same order the court or a judge is empowered, on the application of any party to a cause or matter, and upon such terms as may seem just, to make any order for the detention, preservation, or inspection of any property or thing being the subject of such cause or matter, or as to which any question may arise therein, and for all or any of the purposes aforesaid to authorize any persons to enter upon or into any land or building in the possession of any party to such cause or matter, and for all or any of the purposes aforesaid to authorize any samples to be taken, or any observation to be made, or experiment to be tried, which may seem necessary or expedient for the purpose of obtaining full information or evidence.

And by Rule 4 of the same order any judge by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal, may inspect any property or thing concerning which any question may arise therein. And by Rule 5 of the same order the provisions of Rule 3 mentioned above shall apply to inspection by a jury (*t*).

The result, therefore, is that each division of the High Court of Justice has now the fullest powers of making orders for injunction, inspection or account whenever it shall think proper so to do, and this jurisdiction can be exercised by any judge of the court (*u*). The powers conferred by this section and the rules cited above being given to "the court or a judge" may be exercised either on application in court or on summons at chambers (*x*), subject, however, to the provisions of Order LIV. r. 12, and Order LV. r. 15. No writ of injunction is to

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(*t*) See also S. C. R. 1883, Ord. L. r. 6.

(*u*) *Beddow* v. *Beddow*, 9 Ch. D. 89; *Thomas* v. *Williams*, 14 Ch. D. 864; *Quartz Consolidated, etc. Co.* v. *Beall*, 20 Ch. D. 501.

(*x*) See *Frearson* v. *Loe*, 26 W. R. 138.

be issued. An injunction is to be by judgment or order, and any such judgment or order is to have the effect which a writ of injunction previously had (*y*). Sect. 30. NOTE.

The words "impose such terms" are an addition to the corresponding section of the Act of 1852.

On an application for injunction the judge may make an order for an early trial without first going into the whole merits on affidavit or other evidence for the purposes of the application (*z*).

INJUNCTIONS (INTERLOCUTORY).

The rule as to granting interlocutory injunctions in patent actions is thus stated by Sir GEORGE JESSEL, M.R. :—

"The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the court to say that as against the defendant himself there is no reason to doubt the validity of the patent" (*a*).

It will be convenient to consider these several cases in the order thus stated.

I.—*Where the patent is old, and there has been long and undisturbed enjoyment.*

On this point the rule is laid down by Lord ELDON in the following terms :—

"Where a patent has been granted, and an exclusive possession of some duration under it, the court will interpose its injunction without putting the party previously to establish his patent by an action at law. But where the patent is but of yesterday, and upon an application being made for an injunction it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial (*b*). Rule as to long enjoyment.

(*y*) S. C. R. Order L. r. 11.
(*z*) S. C. R. Order L. r. 1*a*.
(*a*) *Dudgeon* v. *Thomson*, 30 L. T. (N.S.) 244 ; *S. C.* 22 W. R. 464.
(*b*) *Hill* v. *Thompson*, 3 Mer. 622 ; *S. C.* 1 Webst. P. C. 229, 231. See also *Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 707 ; *Stevens* v. *Keating*, 2 Webst. 177 ; *Harmer* v. *Plane*, 14 Ves. 130 ; *Bickford* v. *Skewes*, 1 Webst. 211, 213 ; *Electric Telegraph Co.* v. *Nott*, 2 Coop. C. C. 41 ; *Wilson* v. *Tindal*, 1 Webst. P. C. 730 ; *Renard* v. *Levinstein*, 10 L. T. (N.S.) 94 ; *Davenport* v. *Jepson*, 4 D. F. J. 440.

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The ground of this presumption in favour of the patent when there has been long enjoyment is that anybody might have proceeded by *scire facias* to repeal the patent, and yet for a length of time no one has done so (c).

Again, Lord COTTENHAM, C., said that in the case of patents "the rule steps in and says long and and uninterrupted possession shall be *primâ facie* evidence of title which ought to be respected. . . . . *Primâ facie* in that state of the case the court is not at liberty to exercise a discretion as to whether the patent be good or not" (*d*).

Comparative inconvenience not considered in cases of long enjoyment.

In these cases the court does not proceed on the ground of comparative inconvenience. In *Davenport* v. *Jepson* (*e*), TURNER, L.J., said: "If the case turned on the question of comparative injury, see what the position of the plaintiff would be if an injunction were refused. Supposing his patent is valid, a number of persons are infringing it. If the court refused an injunction in this case, it must refuse it in the case of each of the other infringers. Supposing the plaintiff to succeed at the hearing, the market will, in the meantime, have been flooded with articles wrongfully manufactured according to his patent." This also appears to have been the view of Lord ELDON in *Harmer* v. *Plane* (*f*), and of Lord COTTENHAM in *Stevens* v. *Keating* (*g*).

But enjoyment must have been uninterrupted.

And there must also be clear evidence that the enjoyment by the patentee has been in fact uninterrupted and exclusive. When the evidence of this is not satisfactory, then, notwithstanding the patent may be of long standing, the interlocutory injunction will be refused till after the validity of the patent has been established (*h*). Thus, when a patent dated in 1825 was in 1838 assigned to the plaintiffs, who in that year filed a bill to restrain infringement and obtained an *ex parte* injunction against the defendant, but it was shown that for some years prior to the assignment the invention had been used by one of the plaintiffs without the licence of and adversely to the patentee, the injunction was dissolved (*i*).

And active not passive

And the plaintiff must show not merely passive enjoyment of the patent, but an actual user of the invention. And therefore, where a patentee whose patent was ten years old applied for an injunction but did not produce any evidence of actual user except at a recent period,

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(*c*) *Per* TURNER, L.J., *Davenport* v. *Jepson*, 4 D. F. J. 446; *Caldwell* v. *Vanvlissengen*, 9 Ha. 415, 424; *Electric Telegraph Co.* v. *Nott*, 2 Coop. Ch. Ca. 41.

(*d*) *Stevens* v. *Keating*, 2 Webst. 177.

(*e*) 4 D. F. J. 448.

(*f*) 14 Ves. 130.

(*g*) 2 Webst. 177.

(*h*) *Collard* v. *Allison*, 4 My. & Cr. 487.

(*i*) *Curtis* v. *Cutts*, 8 L. J. (N.S.) Ch. 184; 2 Coop. C. C. 60.

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Or dependent on substratum patent.

the application was refused (*k*). But the application for injunction is not defective merely because the plaintiff does not allege that his patent has never been disputed (*l*).

Where a patented invention was the subject of a prior substratum patent, and could not be used without the licence of the original patentee, it was held that the undisturbed enjoyment of the second patent only dated from the expiration of the substratum patent, and as on this view only one year's enjoyment could be shown, no injunction could be granted (*m*).

Injunction granted on long enjoyment, though validity of patent doubtful.

When the enjoyment of the patent has been long and uninterrupted the court will grant the interlocutory injunction, notwithstanding there may be doubts as to the validity of the patent (*n*). Thus, in *The Universities of Oxford and Cambridge* v. *Richardson* (*o*), Lord ELDON, C., said: "In the case of patent rights, if the party gets his patent and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained, this court has lately said possession under colour of title is ground enough to enjoin, and to continue the injunction till it is proved at law that it is only colour and not real title."

And in *Losh* v. *Hague* (*p*) the injunction was granted although a prior specification was produced as an anticipation of the plaintiff's invention, which, on the face of it, seemed to be fatal to his patent (*q*).

So, also, in *Muntz* v. *Foster*, the patentee having had long possession and enjoyment of his patent, an injunction to restrain infringement was granted by Sir J. L. KNIGHT-BRUCE, V.-C. On appeal, objections to the specification were made, but Lord LYNDHURST, C., sustained the injunction, saying, "The patentee has been in the possession of his exclusive privilege for several years and the court will not, on any suggested defect of the specification, allow the enjoyment of that privilege to be disturbed until the title has been decided in a court of law" (*r*).

And in *Briggs* v. *Lardeur* (*s*), on an application for an injunction to restrain the infringement of a patent ten years old, where it was contended that the patent was, on the face of it, bad, PEARSON, J., said: "Whether this patent is a good patent or not I think I ought not to consider at

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(*k*) *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 38.

(*l*) *Read* v. *Andrew*, 2 R. P. C. 119.

(*m*) *Heugh* v. *Magill*, W. N. 1877, 62.

(*n*) *Betts* v. *Menzies*, 3 Jur. (N.S.) 357, 359; *Dudgeon* v. *Thomson*, 30 L. T. (N.S.) 244.

(*o*) 6 Ves. 707. See also *Gardner* v. *Broadbent*, 2 Jur. (N.S.) 1041.

(*p*) 1 Webst. 201.

(*q*) See also *Beeston* v. *Ford*, 2 Coop. C. C. 58; *Bickford* v. *Skewes*, 1 Webst. P. C. 213.

(*r*) 2 Webst. 93, 95.

(*s*) 1 R. P. C. 129.

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all on the present motion unless I can see, on the face of this patent, that it is so irretrievably and hopelessly bad that it is absolutely impossible that it could be supported. In a case so plain as that, I doubt not I might consider it on interlocutory motion; but when the patent has been in existence ten years, and has not been challenged at the end of ten years, I think this court ought to give credit to the patent and ought to assume, at all events, upon the interlocutory motion, that for the purposes of the interlocutory motion the patent is a good patent; of course, leaving it entirely open until the case comes on for trial to determine that the patent is as bad a patent as was ever taken out" (*t*).

Statements in an affidavit as to the invalidity of the patent, which are founded on mere information and belief, are not sufficient to prevent the grant of an injunction (*u*).

What length of enjoyment sufficient for injunction

The following cases may be consulted as to the time of undisputed possession of a patent on which the court will grant an injunction before the patent has been established:—

In *Harmer* v. *Plane* (*x*) and *Read* v. *Andrew* (*y*), the patentee had had thirteen years' enjoyment; in *Neilson* v. *Thompson* (*z*), twelve years; in *Stevens* v. *Keating* (*a*), of one patent, thirteen years, of another, seven years; in *Wilson* v. *Tindal* (*b*), eleven years; in *Briggs* v. *Lardeur* (*c*) and *Shillito* v. *Larmuth* (*d*), ten years; in *Davenport* v. *Richards* (*e*), nine years; in *Betts* v. *Menzies* (*f*), eight years; in *Losh* v. *Hague* (*g*), and *Osmond* v. *Hirst* (*h*), seven years; and in *Bickford* v. *Skewes* (*i*), and *Rothwell* v. *King* (*k*), six years. (In *Neilson* v. *Thompson*, *Stevens* v. *Keating*, *Betts* v. *Menzies*, and *Briggs* v. *Lardeur* (*l*), the injunctions were ultimately dissolved, but not on any ground affecting the question of long enjoyment.)

In *Renard* v *Levinstein* (*m*), Lord Hatherley, then Vice-Chancellor, said that if the patent had been six or seven years old, and up to that time undisputed, the *primâ facie* right to an injunction would have been clear.

Where the invention related to a subject-matter in which inventors were very much on the alert, and in which several patents had been taken out, it was held by the same learned judge that the fact that the

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(*t*) See also *Shillito* v. *Larmuth*, 2 R. P. C. 1.

(*u*) *Read* v. *Andrew*, 2 R. P. C. 119.

(*x*) 14 Ves. 130.

(*y*) 2 R. P. C. 119.

(*z*) 1 Webst. 279.

(*a*) 2 Webst. 176.

(*b*) 1 Webst. 730.

(*c*) 1 R. P. C. 126.

(*d*) 2 R. P. C. 1.

(*e*) 3 L. T. (N.S.) 503.

(*f*) 3 Jur. (N.S.) 357. See also L. R. 3 Eq. p. 312.

(*g*) 1 Webst. 200.

(*h*) 2 R. P. C. 265.

(*i*) 1 Webst. 211, 213.

(*k*) 3 R. P. C. 379.

(*l*) 1 R. P. C. 192.

(*m*) 10 L. T. (N.S.) 94.

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articles had been sold under the patent for three years at large profits to the patentee without any invasion of his patent, was sufficient to warrant the grant of an injunction on a patent rather more than three years old (*n*).

On the other hand, in *Hill* v. *Thompson*, the patent was dated July 1814, the bill was filed in 1817, but the plaintiff's works were not complete so as to enable him to carry on operations under the patent till July, 1816. Under these circumstances Lord ELDON dissolved an injunction which had been obtained (*o*).

And in *Renard* v. *Levenstein* (*p*), where the patent was only two years old at the time of the filing of the bill, and its validity had not been established in any proceeding, the Lords Justices refused to continue an injunction which had been granted by the Vice-Chancellor, notwithstanding the facts that the defendant had filed no affidavits in opposition to the original motion, and had since put in his answer and allowed three months to elapse before applying to dissolve the injunction, and although four infringers had submitted to the plaintiff's demands, one of whom had bought the articles complained of from the defendant's own agent (*q*). The defendant having suggested various defects in the plaintiff's specification, KNIGHT-BRUCE, L.J., said, after referring to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant in such a case at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification." And after referring to the suggested objections, his lordship continued: "It is only for the present purpose, the age of the patent considered, necessary to say, as far as I am concerned, that in my judgment, at least, the point is one of doubt and difficulty."

The circumstance that the court itself now tries the whole case without, as was the old practice of the Court of Chancery, directing an action to be tried at law, ought not, where there has been long and quiet enjoyment of the patent, to have any weight on the question whether or not an interlocutory injunction shall be granted (*r*).

Where the patent is recent the court will not interfere by interlocutory injunction, when there is a substantial question to be tried as to the validity of the patent. In such a case the proper course is, upon the

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(*n*) *Wheatstone* v. *Wilde*, Griffin, P. C. 247.

(*o*) 3 Mer. 622; 1 Webst. 232. See also *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 37.

(*p*) 10 L. T. (N.S.) 177.

(*q*) These facts appear from the report before the V.-C., 10 L. T. (N.S.) 94.

(*r*) See *per* TURNER, L.J., *Davenport* v. *Jepson*, 4 D. F. & J. 447.

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defendant undertaking to keep an account, not to make any order on the plaintiff's motion (*s*).

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The above rule applies to patents under the Act of 1852; but in *Jackson* v. *Needle* (*t*), the Court of Appeal expressly refrained from giving any opinion as to what would be the proper course in any case arising under the present Act—"The question will be thereunder whether the investigation and protection which is given to the public under sections 10 and 11 may alter the rule which hitherto has existed, where a patentee of a patent of a recent date comes for an interim injunction."

But if the defendant does not appear, an injunction may be granted, even in the case of a new patent, on a proper affidavit being produced of its validity (*u*).

And where the patent was recent, but the infringement was not denied, and the only objection to the patent was that the specification was defective, which objection was founded on the circumstance that the plaintiff had given to a licensee certain instructions not embodied in the specification, and it was shown that a competent workman with no other assistance than the specification could work the invention, an interlocutory injunction was granted (*x*).

In *Tadman* v. *Owens* (*y*), where the court considered that the invention was not subject-matter for a patent, the injunction was refused with costs.

II.—*Where the validity of the patent has been established elsewhere, and the court sees no reason to doubt the propriety of the result.*

Patent established in one action injunction granted in action against new infringer.

In some of the earlier cases, as, for instance, in *Crosskill* v. *Tuxford* (*z*), *Crosskill* v. *Evory* (*a*), it seems to have been considered that, notwithstanding previous suits establishing the patent against other persons, an interlocutory injunction could not be granted against a new infringer until after the patent had been established against him. This view, however, is inconsistent with the later cases, which lay down the rule that while the defendant in such a case may dispute the patent at the trial, the validity of the patent will be considered so far established by the previous suits as to warrant the Court in granting an interlocutory injunction (*b*).

(*s*) *Jackson* v. *Needle*, 1 R. P. C. 174, 177; *Lister* v. *Norton*, 1 R. P. C. 114; *Holophane, Ltd.* v. *Berend*, 15 R. P. C. 18. See also *Caldwell* v. *Van Vlissengen*, 9 Hare, 424, TURNER, L.J.

(*t*) 1 R. P. C. 177, judgment of COTTON, L.J.

(*u*) *Clarke* v. *Nichols*, 12 R. P. C. 310.

(*x*) *Coles* v. *Baylis*, 3 R. P. C. 178.

(*y*) 11 R. P. C. 349.

(*z*) 5 L. T. 342.

(*a*) 10 L. T. 459.

(*b*) *Newall* v. *Wilson*, 2 D. M. & G. 282; *Davenport* v. *Jepson*, 4 D. F. & J. 440; *Davenport* v. *Goldberg*, 2 H. & M. 282; *Bovill* v. *Smith*, W. N. 1867, 240; *Dudgeon*

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The distinction is that, where the validity of the patent has not been made the subject of legal proceedings, then the patentee must prove its validity before a jury before the court will protect him; but having once established its validity, then the court will protect him against any other person until that person proves its invalidity (*c*).

Even though new facts alleged against patent.

In such a case the interlocutory injunction will be granted, although a fresh fact may be now brought forward tending to impeach the novelty of the invention (*d*).

In *Renard* v. *Levinstein* (*e*) it was held that the injunction ought to be granted notwithstanding the defendant offered to keep an account. In this case, it is true, the issues as to the validity of the patent which had been directed in the suit had been found in favour of the plaintiff, but there seems to be no reason why the rule should not apply in cases where credit for the purposes of the interlocutory injunction is given to the patent by reason of its having been established in previous suits against other persons.

An allegation as to the defendant's inability to be answerable in damages is not irrelevant upon a motion for injunction to restrain infringement (*f*).

And where a patentee had brought an action against a defendant, and on the trial an arbitration was agreed to, on which the arbitrator found in favour of the validity of the patent, the court, upon a subsequent infringement by the same defendant, considered the validity of the patent as sufficiently established by the award, and granted an interlocutory injunction (*g*).

And the fact of an interdict having been granted by the Court of Session in Scotland against the defendant, restraining him from infringing the patent, is sufficient *primâ facie* evidence of its validity to warrant the grant of an interlocutory injunction by an English Court (*h*).

Issues found in plaintiff's favour, injunction granted.

Under the old practice in Chancery, where an interlocutory injunction had been originally refused, or, having been granted, had been dissolved on the terms that the plaintiff should bring an action to try the validity of his patent, it was almost a matter of course, if the action resulted in judgment for the plaintiff, that the injunction should be

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v. *Thomson*, 30 L. T. (N.S.) 244. *Farbenfabriken* v. *Dawson*, 8 R. P. C. 397.

(*c*) *Per* Lord ROMILLY, M. R., *Bovill* v. *Goodier* (2), L. R. 2 Eq. 200.

(*d*) *Newall* v. *Wilson*, 2 D. M. & G. 282; *Pneumatic Tyre Co.* v. *Marwood*, 13 R. P. C. 347.

(*e*) 2 H. & M. 628, 634.

(*f*) *Newall* v. *Wilson*, 2 D. M. & G. 282.

(*g*) *Lister* v. *Eastwood*, 26 L. T. 4.

(*h*) *Dudgeon* v. *Thomson*, 30 L. T. (N.S.) 244.

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allowed (*i*); and this course has been followed in the practice under Sir John Rolt's Act and Lord Cairns' Act; and where the usual issues in a patent suit had been tried by the court itself under those Acts, and the verdict had been in favour of the plaintiff, the latter was at once entitled to the interlocutory injunction, and this although the defendant volunteered to keep an account (*k*).

And where the plaintiff, having been directed to bring an action, had obtained a verdict upon a case stated, but the Court of Common Law was equally divided upon the question of the validity of the patent, Lord ROSSLYN, C., would not dissolve an injunction previously granted, but directed the patentee to bring a fresh action, and declined to impose terms on the plaintiff as to the Court in which the action should be brought (*l*).

But not if proceedings for new trial pending.

But where after verdict in favour of the plaintiff the defendant had obtained a rule *nisi* for a new trial (*m*), or had stated his intention to move for a new trial (*n*), or tendered a bill of exceptions (*o*), the motion for an interlocutory injunction was ordered to stand over till the result of the application to the Court of Common Law should be known.

And where an injunction which had been obtained by a plaintiff pending the trial of an action at law was continued by the Vice-Chancellor, notwithstanding the first decision of the Court of Law against the validity of the patent, it was dissolved upon such first decision being affirmed by the Court of Exchequer Chamber (*p*).

The rule, however, was not invariable, and in *Bridson* v. *Benecke* (*q*) it was held that the Court would act according to the circumstances of each particular case.

After patent established injunction granted on *primâ facie* evidence of infringement.

Where the validity of the patent has been established in another action, an injunction against a fresh infringer may be granted, if the Court, on the evidence before it, sees a *primâ facie* case of infringement, even though it reserves to itself the right to decide finally on the infringement at the trial (*r*). And if the infringement is clear the injunction may be granted with costs (*s*).

(*i*) *Neilson* v. *Harford*, 1 Webst. P. C. 373; *Russell* v. *Cowley*, 1 Webst. P. C. 471.

(*k*) *Renard* v. *Levenstein*, 2 H. & M. 628.

(*l*) *Boulton* v. *Bull*, 3 Ves. 140.

(*m*) *Collard* v. *Allison*, 4 My. & Cr. 487, 490.

(*n*) *Hill* v. *Thompson*, 3 Mer. 631; *S.C.* 1 Webst. P. C. 235, 238.

(*o*) *Bridson* v. *McAlpine*, 8 Bea. 229.

(*p*) *Betts* v. *Menzies*, cited by Sir W. P. WOOD, V.-C., in *Penn* v. *Bibby*, L. R. 3 Eq. 308, 312.

(*q*) 12 Bea. 1.

(*r*) *Thorn* v. *Worthing Skating Rink Co.*, 6 Ch. D. 415 n.; *Plimpton* v. *Spiller*, 4 Ch. D. 286, 289; *Moser* v. *Sewell*, 10 R. P. C. 365; *Edison-Bell Phonograph Co.* v. *London Phonograph Co.*, 11 R. P. C. 193.

(*s*) *Hayward* v. *The Pavement Light Co.*, 1 R. P. C. 207.

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And where a defendant in the previous action in which the certificate was granted had contested the patent up to trial, and had not appeared at the trial, and the defendant in a second action had taken a similar course, and submitted at the trial, an interlocutory injunction was granted in a third action (*t*).

But new defendant not bound by proceedings in former action.

Although an interlocutory injunction will, at the suit of a patentee who has established his patent against previous infringers, be granted against a new defendant, the latter is nevertheless not bound at the trial by the previous decisions to which he has been no party, and he is not to be driven to contest the validity of the patent by proceedings for its revocation (*u*).

But injunction may be granted and issue as to novelty directed.

But if, in such a case, the Court is satisfied of the sufficiency of the specification, the utility of the invention, and the fact of infringement, although it may grant an issue as to the novelty of the invention, it will grant an injunction restraining infringement, reserving the further hearing of the cause till after the trial of the issue (*x*).

III.—*Where the conduct of the defendant is such as to enable the Court to say that as against him there is no reason to doubt the validity of the patent.*

Licensee cannot dispute patent.

Thus, where a licence is granted by deed, and the deed contains a recital necessarily implying the validity of the letters patent, the licensee is thereby estopped from disputing the patent (*y*). And where the deed merely recited the grant of letters patent, it was held that a plea by an exclusive licensee in an action for royalties that the invention was of no utility and not new could not be sustained, no fraud being alleged, first, because the contract being by deed the failure of consideration was immaterial; and secondly, because it is not competent to a defendant by plea to deny the effect of a deed which he has executed (*z*).

And apart from any question of estoppel by deed, a licensee, during the continuance of the licence, and whilst he is using the patented invention, will not be allowed to dispute the validity of the letters patent (*a*).

(*t*) *Edison Bell Phonograph Co.* v. *Bernstein*, 14 R. P. C. 153.

(*u*) *Borill* v. *Goodier* (2), L. R. 2 Eq. 195. See also *Shaw* v. *Day*, 11 R. P. C. 185; *Russell* v. *Barnsley*, 1 Webst. 472; *S.C.* 2 Coop. C. C. 58. See, however, *Davenport* v. *Goldberg*, 2 H. & M. 286.

(*x*) *Borill* v. *Goodier*, *ubi supra*.

(*y*) *Bowman* v. *Taylor*, 2 Ad. & E. 278; 1 Webst. 292. See also *Cutler* v. *Bower*, 11 Q. B. 973.

(*z*) *Smith* v. *Scott*, 6 C. B. (N.S.) 771; 5 Jur. (N.S.) 1358. See also *Hall* v. *Conder*, 2 C. B. (N.S.) 22.

(*a*) *Clark* v. *Adie* (No. 2), 2 App. Cas. 423; *Charnaud* v. *Stevens*, W. N. 1874, p. 193; *Bessman* v. *Wright*, 6 W. R. 719; *Cochman* v. *Greener*, 1 R. P. C. 197.

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Thus, in *Laves* v. *Purser* (*b*), there was an agreement by the defendants to pay a royalty of 10*d.* per ton in respect of a certain substance manufactured according to the patented invention. The defendants used the invention, and on action by the patentee for the royalty pleaded that the letters patent were void. The plea was overruled, and Lord CAMPBELL, C.J., said :—"There having been such an agreement, as stated in the declaration, and permission to use the invention having been enjoyed under it, can it be permitted to the defendants, after such a contract and such acquiescence on their part of the plaintiff's claim, and such enjoyment by them of the invention, to say that they will not pay the stipulated price because the patent is void?" And it was held that the defendants, not denying that they had so used the invention, could not set up this defence.

So, also, in *Noton* v. *Brooks* (*c*), a similar defence under similar circumstances was overruled, Sir F. POLLOCK, C.B., saying :—"The defendant agrees to pay the plaintiffs a royalty if they will allow him to use their patent invention, and he does use it ; then how can he turn round and say that it is worthless?"

Even where licence is verbal only.

And even when the agreement was only verbal, but the defendant used the invention, and afterwards in a suit for the royalties denied the validity of the patent, it was held by Sir W. P. WOOD, V.-C., and afterwards by the House of Lords, that this defence was not open to him. Lord WESTBURY, C., said :—"It is an idle distinction that it is attempted to be set up by the respondent that he made an agreement and did not take a licence ;" and Lord CHELMSFORD said :—"The question is not whether the defendant is at liberty to dispute the right of the plaintiffs to their patent inventions, but whether, being under an agreement to pay royalties for goods manufactured by the plaintiff's looms, and any other looms embodying their inventions, he is, while that agreement is subsisting, at liberty to use those inventions and to refuse to pay the royalties. I apprehend that he cannot do so. He cannot act under the agreement and at the same time repudiate it. He may, if he pleases, put an end to the agreement, and he may use the machines which he has purchased from the plaintiffs, but he must do so at his peril ; he must do so under the liability to be treated as an infringer, and to be subject to an action for damages for that infringement (*d*).

And where, in an action by patentees against licensees for an account and injunction against using the invention except on the terms of the licence, the defendants pleaded that if the specification was construed

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(*b*) 6 E. & B. 930.
(*c*) 7 H. & N. 499.
(*d*) *Crossley* v. *Dixon*, 10 H. L. C. 293, 308. 310 ; *Clark* v. *Adie* (No. 2). 2 App. Cas. 423.

so as to include the process used by them, the patent would be invalid, the plea was struck out as embarrassing (*e*).

And in the same case where certain of the defendants pleaded that they were not bound by the licence, and that if it existed it had been cancelled, and also pleaded invalidity of the patent, the plea of invalidity was struck out.

And the rule applies though patent declared bad in action against third party.

And the above rules will apply as between the plaintiff and the defendant, his licensee, even though the patent has subsequently to the commencement of the action been, in another proceeding against a third person, declared invalid (*f*), or has been revoked (*g*).

Nor can licensee recover from patentee because patent bad

And where a licensee had under an agreement which recited the patent, used the invention and paid royalties, and it having turned out that the patent was void, brought an action to recover from the patentee the amount so paid, it was held that the action must fail; and HEATH, J., said:—"There never has been a case, and there never will be, in which the plaintiff, having received benefit from a thing which has afterwards been recovered from him, has been allowed to maintain an action for the consideration originally paid"(*h*).

But where the defendant had agreed to pay an annuity of 400*l.* a year as the consideration for the exclusive use of certain patented inventions, but in fact never used them, it was held, in an action for payment of the annuity, that he could plead the invalidity of one of the patents as a defence to the action. The consideration was entire, and the payment to be made by the defendant was entire. The consideration, by failing partially, failed entirely (*i*).

And in *Hayne* v. *Maltby* (*k*), where there was in an agreement a recital that the plaintiffs were assignees of a patent, and that the defendant had applied to the plaintiffs for permission to use the invention, to which they assented, on condition of his working it in the manner described in the specification, and the defendant covenanted not to use any machines except one allowed to him by the agreement, and an action was brought on the agreement alleging two breaches of covenant, one for using patent machines other than that by the agreement allowed, and the other for using machines resembling the patent

(*e*) *Ashworth* v. *Law*, 7 R. P. C. 231.

(*f*) *Grover and Baker Sewing Machine Co.* v. *Millard*, 8 Jur. (N.S.) 713.

(*g*) *African Gold Recovery Co.* v. *Sheba Gold Mining Co.*, 14 R. P. C. 660.

(*h*) *Taylor* v. *Hare*, 1 B. & P. N. R. 260; 1 Webst. P. C. 292. See also *Collinge* v. *Bowman*, 1 Webst. P. C. 295.

(*i*) *Chanter* v. *Leese*, 4 M. & W. 295; 5 M. & W. 698; 1 Webst. P. C. 295. See observations of CROMPTON, J., on this case in *Besseman* v. *Wright*, 6 W. R. 719.

(*k*) 3 T. R. 438; 1 Webst. P. C. 291.

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machines, it was held that the defendant was not estopped from pleading the invalidity of the patent. Upon this case it was observed by PATTESON, J., in *Bowman* v. *Taylor* (*l*), that the recital contained no assertion of right in the plaintiffs, except as assignees, and that the case was not properly one of estoppel; and by Lord COTTENHAM, C., in *Neilson* v. *Fothergill* (*m*), that the case of *Hayne* v. *Maltby* merely amounted to this, that although a party has dealt with a patentee, and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot recover without giving the other party an opportunity of disputing his right, and that if the defendant successfully dispute his right, notwithstanding he has been dealing under a contract, it is competent to the defendant to do so.

The defendant is not estopped from disputing the patent if the only working has been under an agreement which has been entered into subject to an inquiry as to the validity of the patent, and such inquiry has not been unreasonably delayed (*n*).

Where the plaintiff brought an action for infringement, and the defendant claimed under an equitable agreement for a licence, which the plaintiff alleged was revoked, it was held that the defendant could not dispute the validity of the patent, and at the same time insist on his rights under the licence (*o*).

And where in a licence there was a covenant by a patentee that he would take proceedings against infringers, and that if the patent should become void or ineffectual by reason of his omission to do so, or by reason of the invention not being novel, or being an infringement of other letters patent, the payment of the annual sum convenanted to be paid by the licensees should cease, and the patentee, having let the patent lapse by non-payment of renewal fees, sued for the payment of the annual sum, it was held that the licensees could not plead want of novelty (*p*).

Inasmuch as a petition for revocation, by whomsoever presented, is a petition on behalf of the public, and is not personal to the petitioner (*q*), it would seem that a licensee may present a petition for revocation (*r*).

But licensee may dispute the patent when licence determined.

After the determination of a licence the licensee may dispute the validity of the patent as against his licensor (*s*).

(*l*) 2 Ad. & E. 278; 1 Webst. 294.
(*m*) 1 Webst. P. C. 290.
(*n*) *Wilson* v. *Union Oil Mills Co.*, 9 R. P. C. 57.
(*o*) *Postcard Automatic Supply Co.* v. *Samuel*, 6 R. P. C. 560.
(*p*) *Mills* v. *Carson*, 10 R. P. C. 9.
(*q*) *Deeley's Patent*, [1895] 1 Ch. 687; 12 R. P. C. 192, 199. See also *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 530.
(*r*) See also *Martin's Patent*, Griffin, P. C. 320.
(*s*) *Dangerfield* v. *Jones*, 13 L. T. (N.S.) 142; *Armann* v. *Lund*, L. R. 18 Eq. 330; *Crossley* v. *Dixon*, 10 H. L. C. 293.

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And equitable assignees of an exclusive licence, who, having used the invention, disclaimed any further use of it, were, in an action brought to restrain them from selling the patented article otherwise than in conformity with the covenants of the licence, held to be not estopped from disputing the validity of the patent (*t*).

And it is open to a licensee to show that his licensor's right has expired, and therefore, where there was an agreement to pay royalties while certain English and foreign patents belonging to the licensors should last, the licensees were allowed to show that one of the patents, an American patent, had expired by reason of the prior expiry of an English patent for the same invention (*u*).

Licensee entitled to have ambit of licence determined.

A licensee, however, is entitled to have it ascertained what is the ambit, what is the field, which is covered by the specification of the patent (*x*).

If a tool used by a licensee, without payment of royalty, is found to be included in the patent, he may be restrained from using it, except in accordance with the licence, and upon such a question the conduct of the parties may be taken into consideration (*y*).

In an action for misrepresentation in a company prospectus, which had stated that a patent was valuable, evidence to show that the invention had been anticipated, and that the patent was therefore invalid, was held inadmissible (*z*).

Others besides licensee may be estopped from disputing patent.

A defendant, though not a licensee, may, by his acts, be prevented from disputing the patent on an application for interlocutory injunction.

Thus, where the patentee had at one time worked his invention in partnership with the defendants under an agreement reciting the patent, and during the subsistence of the partnership the defendants had joined the patentee as co-plaintiffs in suits against various infringers, it was held by KNIGHT-BRUCE, V.-C., that the partnership having been determined, and the defendants having commenced working the invention without the leave of the patentee, the latter was entitled to an interlocutory injunction against them before establishing his patent at law (*a*).

(*t*) *Pidding* v. *Franks*, 1 Mac. & G. 56.

(*u*) *Muirhead* v. *Commercial Cable Co.*, 11 R. P. C. 317; 12 R. P. C. 39.

(*x*) *Per* Lord CAIRNS, L.C., *Clark* v. *Adie* (No. 2), 2 App. Cas. 426. As to how far prior specifications may be looked at for the purpose of construing the plaintiff's specification, see *ante*, p. 19.

(*y*) *Useful Patents Co.* v. *Rylands*, 2 R. P. C. 255.

(*z*) *Stavert* v. *Passburg Grains Syndicate*, 8 R. P. C. 400.

(*a*) *Muntz* v. *Grenfell*, 2 Webst. P. C. 88, 91.

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And where defendants had agreed with the owner of a patent for a canopy for fire grates that they should be at liberty, on certain terms, to make and sell grates having the patent canopy, which they were to mark in a particular manner with the name of the patentee, and an action being brought to enforce this agreement, the defendants undertook not to sell any grates having the patent canopy without marking them in the manner agreed, it was held, on a motion to commit them for a breach of this undertaking, which motion was, by consent, turned into a motion for injunction, that the defendants could not now allege that they had lately discovered that the canopies they were making were the same as those which had been sold under a patent of prior date to the plaintiff's patent, and that the plaintiff's patent was therefore invalid (*b*).

Patentee cannot after assignment dispute patent.

No one can derogate from his own grant. And, therefore, where a patentee had worked his patent in partnership with the plaintiffs, and the partnership was dissolved, and the patentee assigned to the plaintiffs all his interest in the patent, it was held that he could not set up the invalidity of the patent in a suit by the plaintiffs to restrain infringement by him, and an interlocutory injunction was granted (*c*).

So also a patentee, who had assigned his patent, was not allowed to dispute its validity in an action brought against him by the assignee for infringement (*d*).

But it does not follow that a person who has assigned a patent can be restrained from mentioning to another person matters which may show that the invention was not a new invention (*e*), or from assisting as a scientific witness or otherwise persons against whom actions are brought for infringing the patent (*f*). And such a person may show that the specification does not cover what it is alleged by the plaintiff to cover. And, notwithstanding the principle that a grantor cannot defeat his own grant, the language of the specification cannot be forced from its true construction, even if the result is to show that what was granted was valueless (*g*).

Where the plaintiff, a patentee, immediately after the grant of his patent, and before filing his specification, employed the defendants to manufacture for him, and in course of such manufacture their servants discovered, as he alleged, an improvement which the defendants requested the plaintiff to introduce into his specification,

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(*b*) *Crossthwaite* v. *Steel*, 5 R. P. C. 220.

(*c*) *Chambers* v. *Crichley*, 33 Bea. 374.

(*d*) *Oldham* v. *Langmead*, cited 3 T. R. 439; *Walton* v. *Lavater*, 8 C. B. (N.S.) 162, 187

(*e*) *London and Leicester Hosiery Co.* v. *Grimrold*, 3 R. P. C. 251, 253.

(*f*) *London and Leicester Hosiery Co.* v. *Grimrold*, *ubi supra*.

(*g*) *Hocking* v. *Hocking*, 6 R. P. C. 69.

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and to allow them, in consideration of the improvement, a share of the profits of the patent, and on the plaintiff's refusal the defendants commenced working the plaintiff's invention, an application that the plaintiff might be ordered to try the validity of the patent at law was refused, and the injunction was granted; Sir J. STUART, V.-C., observing that it was not a mere matter of course because a patent was recent to call upon the patentee to establish his right at law before granting him the relief of an injunction, but it was in the discretion of the court according to the nature of the case, and that what had mainly or altogether led to the validity of the plaintiff's patent being disputed was his refusal of the proposition made by the defendants for amalgamation (*h*).

Where patentee not estopped from disputing patent.

In *Cropper* v. *Smith* (*i*), it was held that a patentee who has become bankrupt is not estopped from disputing, on the ground of want of novelty, the validity of the patent as against a purchaser from his trustee in bankruptcy. In this case the purchasers were not shown to have relied in any way on the statements as to novelty made by the patentee in his petition for patent. If that had been shown the patentee might have been estopped from alleging want of novelty (*k*).

A patentee is not estopped from disputing the validity of his patent either by matter of record, on the ground that the letters patent were of record, or by deed, by reason of the specification being under his seal (*l*).

Defendant not disputing patent in earlier proceedings.

Where the defendant, a foreign manufacturer, had, in a previous action brought against his agent, declined to assist in the defence, and the agent had submitted to an injunction, and the plaintiff had had eight years' undisturbed enjoyment, an injunction was granted until the validity of the patent could be established (*m*).

And a defendant, who in an action for infringement submitted to a perpetual injunction, was not allowed, on a motion to commit for breach of the injunction founded on a sale by the defendant of an instrument different from that which was in question in the action, to dispute the validity of the patent, or the fact that the instrument sued on in the action was an infringement (*n*).

And a defendant who, having been sued in Scotland in an action which was decided in favour of the validity of the patent, had not

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(*h*) *Clark* v. *Ferguson*, 1 Giff. 184. See also *Gardner* v. *Broadbent*, 2 Jur. (N.S.) 1041.

(*i*) 26 Ch. D. 700; affirmed on this point, 10 App. Cas. 249.

(*k*) See judgment of COTTON, L.J., 26 Ch. D. 706.

(*l*) *Cropper* v. *Smith*, *ubi supra*.

(*m*) *Betts* v. *Menzies*, 3 Jur. (N.S.) 337.

(*n*) *Thomson* v. *Moore*, 6 R. P. C. 426; 23 L. R. Ir. 599; 7 R. P. C. 325 (H.L.).

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raised in that action the defence of want of novelty of the invention, was not allowed to set up this defence in answer to an application in England for an interlocutory injunction to restrain the infringement of the same patent (*o*).

And where, in an action for infringement, the judge had found that the patent was valid, but that the defendants had not infringed, it was held in a subsequent action by the same plaintiffs against the same defendants that the validity of the patent was *res judicata*, and that the defendants could not dispute the patent even though they had new evidence against the patent which they did not know of in the first action (*p*).

And where, in an action for infringement, the patentee agreed to accept the decision of the judge on the question of disconformity between the provisional and final specification, and the action was dismissed on this ground, and also on the ground of want of novelty in the invention, and the patentee subsequently amended his specification so as to get rid of the last objection, but not further, it was held in a subsequent action against the same defendant on the amended specification that the plaintiff had agreed that the decision on the question of disconformity should be final, and the action was dismissed (*q*). And in the same case the court declined to express an opinion whether if there had been no undertaking the patent was after amendment to be considered as a new patent, so as to enable the plaintiff to raise again the question of disconformity decided against him in the first action (*r*).

But where proceedings in Chancery had been taken against a defendant in the course of which the validity of the patent was questioned, and the matter being referred to arbitration, the arbitrator found that the patent was not void or invalid, it was held that, in an action at law between the same parties to recover damages for infringement, the defendant was not estopped from disputing the validity of the patent (*s*).

And in *Axmann* v. *Lund* (*t*), where two persons had in partnership worked for their common benefit a patent belonging to one of them, and had together asserted its validity as against infringers, but having been advised that the specification was bad had refrained from taking legal proceedings, it was held by Sir R. MALINS, V.-C., that after the determination of the partnership the other partner was at liberty to dispute the validity of the patent (*u*).

(*o*) *Dudgeon* v. *Thomson*, 30 L. T. (N.S.) 244.

(*p*) *Shoe Machinery Co.* v. *Cutlan* (No. 2), 13 R. P. C. 141; [1896] 1 Ch. 667.

(*o*) *Horrocks* v. *Stubbs*, 13 R. P. C. 69.

(*r*) 13 R. P. C. 73.

(*s*) *Newall* v. *Elliott*, 1 H. & C. 797.

(*t*) L. R. 18 Eq. 330.

(*u*) These circumstances appear to distinguish this case from *Muntz* v. *Grenfell*, *ante*, p. 259, which does not appear to have been cited in *Axmann* v. *Lund*.

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Although one of several partners may be debarred by his acts from disputing the patent, there is no estoppel against the other partners who have not been concerned in such acts, and therefore, where a plaintiff sued two partners for infringement of a patent which had been granted to one partner, and by him assigned to the plaintiff, it was held that, although one partner was estopped, the other partner was at liberty to dispute the validity of the patent (*x*).

Defendant may be estopped on application for interlocutory injunction, though not at the trial.

A defendant may, by his conduct, be estopped from disputing the validity of the patent on an application for an interlocutory injunction where he is not so estopped at the trial. Thus, when the defendants had submitted to an action for infringement, and given judgment and paid costs, it was held by Sir W. P. WOOD, V.-C., on the hearing of a suit against the same defendants for infringing the same patent, that if the present had been an interlocutory application, plaintiffs would have been entitled to an injunction till the hearing, but that the question being as to a perpetual injunction, the right of the defendants to deny the validity of the patent was not barred (*y*).

Where a defendant proves non-infringement there is nothing in the nature of estoppel to prevent the court finding in his favour, because at some time he had stated that he had infringed (*z*).

When real doubt as to infringement, injunction refused.

The rules above stated only apply where the sole question between the parties is the validity of the patent (*a*). If there is a real doubt as to whether the patent has been infringed, the interlocutory injunction will be refused.

Thus, where the plaintiffs sued upon certain patents, of one of which there had been ten, and of the others seven and five years' enjoyment, Lord COTTENHAM, C., refused the injunction entirely on the ground of uncertainty as to the infringement, and, referring to the evidence on this point, which was very conflicting, said: "It would be rash in me if I were to give any opinion coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If, in a question so open to doubt as this, I should interfere with the defendant, I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected

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(*x*) *Heugh* v. *Chamberlain*, 25 W. R. 742. See also *Goucher* v. *Clayton*, 11 Jur. (N.S.) 107.

(*y*) *Goucher* v. *Clayton*, 11 Jur. (N.S.) 107.

(*z*) *Osborne* v. *Board*, 13 R. P. C. 740, 749.

(*a*) *Electric Telegraph Co.* v. *Nott*, 11 Jur. 157; *S.C.* 2 Coop. C. C. 41; *Neilson* v. *Thompson*, 1 Webst. P. C. 277; *Stevens* v. *Keating*, 2 Webst. P. C. 179.

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with anything claimed by the plaintiffs. I may not be satisfied that these gentlemen are right, or that the plaintiffs are wrorg, but I am satisfied that the case is not one so free from doubt as to justify me in interfering" (*b*).

So where, on a patent six years old, an *ex parte* injunction had been obtained, and, on a motion to dissolve, the question of infringement was the only question raised, Sir L. SHADWELL, V.-C., dissolved the injunction, and, after pointing out that the alteration made by the defendants was not merely colourable, but *primâ facie* a decided improvement, said that that was the proper question for a jury to consider (*c*). And in *Muntz* v. *Vivian* (*d*), where the invention was the manufacture, by means of an alloy of zinc and copper in such proportions as will alone effect such purpose, of metal plates which may be rolled into slips at a red heat, and the defendants filed affidavits showing that they rolled cold, the same learned judge refused an interlocutory injunction.

Where, however, upon the material before it, the court can come to the conclusion that what is complained of is in substance an invasion of the plaintiff's patent, it will grant an interlocutory injunction, reserving to itself the right of finally deciding the question of infringement at the trial (*e*). And for this purpose a *primâ facie* case of infringement is sufficient (*f*). And one instance of a clear infringement is sufficient ground for an injunction (*g*).

The mere possession of instruments made in infringement of a patent is of itself a ground for injunction ; and an allegation of no intention to infringe will not prevent the injunction being granted (*h*).

Undertaking instead of injunction.

A plaintiff proving infringement is not entitled to an injunction as a matter of course, and where the infringement was small, and the defendant offered to give an undertaking not to infringe, the court accepted the undertaking and refused to grant an injunction (*i*).

Expressed intention to infringe sufficient to found injunction.

And where there is a deliberate intention expressed and about to be carried into execution to infringe letters patent under the claim of a right to use the invention patented, the plaintiff will be entitled to an

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(*b*) *Electric Telegraph Co.* v. *Nott*, 11 Jur. 157 ; *S.C.* 2 Coop. C. C. 41.

(*c*) *Morgan* v. *Seward*, 1 Webst. P. C. 168.

(*d*) 2 Webst. P. C. 87.

(*e*) *Thorn* v. *Worthing Skating Rink Co.*, 6 Ch. D. 415, 418, n. ; *Howes* v. *Webber*, 11 R. P. C. 586. See also *Grafton* v. *Watson*, 51 L. T. (N.S.) 143.

(*f*) See *Briggs* v. *Lardeur*, 1 R. P. C. 128 ; *Shillito* v. *Larmuth*, 2 R. P. C. 1, 3.

(*g*) *United Telephone Co.* v. *Sharples*, 29 Ch. D. 164, 169.

(*h*) *United Telephone Co.* v. *London, etc. Telephone Co.*, 26 Ch. D. 766 ; *Adair* v. *Young*, 12 Ch. D. 13.

(*i*) *Jenkins* v. *Hope*, 13 R. P. C. 57.

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injunction without proving actual infringement, provided, of course, that what is threatened to be done would be an infringement (*k*).

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And where an action was brought against the master of a ship, which was fitted exclusively with pumps which were an infringement of a patent, but the defendant was not a part owner, and had had nothing to do with putting the pumps on board, and they had never been worked in British waters, it was held by the Court of Appeal (*dissentiente* JAMES, L.J.), affirming a decision of BACON, V.-C., that the injunction must be granted, on the ground that the master, under the circumstances, must be considered as intending to use the patented invention (*l*).

And where the defendants had opposed the grant of a patent, and had infringed between the filing and acceptance of the specification, and had also infringed after the action was brought, it was held, that although there could be no action for the first infringements by reason of s. 13 of the Act, and the second infringements being after action commenced would not sustain the action, and therefore no damages could be awarded, there was evidence of an intention to infringe, and an injunction was granted (*m*).

Infringements after action brought.

If the action is based on threats to infringe, care must be taken that the defendant shall have fair notice of the special infringement he is alleged to be contemplating, and then if after action brought he commits that special infringement, or substantially that infringement, evidence of it can be given, as it is evidence to show that the plaintiff was right in his allegation that at the date of the action the defendant was threatening and intending to infringe. If the action is based on past infringements, and the plaintiff finds that the defendant has since action brought infringed in a way substantially different from his former infringements, leave would be given by the court to the plaintiff in a proper case and on proper terms to amend his action and bring those subsequent infringements before the court to be dealt with once for all with the prior infringements (*n*).

But where the plaintiffs at the trial of an action of the latter class admitted that the machines mentioned in the particulars of breaches were not in fact infringements, and, without asking to amend, offered evidence to prove as infringements mechanism of a different character, and which was made for the first time after action brought, such evidence was rejected (*o*).

(*k*) *Frearson* v. *Loe*, 9 Ch. D. 48, 65.

(*l*) *Adair* v. *Young*, 12 Ch. D. 13.

(*m*) *Dowling* v. *Billington*, 7 R. P. C. 191.

(*n*) See *per* ROMER, J., *Shoe Machinery* v. *Cutlan*, 12 R. P. C. 342, 358, 359.

(*o*) *Shoe Machinery* v. *Cutlan*, *ubi supra*.

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The plaintiff's evidence on an application for an injunction should show distinctly the manner in which the alleged infringement has taken place (*p*).

The court will, in general, at any time previously to the hearing of the motion, postpone the hearing to allow time for the filing of affidavits; but affidavits filed after the hearing has begun will not be allowed to be read (*q*).

But an undertaking to keep an account of sales was held, in the case of a patent nearly fourteen years old, not sufficient to induce the court to allow the motion for injunction to stand over for scientific evidence, the defendants refusing to undertake not to continue working (*r*).

Injunction refused, defendant ordered to keep an account.

Where, under the old practice, the injunction was refused on the ground that the validity of the patent had not yet been established, and the plaintiff was directed to take steps to try the right, the defendant was directed to keep an account of all things made or sold by him according to the patented invention (*s*); and in *Jones* v. *Pearce* (*t*), Sir L. SHADWELL, V.-C., said that when this course would afford the court ample means of doing justice to the plaintiff should his right be established, the court rarely granted the interim injunction, the profits made by the defendant being generally no very inadequate compensation to the plaintiff for the infringement.

And, under the present practice, when the injunction is refused, the usual course is that defendant must undertake to keep an account (*u*); and this is the rule, even when the injunction is refused on the ground of delay (*x*). But the injunction may be refused although the defendant will not undertake to keep an account (*y*).

And this course was followed where the patent was of very recent date and there was doubt as to the infringement, and there had been an agreement between the patentees of the plaintiff's process and the defendant not to oppose the formation of a company for purchasing his invention which was now complained of as an infringement (*z*).

(*p*) *Hill* v. *Thompson*, 1 Webst. P. C. 231.

(*q*) *Electric Telegraph Co.* v. *Nott*, 11 Jur. 273.

(*r*) *Read* v. *Andrew*, 2 R. P. C. 119.

(*s*) *Bacon* v. *Jones*, 4 M. & C. 436; *Hill* v. *Thompson*, 3 Mer. 626; *S.C.* 1 Webst. P. C. 232; *Morgan* v. *Seward*, 1 Webst. P. C. 169; *Neilson* v. *Thompson*, 1 Webst. P. C. 286. For the common form of order, see Seton p. 548.

(*t*) 2 Coop. C. C. 58.

(*u*) *Jackson* v. *Needle*, 1 R. P. C. 176; *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 38; *Bacon* v. *Jones*, 4 My. & Cr. 436.

(*x*) *Borill* v. *Crate*, L. R. 1 Eq. 388; *Neilson* v. *Thompson*, 1 Webst. 286; *Lister* v. *Norton*, 1 R. P. C. 114.

(*y*) *British Tanning Co.* v. *Groth*, 7 R. P. C. 1.

(*z*) *Ibid.*

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When a defendant had undertaken to keep an account of all monies received by reason of the manufacture or sale of the alleged infringing articles and had paid a sum of money into court, the court refused to grant an interlocutory injunction against the defendant's customers (*a*).

Form of account.

A question may arise as to the form of this account. In *Neilson* v. *Thompson*, the account was not only for the time to come, but from the commencement of the infringement (*b*). On the other hand, in *Vidi* v. *Smith* (*c*), the Court of Queen's Bench said that a retrospective account should not be granted before final judgment. And the observations of Baggallay, L.J., in *Plimpton* v. *Spiller* (*d*), seem to imply that the account should be prospective only.

In *Plimpton* v. *Malcolmson* (*e*), and in *Russell* v. *Cowley* (*f*), the account was of "all moneys received or to be received" by the sale of the patented articles. But in some cases the account has referred only to the articles.

Thus, in *Beardsell* v. *Schwann* (*g*), the account was of "all mohair cloths and other textile fabrics finished by or for the defendants in the manner in the plaintiff's bill complained of." And in *Edison, etc., Co.* v. *Holland* (*h*), the undertaking was to keep an account of "all lamps alleged to be an infringement of the patent which the defendants may now be using or may hereafter use or which they may have used since" a date named (the date of judgment in a previous action).

Injunction granted, plaintiff required to give undertaking as to damages.

It appears at one time to have been unusual for the court, in granting the interlocutory injunction, to require from the plaintiff any undertaking as to indemnifying the defendant in case it should ultimately turn out that the patent is bad, and that the injunction, therefore, ought not to have been granted (*i*), and there is no doubt of the competency of the court to grant an interlocutory injunction *simpliciter* (*k*). But this undertaking was required by Sir J. L. Knight-Bruce, V.-C., in *Muntz* v. *Grenfell* (*l*). And it is now settled that the court will always require it on granting the interlocutory injunction (*m*), and this not merely on *ex parte* applications, but also on injunctions granted upon motion after notice (*n*). But this does not apply to an order which is not

(*a*) *Pneumatic Tyre Co.* v. *Goodman*, 13 R. P. C. 723.

(*b*) 1 Webst. 286.

(*c*) 3 E. & B. 969.

(*d*) 4 Ch. D. 291.

(*e*) Seton, 548.

(*f*) 1 Webst. 458.

(*g*) Seton, 3rd ed. p. 910. See also *Hill* v. *Thompson*, 3 Mer. 626; *Jackson* v. *Needle*, 1 R. P. C. 176.

(*h*) Edmunds on Patents, 2nd ed. p. 837.

(*i*) *Bickford* v. *Skewes*, 1 Webst. 214; *Tuck* v. *Silver*, Johnson, 218.

(*k*) *Bacon* v. *Jones*, 4 My. & Cr. 436; *Wilson* v. *Tindal*, 1 Webst. P. C. 730.

(*l*) 2 Webst. 91. See the order, 2 Coop. C. C. 59.

(*m*) *Chappell* v. *Davidson*, 8 D. M. & G. 1.

(*n*) *Tuck* v. *Silver*, Johns. 218; *Wakefield* v. *Duke of Buccleuch*, 11 Jur. (N.S.) 523; *Graham* v. *Campbell*, 7 Ch. D. 491.

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interlocutory in the sense of not being interim or which leaves nothing for decision at a future time, and, therefore, where an injunction was granted to restrain certain advertisements pending an action for infringement no undertaking as to damages was required (*o*).

The undertaking is required even where the patent has been established in previous suits (*p*), and was required where the defendant in the present suit was one of a number of persons who had formed themselves into an association for the purpose of contesting the patent, and who had actually found the funds for defending one of the previous suits in which the plaintiff had obtained a decree in his favour (*q*). So also where issues involving the validity of a patent had been directed in a suit and found in the plaintiff's favour, and the plaintiff applied for an interlocutory injunction, the undertaking as to damages was required, the defendant having offered to keep an account (*r*).

For the forms of the undertaking and of the inquiry thereon as to damages, see Seton, pp. 452, 453. The ultimate dismissal (*s*) or discontinuance (*t*) of the action does not put an end to the undertaking, and it can be enforced when the injunction has been wrongly granted owing to a mistake of law by the judge (*u*). As to the time within which application to enforce the undertaking should be made, see *Ex parte Hall* (*x*).

The undertaking may be given by a married woman (*y*), and may be enforced against a married woman suing her husband, notwithstanding s. 12 of the Married Women's Property Act, 1882 (*z*).

The undertaking applies to all the defendants asking for it, though the injunction may not be granted against all (*a*).

The costs of the inquiry as to damages are provided for in the usual form of order for the inquiry (*b*), and need not be reserved (*c*).

Injunction granted on terms.

When, on a motion for injunction to restrain infringement of a patent which had been established in a former action, the defendants alleged that the plaintiffs had contracted to supply them with certain machines

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(*o*) *Fenner* v. *Wilson*, 10 R. P. C. 283; [1893] 2 Ch. 656.

(*p*) See *United Telephone Co.* v. *Tasker*, 5 R. P. C. 628, 633.

(*q*) *Borill* v. *Smith*, W. N. 1867, 240.

(*r*) *Renard* v. *Levinstein*, 2 H. & M. 628, 634.

(*s*) *Newby* v. *Harrison*, 3 D. F. & J. 287; *Graham* v. *Campbell*, 7 Ch. D. 491.

(*t*) *Newcomen* v. *Coulson*, 7 Ch. D. 764.

(*u*) *Griffith* v. *Blake*, 27 Ch. D. 474, dissenting from the dictum of JESSEL, M. R., in *Smith* v. *Day*, 21 Ch. D. 421. See also *Hunt* v. *Hunt*, 54 L. J. Ch. 289; *Rothwell* v. *King* (No. 2), 4 R. P. C. 76.

(*x*) 23 Ch. D. 644.

(*y*) *Re Prynne*, W. N. 1883, p. 144.

(*z*) *Hunt* v. *Hunt*, *ubi supra*.

(*a*) *Tucker* v. *New Brunswick, etc., Co.*, 44 Ch. D. 249.

(*b*) *Burdett* v. *Hay*, Seton, p. 453: *Hunt* v. *Hunt*, *ubi supra*.

(*c*) *Rothwell* v. *King* (No. 2), 4 R. P. C. 76.

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to carry on their business, and had broken the contract, it was held that this fact did not justify the infringement; but the injunction was granted only on the terms that the plaintiffs should supply the defendants with a certain limited number of machines in the place of those which the injunction would prevent the defendants from using (*d*).

When questions both as to validity of patent and fact of infringement.

It has been said by Lord Eldon that where there is one question as to whether the patent is valid, and another question whether it has been infringed, the court would be going a long way if it took upon itself to grant an injunction (*e*). In such cases it depends on the degree of doubt which exists on these questions whether the court will grant the interim injunction. It will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction (*f*). And in *Plimpton* v. *Malcolmson* (*g*) Sir George Jessel, M.R., said that, when it appears that there is a serious question to be tried at the hearing, it is not the course of the court to grant an injunction on an interlocutory application.

In order to obtain an interlocutory injunction, the plaintiff must make out a *primâ facie* case, that is, that, if the evidence remains as it is, it is probable that at the hearing he will get a decree in his favour. Unless the court is so satisfied, the injunction ought not to be granted (*h*).

Court considers best mode of keeping things *in statu quo*.

The court on the interlocutory application avoids as far as possible expressing an opinion on the merits of the case (*i*), and will endeavour to ascertain what is the best method of keeping things *in statu quo*, either by granting an injunction and requiring from the plaintiff the undertaking as to damages, or by refusing the injunction, and requiring the defendant to keep an account (*k*).

Circumstances leading to refusal of injunction

Where granting the injunction would be extremely prejudicial to the defendant, and do no possible good to the plaintiff, the injunction will be refused (*l*).

Thus, in *Morgan* v. *Seward* (*m*), where a contract had been entered into by defendant, and justice could be done to the plaintiff by directing the defendant to keep an account, the injunction was refused.

(*d*) *United Telephone Co.* v. *Tasker*, 5 R. P. C. 628.

(*e*) *Wood* v. *Cockerell*, 2 Coop. C. C. 58.

(*f*) *Per* Lord Langdale, *Bridson* v. *McAlpine*, 8 Ben. 230.

(*g*) L. R. 20 Eq. 38.

(*h*) *Challender* v. *Royle*, 36 Ch. D. 425, 436, Cotton, L.J. See also *Preston* v. *Luck*, 27 Ch. D. 497, 506.

(*i*) *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 38.

(*k*) *Plimpton* v. *Spiller*, 4 Ch. D. 289.

(*l*) *Neilson* v. *Thompson*, 1 Webst. 275, 285.

(*m*) 1 Webst. 169.

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Circumstances in favour of injunction.

But in estimating the balance of convenience and inconvenience the court will consider as a circumstance in favour of an injunction that the defendant's trade is a new trade, and that if the injunction were refused the plaintiff would be driven to commence actions against the purchasers from and customers of the defendant (*n*). And in a design case, where defendants had admittedly gone as near to plaintiff's design as they thought they safely could, the interlocutory injunction was granted on the balance of convenience and inconvenience (*o*).

An interlocutory injunction is usually granted only in general terms (*p*).

If a *primâ facie* case has been made out, and the judge below has granted an injunction, the Court of Appeal will not interfere with that exercise of his discretion (*q*).

The circumstance that the old practice (*r*) is no longer in force under which, except in special cases, an injunction was not granted until the patent had been established at law, has not altered the practice of the court in granting interlocutory injunctions, though it may introduce considerations with which the court must deal on the question whether an injunction should be granted or not (*s*). The patentee may, if the injunction be granted, be put upon terms to bring the action to trial as speedily as possible (*t*), and this course was adopted in *Renard* v. *Levinstein* (*u*).

Under the old practice, if a plaintiff, having been put upon terms to try the action as speedily as possible, was guilty of undue delay, the injunction was dissolved (*x*).

Ex parte injunctions.

Where an injunction is applied for *ex parte*, it is incumbent on the party making the application to swear, at the time of making it, that he is the original inventor; for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information have been communicated, sufficient to convince him that it was not his

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(*n*) *Plimpton* v. *Spiller*, 4 Ch. D. 286, 292. See also *Read* v. *Richardson*, 45 L. T. 54, 58.

(*o*) *Grafton* v. *Watson*, 51 L. T. (N.S.) 143 (C. A.).

(*p*) *Edison Bell Phonograph Co.* v. *London Phonograph Co.*, 11 R. P. C. 193; *Plimpton* v. *Spiller*, Seton, 547.

(*q*) *Baker* v. *White*, 1 Times R. 65.

(*r*) *Bacon* v. *Jones*, 4 My. & Cr. 436; *Jones* v. *Pearce*, 2 Coop. C. C. 58.

(*s*) *Davenport* v. *Jepson*, 4 D. F. & J. 440, 445, 446.

(*t*) *Davenport* v. *Jepson*, 4 D. F. & J. 448.

(*u*) 10 L. T. (N.S.) 94; *S.C.* on App., *Ibid.* 177.

(*x*) *Stevens* v. *Keating*, 2 Ph. 333; 2 Webst. P. C. 180. See also *Bell* v. *Bell*, 14 Jur. 1129; *Heath* v. *Unwin*, 14 Jur. 1129; *Baker* v. *McClellan*, 27 L. J. (N.S.) 57; *Arnold* v. *Thomson*, 9 Jur. (N.S.) 436.

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own original invention, and that he was under a mistake when he made his previous declaration (*y*).

This rule was recognised by Lord LYNDHURST, C., in *Sturtz* v. *De la Rue* (*z*), and though this was an application for an *ex parte* injunction, the words of the judgment are wide enough to include all cases of interlocutory injunction, whether applied for *ex parte* or on notice; and it is remarked by Mr. Hindmarch that the reason for the rule laid down by Lord ELDON in *Hill* v. *Thompson*, as above mentioned, is quite as much applicable to the case of an application after notice as to a motion for an injunction *ex parte*, and that there can be little doubt that the rule was intended to apply to all interlocutory applications for injunction (*a*), and this view appears to be correct (*b*).

The court expects the utmost good faith from a plaintiff seeking an *ex parte* injunction. The plaintiff must state to the court all the facts in his knowledge which are material to the question whether the injunction ought to be granted, and it is no excuse for the plaintiff to say that he was not aware of the importance of such facts, and the omission to bring those facts under the notice of the court when the *ex parte* injunction was obtained is a sufficient ground for dissolving it (*c*). And it is a rule without exception that, if the defendant has appeared, the plaintiff must inform the judge of the fact. *Ex parte* injunctions may be, but are not usually, granted when the defendant has appeared (*d*).

According to the usual practice *ex parte* injunctions are not now granted. The court generally grants an interim order restraining the defendant till after a day named, liberty being given to the plaintiff to serve notice for an injunction for the day before such day. The plaintiff is also required to give an undertaking to abide by the order of the court as to any damages the defendant may be put to by reason of the interim order, and such other terms are imposed on him as the case may require (*e*).

And if the interim order is irregularly obtained in consequence of a suppression of facts the court may, on the hearing of a motion for an injunction or in the alternative to continue the interim order, discharge the *ex parte* order without any cross notice of motion for that purpose

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(*y*) *Hill* v. *Thompson*, 3 Mer. 624; *S.C.* 1 Webst. P. C. 231.

(*z*) 5 Russ. 322, 329. See also *Gardner* v. *Broadbent*, 2 Jur. (N.S.) 1041.

(*a*) Hindmarch on Patents, 334.

(*b*) *Whitton* v. *Jennings*, 1 Dr. & Sm. 110; *Mayer* v. *Spence*, 1 J. & H. 87; *Clarke* v. *Nichols*, 12 R.P.C. 310.

(*c*) *Dalglish* v. *Jarvie*, 2 Mac. & G. 231. See *Curtis* v. *Cutts*, 3 Jur. 34.

(*d*) *Mexican Co. of London* v. *Maldonado*, W. N. 1890, 8.

(*e*) Daniell's Chancery Practice, 6th ed. p. 1611.

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by the defendant, though the court may upon the evidence on the plaintiff's motion grant the injunction (*f*).

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Where two persons had obtained patents for the same invention, the court would not interfere between them by interlocutory injunction, but left them to try the legal right by *scire facias* (*g*) (now by petition of revocation, s. 26).

Application for interlocutory injunction to be made without delay.

A patentee desiring to obtain an interlocutory injunction must apply to the court without delay. If the application be *ex parte*, it should be at the earliest possible period, and if upon notice, it should be made early (*h*). If this rule be not complied with, the injunction will be refused. And the rule will be enforced even where there have been previous suits in which the validity of the patent has been established against other defendants. Thus, in *Bridson* v. *Benecke*, cited above, the patent had been established in a previous suit against one McAlpine, but the present bill was not filed till December, although the plaintiff knew of the infringement in January, and gave the defendant notice to desist. Lord LANGDALE, M.R., refused the injunction, notwithstanding he had a strong impression in favour of the plaintiff's right.

Delay fatal to injunction even though patent established in previous actions.

Again, in *Borill* v. *Crate* (*i*), there had been several previous suits, but the plaintiff, having knowledge in August of the defendant's proceedings, and having written in November to complain of the infringement, and being told by the defendant's solicitor in the following April that service of a bill would be accepted on defendant's behalf, did not file a bill till July; the injunction was refused on the ground of delay (*k*).

And in *Greer* v. *Bristol Tanning Co.* (*l*), an application on December 2nd for an interim order to restrain infringements, which plaintiff knew of on November 13th and 23rd, was held too late, but leave was given to serve notice of motion.

And where the action was not brought till June although the plaintiff had known of the alleged infringement in December, but it was alleged that there were a nnmber of small infringers of no means, who, if proceeded against, contested the matter till the day of trial and

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(*f*) *Boyce* v. *Gill*, W. N. 1891, 108.

(*g*) *Copeland* v. *Webb*, 11 W. R. 134; *S.C.* 1 N. R. 119. See also *Baskett* v. *Cunningham*, 2 Ed. 137.

(*h*) *Bacon* v. *Jones*, 4 My. & Cr. 438; *Bridson* v. *Benecke*, 12 Ben. 1, 3; *Baxter* v. *Coombe*, 1 Ir. Ch. R. 284.

(*i*) L. R. 1 Eq. 388.

(*k*) See also *Smith* v. *London and South-Western Rail. Co.*, Mner. P. C. 209; *S.C.* Kay, 417; *North British Rubber Co.* v. *Gormully, etc., Co.*, 12 R. P. C. 17; *Lister* v. *Norton*, 1 R. P. C. 114; *Leonhardt* v. *Kalle*, 11 R. P. C. 531; *Aluminium Co.* v. *Domeiere, etc., Actien Gesellschaft*, 15 R. P. C. 32.

(*l*) 2 R. P. C. 268. See also *Thomson* v. *Batty*, 4 Times R. 36.

then disappeared, on the defendant undertaking to pay a sum into court, and to keep the usual account, the interlocutory injunction was refused, the action to be prosecuted without delay (*m*).

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On the other hand, delay was held no bar to an interlocutory injunction where the plaintiff, having established his patent in several previous suits, and there being a combination of persons against him *interested in resisting his claims, had not filed bills against the* separate members of this combination until he had succeeded in again establishing his patent in a suit against one of them (*n*).

When delay no bar.

And where the plaintiff, having known of the infringement on March 23rd, spent some time in making inquiries, on May 8th gave notice to the defendant to desist, and, after some correspondence, filed his bill on July 7th, he was held to have come in sufficient time, and the injunction was granted (*o*).

So also where the solicitor of a company formed to work certain patents wrote, shortly after its incorporation, to the plaintiffs in February, 1887, that the company were about to manufacture instruments which might be alleged by the plaintiffs to be infringements, and offered inspection, and the plaintiffs, who had already been engaged in extensive litigation in which they had established their patent, took no notice of the letter, and did not bring an action till March, 1888, shortly after the company had actually begun to manufacture, and alleged that they had been advised not to commence proceedings until they found the company had a substantial capital, and were actually infringing, the delay was held to be sufficiently explained (*p*).

And the mere existence of a rival patent of the defendant is no ground of itself for imputing to the plaintiff knowledge of the defendant's infringement so as to affect the plaintiff with *laches* (*q*). And a defendant cannot avail himself of the plaintiff's *laches* with respect to a person not a defendant (*r*).

If there is an independent case, such as *laches*, against the motion for injunction, the better course is to order the motion to stand to the trial if the defendant asks for it; but when the case on the motion is the same as the case at the trial, the proper course is to make the costs of the motion costs in the action (*s*).

(*m*) *Edison Bell Phonograph Co.* v. *Hough*, 11 R. P. C. 594. See also *North British Rubber Co.* v. *Gormully, etc., Co., ubi supra.*

(*n*) *Bovill* v. *Smith*, W. N. 1867, 240.

(*o*) *Losh* v. *Hague*, 1 Webst. P. C. 201.

(*p*) *United Telephone Co.* v. *Equitable Telephone Association*, 5 R. P. C. 233.

(*q*) *Osmond* v. *Hirst*, 2 R. P. C. 265, 267.

(*r*) *Pneumatic Tyre Co.* v. *Warrilow*, 13 R. P. C. 284.

(*s*) *Lister* v. *Norton*, 1 R. P. C. 114.

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Where the costs of a motion for injunction which was refused on the ground of *laches* were reserved, and the plaintiff succeeded at the trial, the costs of the motion were made costs in the action (*t*).

Acquiescence.

Acquiescence by the plaintiff in defendant's proceedings will also defeat the right to an interlocutory injunction. Thus, in *Neilson* v. *Thompson* (*u*), the plaintiff, not being himself a manufacturer, and whose practice was not to work the invention himself, but to grant licences under his patent, had permitted the defendants to erect their works on the expectation that they would take a licence to use the invention on the terms on which other licences had been granted, and had expressed his willingness to grant the defendants a licence on those terms. The defendants began to work the invention without the licence of the plaintiff: but it was held upon the defendants undertaking to keep an account, and to deal with that account as the court might direct, that the acquiescence was a bar to an injunction (*x*).

Delay no bar at trial.

At the trial, however, the court decides on the rights of the parties, and therefore it may be that delay or acquiescence, which would be fatal to an interlocutory application, will not necessarily debar a plaintiff from obtaining an injunction at the trial (*y*). Mere delay to enforce a legal right is no bar to an action, unless the delay is such as to cause a statutory bar (*z*). But acquiescence may be a ground for refusing an account of profits (*a*), or for limiting it to the date of commencing the action (*b*), or for granting damages instead of an injunction (*c*).

Where the patentee brought an action for infringement against purchasers from a rival manufacturer, and the defendants set up a case of acquiescence, and proved that the patentee, knowing of their intention to purchase, and believing the rival machines to be infringements, had called on the defendants and asked them to try his machine, but without intimating that he considered the other machine an infringement, it was held that as the defendants did not allege, and there was no reason to suppose, that they were ignorant of the plaintiff's patent, or that the plaintiff supposed them to be ignorant of it, the plaintiff

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(*t*) *Thomson* v. *Batty*, 6 R. P. C. 84, 109.

(*u*) 1 Webst. 275, 285.

(*x*) *Neilson* v. *Thompson*, 1 Webst. P. C. 287.

(*y*) *Johnson* v. *Wyatt*, 2 D. J. & S. 18, 25; *Fullwood* v. *Fullwood*, 9 Ch. D. 176; *Rowland* v. *Michell*, 14 R. P. C. 37, 45.

(*z*) *Three Towns Banking Co.* v. *Maddever*, 27 Ch. D. 531. See also observations of PEARSON, J., *Wood* v. *Lambert*, 3 R. P. C. 84.

(*a*) *Crossley* v. *Beverley*, 1 Webst. 120; *Harrison* v. *Taylor*, 11 Jur. (N.S.) 408; *Beard* v. *Turner*, 13 L. T. (N.S.) 746.

(*b*) *Ford* v. *Foster*, L. R. 7 Ch. 627, 634.

(*c*) *Sayers* v. *Collyer*, 28 Ch. D. 103, FRY, L.J.

had not, on the ground of acquiescence or estoppel, lost his right to bring the action (*d*).

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And where the plaintiff knew of the defendant's infringement in July, 1886, and a correspondence took place between the parties and their respective solicitors, but the action was not brought till March, 1888, it was held at the trial that there had been no acquiescence to bar the plaintiff's right to relief (*e*).

But where the plaintiff, having a common law trade mark, had been aware of its use by other persons than the defendant and had not attacked them, though one of such persons had expressly declined to discontinue the use of the mark, an action against the defendant for infringement was dismissed (*f*).

INJUNCTION (PERPETUAL).

If the plaintiff establishes the validity of his patent and the fact of infringement, he will obtain judgment for a perpetual injunction to restrain infringment, and may also have further relief in the shape of damages or account of profits.

Perpetual injunction.

But the court will not grant such perpetual injunction unless the validity of the patent has been conclusively established (*g*).

And an injunction is not a matter of course at the trial. When the defendant had infringed inadvertently and had subsequently made an offer to undertake not to infringe and to pay costs and damages, which the court considered ought to have been accepted, the court declined to grant an injunction, but accepted the defendant's undertaking (*h*).

If the plaintiff moves for judgment on admission in the pleadings under S. C. R. Order XXXII. r. 6, he is bound to accept as true the statements of fact in the defence; and therefore where defendant *admitted in his defence ten infringements, but denied any further* infringements, an *inquiry* as to damages was refused, except as to the ten instances (*i*).

Where persons had been brought in by the defendants under the third-party rules as liable to indemnify the defendants, but had not *been made defendants to the action, though they had, in fact, had the* conduct of the defence, it was held by the court of appeal that no injunction could be granted against them. They were, however, ordered to pay costs (*k*).

(*d*) *Proctor* v. *Bennis*, 36 Ch. D. 741.

(*e*) *Shaw* v. *Jones*, 6 R. P. C. 329.

(*f*) *Ripley* v. *Bandey*, 14 R. P. C. 591, 944.

(*g*) See *Hill* v. *Evans*, 4 D. F. & J. 288, 289.

(*h*) *Jenkins* v. *Hope*, 13 R. P. C. 57; and see *ante*, p. 237.

(*i*) *United Telephone Co.* v. *Donohoe*, 31 Ch. D. 399.

(*k*) *Edison, etc. Co.* v. *Holland*, 41 Ch. D. 28.

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For forms of orders for interlocutory and perpetual injunctions in patent cases, see Seton, pp. 547, 548, and 565, and Pemberton, pp. 483, 484, and 485. Names of manufacturers not parties to the action ought not to appear in the injunction, even for the purpose of identifying the machines affected (*l*).

May by consent be obtained without bringing action to trial.

If a defendant desires to submit to the plaintiff's demands, it is not necessary to bring the action to trial in order to have the injunction made perpetual.

This may be done on motion by the plaintiff with the consent of the defendant (*m*). And if the defendant submits to a perpetual injunction and to pay the costs of the action, the proceedings may be stayed without the consent of the plaintiff, when the only object of the action is an injunction (*n*), or when the plaintiff is willing to waive the other relief prayed by the statement of claim (*o*).

When an interlocutory injunction is granted the injunction may, at defendant's instance, and on his paying costs, be made perpetual as to some of the acts sought to be restained so as to get rid of that part of the case (*p*).

Since the powers of this section are conferred on "the court or a judge," an order for a perpetual injunction may be made in chambers (*q*), subject to the provisions of Order LIV. r. 12, and Order LV. r. 15.

Where defendants offered by their defence to submit to an injunction and pay costs, it was held that an order ought to have been obtained on summons in chambers, and the extra costs occasioned by bringing on the matter in court were refused (*r*).

Consent to a perpetual injunction may be withdrawn if given under mistake or surprise, but not on the mere ground of subsequent discovery of facts on which a defence may be founded (*s*).

No stay of proceedings pending appeal.

By S. C. R. 1883, Order LVIII. r. 16, there is to be no stay of proceeding pending appeal, except so far as the court appealed from, or any judge thereof, or the Court of Appeal may order. The practice on this point has not been uniform.

Under the old practice, where after a trial before the court without a jury the Vice-Chancellor found in favour of a plaintiff, and a motion for a new trial was refused by the Vice-Chancellor, and afterwards by

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(*l*) *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C 342, 359.

(*m*) *Morrell* v. *Pearson*, 12 Beav. 284. But see *Jenkins* v. *Hope*, 13 R. P. C. 57.

(*n*) *Hume* v. *Beale*, cited Seton, p. 630.

(*o*) *Curtis* v. *Pape*, 5 R. P. C. 146.

(*p*) *Curtis* v. *Pape*, 5 R. P. C. 150.

(*q*) Judicature Act, 1873, s. 39: *Frearson* v. *Loe*, 26 W. R. 138.

(*r*) *London Steam Dyeing Co.* v. *Digby*, W. N. 1888, 35; *Allen* v. *Oakey*, W. N. 1890, 121.

(*s*) *Elsas* v. *Williams*, 1 Times Rep. 144.

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the Lord Chancellor, the court refused to suspend the final order for injunction pending an appeal to the House of Lords (*t*). And a perpetual injunction granted after a trial will not be suspended pending an appeal, merely because the defendants may, by the injunction, be prevented from carrying out contracts already entered into by them to deliver the articles complained of, notwithstanding the defendants may offer to undertake as to damages (*u*).

Injunction sometimes suspended pending appeal.

But in some cases the operation of the injunction has been suspended pending appeal. Thus the injunction has been suspended for fourteen days, provided defendants gave notice of appeal within that time, defendant undertaking to keep an account of machines made by them (*x*). And defendants have been required, as a condition of stay of the injunction, to give security for the amount of damages as well as to keep an account (*y*). And the taking of the account of profits and the injunction were suspended pending appeal, on the defendant undertaking to keep an account and to appeal forthwith, liberty being given to the plaintiff to apply if the appeal was not diligently prosecuted (*z*).

And where a defendant company applied for stay of execution pending an appeal, and it appeared that they were making only for the government, a receiver was appointed to receive all moneys coming to the defendants from the government, and the injunction was stayed so far as related to the supply of articles to the government (*a*).

And an order for an attachment, for breach of an injunction by the sale of an article different from that on which the injunction was founded, was suspended pending an appeal to the House of Lords on the terms that the defendant should pay the costs (the plaintiff's solicitor undertaking to refund the same if the order should be reversed) and should keep an account of the infringing articles made and sold (*b*).

Sometimes account only stayed.

And in some cases, although the injunction has not been interfered with, the taking of the account of profits has been stayed pending appeal, on the defendant undertaking to appeal promptly (*c*). And where it appeared that the discovery given by the account would enable the plaintiff to take proceedings against the customers of the defendants,

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(*t*) *Penn* v. *Bibby*, L. R. 3 Eq. 308.

(*u*) *Flower* v. *Lloyd*, 36 L. T. (N.S.) 445.

(*x*) *Hocking* v. *Fraser*, 3 R.P.C. 7; *North British Rubber Co.* v. *Mackintosh*, 11 R. P. C. 477.

(*y*) *National Opalite, etc., Syndicate* v. *Ceralite Syndicate*, 13 R. P.C. 649.

(*z*) *Kaye* v. *Chubb*, 4 R. P. C. 23.

(*a*) *Nordenfelt* v. *Gardner*, 1 R. P. C. 63. See also *Pneumatic Tyre Co.* v. *East London Rubber Co.*, 14 R. P. C. 77, 104.

(*b*) *Thomson* v. *Moore*, 6 R. P. C. 426, 464; 23 L. R. Ir. 599. See also *Thomson* v. *Hughes*, 7 R. P. C. 71.

(*c*) *Woodward* v. *Sansum*, 3 R. P. C. 366; *Humpherson* v. *Syer*, 4 R. P. C. 184.

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and that the defendants, if ultimately successful, might find that in the meantime their business had been ruined, the Court of Appeal stayed proceedings under the account till the hearing of the appeal, the appeal being advanced (*d*).

This course, however, was not followed when the patent had been established in a previous action, and the infringement was not contested in the second action (*e*).

Delivery up of infringing articles suspended.

In *Washburn Manufacturing Co.* v. *Patterson* (*f*), the court declined to suspend the order for the delivery up of infringing machines and articles, the defendant refusing to undertake not to remove them out of the country; but subsequently, on the defendant giving this undertaking, and undertaking also to deliver up all wire made by the machines, and not to sell or import like wire into this country, the order was suspended during the appeal (*g*).

No stay of execution for costs.

When judgment was given for defendant with costs, stay of execution was refused, the defendant's solicitors giving their personal undertaking to repay any costs received by them if the judgment should be ultimately reversed (*h*). This has been said to be the usual practice (*i*). But a special reason for such an order is required by the Court of Appeal (*k*).

Staying proceedings pending appeal to House of Lords.

A motion by defendant to stay proceedings pending an appeal to the House of Lords was refused, it being admitted by the defendant that he was not now making the machines complained of, but machines of a different character, and the object being only to prevent the judgment deterring those who would otherwise buy machines from the defendant (*l*). And an application to stay a new trial pending a like appeal was refused (*m*). So also where the machines in respect of which the stay of proceedings was asked had been ordered since the commencement of the action (*n*). But defendants out of the jurisdiction obtained a stay of the injunction to enable them to decide as to an appeal on increasing the amount already in court (*o*).

(*d*) *Adair* v. *Young*, 11 Ch. D. 136.

(*e*) *Otto* v. *Steel*, 3 R. P. C. 109 121.

(*f*) 1 R. P. C. 158, 162.

(*g*) *Washburn, etc. Co.* v. *Patterson*, 1 R. P. C. 191.

(*h*) *Easterbrook* v. *Great Western Rail. Co.*, 2 R. P. C. 201, 212. See also *Merry* v. *Nickalls*, 8 Ch. 205; *Morgan* v. *Elgood*, 4 Ch. D. 387.

(*i*) *Deeley's Patent*, 12 R. P. C. 65, 75; *Ticket Punch, etc. Co.* v. *Colley's Patents*, 12 R. P. C. 1, 10; *Chadburn* v. *Mechan*, 12 R. P. C. 120.

(*k*) *Pneumatic Tyre Co.* v. *East London Rubber Co.* 14 R. P. C. 573, 590; *Badische Anilin und Soda Fabrik* v. *Johnson*, 14 R. P. C. 405, 418.

(*l*) *Proctor* v. *Bennis*, 4 R. P. C. 363.

(*m*) *Edge* v. *Johnson*, 9 R. P. C. 134, 142.

(*n*) *Lyon* v. *Goddard* (2), 10 R. P. C. 348.

(*o*) *North British Rubber Co.* v. *Gormully, etc. Co.*, 14 R. P. C. 283.

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Where the order of the court of first instance, which had been reversed by the Court of Appeal, is restored on appeal to the House of Lords, an order is necessary making the order of the House of Lords an order of the High Court of Justice (*p*). This may be obtained on *ex parte* application to the judge of the High Court to whom the action is assigned (*q*). The order is not necessary if the order of the Court of Appeal is affirmed by the House of Lords (*r*).

Breach of injunction.

It is not necessary for the plaintiff, in order to justify an application for the committal of a defendant for breach of an injunction, to show that the order granting the injunction has been served upon him, if it is proved that he had notice of the order *aliunde*, and knew that the plaintiff intended to enforce it (*s*).

A defendant will not escape committal if, while himself purporting to observe the injunction, he connives at the continuance by others of the work prohibited (*t*). And persons, though not servants or agents of the defendant or enjoined by the injunction, may be committed for contempt of court if with full knowledge of the injunction they assist the defendant in disobeying it (*u*).

After an injunction has been granted, it is no contempt to publish advertisements asking for subscriptions towards the expenses of an appeal (*v*), or advertisements asking for documentary evidence of anticipation of the patent (*x*).

Although the mere sale of the component parts of a machine is not of itself an infringement (*y*), it seems that an injunction to restrain the sale of a complete machine would be violated by the sale of the component parts of the machine in such a manner as that they may be put together by anyone (*z*).

It is, of course, open to a person charged with having committed a breach of an injunction restraining infringement of a patent to show that since the injunction the patent had ceased to be in force (*a*).

(*p*) See *Man* v. *Ricketts*, Seton, 746.

(*q*) *British Dynamite Co.* v. *Krebs*, 11 Ch. D. 448; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. 470.

(*r*) *A.-G.* v. *Scott*, 1 Ves. sen. 412, 418.

(*s*) *United Telephone Co.* v. *Dale*, 25 Ch. D. 778.

(*t*) *Graydon* v. *Bassett*, 13 R. P. C. 613, 614. See, however, *S. C.* in H. L., 14 R. P. C. 701, 711, 718.

(*u*) *Seaward* v. *Paterson*, [1897] 1 Ch. 545, and see *Graydon* v. *Bassett*, *ubi supra*.

(*v*) *Plating Co.* v. *Farquharson*, 17 Ch. D. 49.

(*x*) *Plating Co.* v. *Farquharson*, *ubi supra*.

(*y*) *M'Cormick* v. *Gray*, 7 H. & N. 25; *Townsend* v. *Haworth*, 12 Ch. D. 831, n., more fully reported 48 L. J. Ch. (N.S.) 770, Higgins, 165; *Sykes* v. *Howarth*, 12 Ch. D. 826.

(*z*) *United Telephone Co.* v. *Dale*, 25 Ch. D. 778.

(*a*) *Daw* v. *Eley*, L. R. 3 Eq. 496.

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It seems that if, after an injunction, the defendant has infringed the patent, a contempt of court has been committed, even though the defendant thought he was not infringing (*b*).

But cases may occur where breach of an injunction may be justified, and may even be a duty. Thus, where an injunction had been granted to restrain the master of a ship from using certain patented pumps with which exclusively the ship was fitted, and the judgment was affirmed by the majority of the Court of Appeal (*dissentiente* JAMES, L.J.), the following remarks were, on a subsequent day, made in reference to this case by the last-named learned judge: "Whatever appliances there may happen to be on board, however they came there, pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated, it is his (the master's) bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out to sea (injunction or no injunction), *salus navis est suprema lex*. And for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer" (*c*).

Injunction against specific article on motion to commit.

On a motion to commit for breach of an interlocutory injunction restraining infringement of a patent for skates, the skate now complained of being different from that which was put in evidence on the application for the injunction, the court, being of opinion that the new skate was also an infringement, but not then finally deciding the question, did not make an order for committal, but upon the plaintiff undertaking as to damages, granted an injunction restraining, until further order, the manufacture of the new skate, and this course was approved of by the majority of the Court of Appeal (*d*). But in a similar case, upon an undertaking by the defendant to keep an account of the infringing articles, the injunction was on the balance of convenience refused, the costs of the motion being reserved (*e*).

In *Spencer* v. *The Ancoats Vale Rubber Co.* (*f*), it was held to be doubtful whether, on a motion for sequestration against the company and committal against the directors for breach of a perpetual injunction, the court could direct an account of profits or delivery up of infringing articles, but the order for sequestration and committal was made, such order, however, not to issue if the defendants should within a named time elect to account for profits and deliver up the article complained of and pay costs.

(*b*) *Plimpton* v. *Spiller*, 4 Ch. D. 287; *Lyon* v. *Goddard*, 11 R. P. C. 113.

(*c*) *Adair* v. *Young*, 12 Ch. 21.

(*d*) *Plimpton* v. *Spiller*, 4 Ch. D. 287.

(*e*) *Thomson* v. *Hughes*, 7 R. P. C. 71.

(*f*) 6 R. P. C. 46, 66.

On a motion to commit, costs as between solicitor and client may sometimes be given to the party moving, by way of indemnifying him, instead of committing the respondent (*g*).

Costs on motion to commit.

But in the above-cited case of *Spencer* v. *The Ancoats Vale Rubber Co.* (*h*), where it appeared that the acts complained of had not been done vexatiously, but in the probable belief that the company were entitled to do what they did, solicitor and client costs were refused, but costs on the higher scale were given (*i*).

Solicitor and client costs cannot be given to a respondent on such a motion (*k*).

Motions to commit where no case for committal is made, and only an apology and costs are asked for, will be discouraged (*k*).

Inspection.

The earliest reported patent case in which inspection was ordered is *Brown* v. *Moore* (*l*), which appears (*m*) to be the same as that the judgment in which is reported, under the name of *Bovill* v. *Moore*, in 2 Cooper's Chancery Cases, p. 56. In that case Lord Eldon rests the jurisdiction on the necessity of inspection to enable the court to have the case properly tried (*n*).

Inspection not a matter of right.

Inspection is not a matter of right, and the court, before granting it, must be satisfied that there really is a case to be tried at the hearing of the cause.

What is required on application for inspection.

In *Piggott* v. *The Anglo-American Telegraph Co.* (*o*), the plaintiffs were owners of a patent for improvements in the mode of generating electric currents, manufacturing submarine telegraph cables, and transmitting signals, and the invention was alleged to consist, not in the construction of any particular electric cable, but in the use of a cable in such a manner as that it should always retain a "static charge." The plaintiffs insisted that the defendants so used their own cable (which was not alleged to be, and was, indeed, proved not to be, similar to the plaintiffs' cable) as to infringe the patent; and having filed a bill for an injunction they moved for leave to inspect the defendants' mode of working; but Giffard, V.-C., being of opinion, upon the specification and evidence, that the plaintiffs' patent was, in fact, only for the construction of a

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(*g*) *Plating Co.* v. *Farquharson*, 17 Ch. D. 49, 57; *Steele* v. *Hutchings*, W. N. (1879), 18.

(*h*) 6 R. P. C. 67, 68.

(*i*) *Spencer* v. *The Ancoats Vale Rubber Co.*, 6 R. P. C. 46, 66.

(*k*) *Plating Co.* v. *Farquharson*, *ubi supra*.

(*l*) 3 Bligh, 178.

(*m*) See *post*, p. 287.

(*n*) See also *Russell* v. *Cowley*, 1 Webst. 458.

(*o*) 19 L. T. (N.S.) 46.

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particular cable, and that in that view there could be no question of infringement to try at the hearing, refused the motion.

Inspection must be shown to be of material importance.

Moreover, before making an order for inspection, the court will require to be satisfied that the inspection is of material importance to the plaintiff's case as made out by his evidence (*p*).

Thus, where in an action for infringing a patent for making cartridges, the plaintiff did not allege that he could not make out his case without inspection, and the defendants filed an affidavit stating that they made several improved cartridges, many of which did not in any way resemble the plaintiff's, and stating further their belief that the inspection was not required for the purposes of the action, but for the purposes of copying their improvements, and the plaintiff did not meet this by any evidence, an application to inspect defendants' manufactory was refused (*q*).

When in an action for infringement of a patent for improvements in spinning machines the particulars of breaches alleged the use by the defendants of certain bobbins and spindles, and the plaintiff had specimens of the bobbins and spindles complained of, an order for liberty to the plaintiff to enter the defendants' works, and work and examine the bobbins and spindles there was refused (*r*).

And when the action was for the specific performance of a contract relating to the working of patents, which contract was denied by the defendant, the court declined to make an order for inspection by the plaintiff of defendant's works (*s*).

An inspection will not be ordered upon an affidavit which simply states that the machine used by the defendants is the same for which the plaintiff has obtained a patent. Such an affidavit is too vague. It ought to state that there is such a machine, and that the plaintiff has reason to believe it is an infringement (*t*). And an affidavit merely stating a belief that the defendants infringe is not enough ; the deponent must show grounds for his belief (*u*). The plaintiff must also show what his own invention is ; and an order for inspection was refused when the plaintiff merely stated the commencement of the action, but did not disclose his invention, and the defendant stated on oath that

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(*p*) *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. (N.S.) 46 ; *McDougall* v. *Partington* (2), 7 R. P. C. 351, 472.

(*q*) *Batley* v. *Kynoch*, L. R. 19 Eq. 90. See also *Amies* v. *Kelsey*, 22 L. J. (N.S.) Q. B. 84 ; *Meadows* v. *Kirkman*, 29 L. J. Ex. 205.

(*r*) *Sidebottom* v. *Fielden*. 8 R. P. C. 266.

(*s*) *McDougall* v. *Partington* (2), 7 R. P. C. 351, 472.

(*t*) *Shaw* v. *Bank of England*, 22 L. J. (N.S.) Ex. 26.

(*u*) *Germ Milling Co.* v. *Robinson*, 1 R. P. C. 217.

he had used no machinery, and only employed the same process as had been used many years before the patent (*x*).

Nor will inspection be granted if the plaintiff has already had, in an action against the defendant, which action he has discontinued, an inspection of the machinery complained of (*y*).

But inspection allowed if *primâ facie* case of infringement made out.

Where, however, a *primâ facie* case of infringement is made out against a defendant, an order for inspection is almost a matter of course (*z*), at all events, when such inspection is essential for the purpose of enabling the plaintiff to prove his case (*a*).

Where an officer of a defendant company, in an action against the company for infringing a patent for carriage wheels, stated in answer to interrogatories, asking as to the construction of defendant's wheels, that the manner of their manufacture could be explained on an inspection, but could not be made intelligible by mere verbal statement, it was ordered that the plaintiff, with certain witnesses on his behalf, should be at liberty to inspect one of the defendant's wheels, and that unless the officer attended and gave information on such inspection he should be examined orally respecting the manner in which such wheels were manufactured (*b*).

Inspection not allowed so as to be oppressive.

The court will not, however, permit inspection to be made the means of oppressing a defendant, nor to be carried beyond what is necessary for the purposes of the cause. Thus, where a defendant, who was sued for infringing the plaintiff's patent for a sewing machine, and against whom a *primâ facie* case was made out, objected to an order which the plaintiff sought for inspection of all the sewing-machines of every kind on the defendant's premises, on the ground that such an order would be oppressive, the court allowed the defendant to verify, on affidavit, the several classes of sewing-machines which he had sold or exposed for sale since the date of plaintiff's patent, and confined the inspection to one of each class (*c*). But the court has no jurisdiction to require the defendant to make such an affidavit if it is objected to (*d*).

And the inspection will be limited to processes of the defendant as to which a *primâ facie* case of infringement has been made out (*e*).

(*x*) *Meadows* v. *Kirkman*, 29 L. J. Ex. 205.

(*y*) *Shaw* v. *Bank of England*, 22 L. J. (N.S.) Ex. 26.

(*z*) *Per* Lord HATHERLEY, *Singer Manufacturing Co.* v. *Wilson*, 13 W. R. 560 ; *S. C.* 5 N. R. 505.

(*a*) *Batley* v. *Kynock*, L. R. 19 Eq. 90, 92 ; *Cheetham* v. *Oldham* (1), 5 R. P. C. 617.

(*b*) *Smith* v. *London and Great Western Rail. Co.*, Macr. P. C. 227 ; 6 E. & B. 405.

(*c*) *Singer Manufacturing Co.* v. *Wilson*, 13 W. R. 560 ; *S. C.* 5 N. R. 505. See the order, Pemberton, p. 485.

(*d*) *Drake* v. *Muntz's Metal Co.*, 3 R. P. C. 43.

(*e*) *Cheetham* v. *Oldham* (1), 5 R. P. C. 617.

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Inspection of books.

In *Vidi* v. *Smith* (*f*), it was held that the "inspection" mentioned in s. 42 of the Act of 1852 referred to an inspection of the instrument or machinery manufactured or used by the parties with a view to evidence of infringement, and not to an inspection of books.

And an inspection of defendant's books was not ordered on affidavits which only showed the mere possibility of thereby discovering matters advantageous to the plaintiff's case. Thus, where a plaintiff filed affidavits stating that defendants, who were charged with infringing a patent for railway wheels, had kept certain books called the wheel register books, containing particulars as to number, size, etc., of the wheels made by them, but the plaintiff did not show that the wheels mentioned in the books were infringements of the patent, an inspection of the books was refused (*g*).

Where a plaintiff asked, under the Judicature Rules, Order L. Rule 3 (of which Order L. r. 3, S. C. R. 1883, is substantially a re-enactment), for an order to inspect defendant's works, and "upon and during such inspection to make such observations *and experiments* as might be necessary and expedient for the purpose of obtaining full information and evidence" as to the mode in which the articles complained of were made by the defendant, the order asked for was made, but with the omission of the words "and experiments" (*h*).

When production ordered.

In *Sidebottom* v. *Fielden* (*i*) the court ordered production of articles in defendant's possession which were alleged as prior user; but the court cannot order production of such articles if not in defendant's possession (*k*).

Where the defendants applied for inspection of machines not the property of the plaintiff, and there was a *primâ facie* case for saying he could procure inspection, it was held that plaintiff must apply to the owner of the machines to permit inspection and make an affidavit as to the result of such application, and the motion stood over for this purpose (*l*).

By S. C. R. 1883, Order XXXI. r. 20, where inspection is objected to the court or a judge may, if satisfied that the right to inspection depends on the determination of any issue or question in the cause, or that for any other reason it is desirable that any issue or question in the cause should be determined before deciding on the right to inspection, order that such issue may be determined first, and reserve the question as to the inspection.

(*f*) 3 E. & B. 969.

(*g*) *Smith* v. *London and Great Western Rail. Co.*, Macr. P. C. 223.

(*h*) *Flower* v. *Lloyd*, W. N. 1876, 169, 170; Seton, p. 561.

(*i*) 8 R. P. C. 266.

(*k*) *Garrard* v. *Edge*, 6 R. P. C. 372.

(*l*) *Rylands* v. *Ashley's etc. Co.*, 7 R. P. C. 175. And see *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 11.

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Where the plaintiff refused to permit inspection by the defendants on the ground that he was making improvements of his machines and that it would be injurious to him to allow rival manufacturers to inspect the works, it was held that he must make an affidavit whether there were any of the patented machines in existence without modifications (*m*).

Trade secrets.

An objection sometimes urged by a defendant, in answer to a motion for inspection, is that the inspection would lead to disclosures of trade secrets. In *Piggott* v. *Anglo-American Telegraph Co.* (*n*), some weight was given to this objection, but there were other reasons above stated for refusing the inspection asked.

But in general this allegation will be insufficient to bar the plaintiff's right to inspection if he be otherwise entitled thereto. Thus, in *Renard* v. *Levenstein* (*o*), discovery of the defendant's process was resisted on the ground that the plaintiffs would thereby obtain the defendant's secret, and ruin his trade. But Sir W. P. WOOD, V.-C., ordered the discovery to be given, observing that the court would, at the proper time, be able to protect the defendant from an improper disclosure of his secret.

And in *Russell* v. *Crichton* (*p*), a Scotch case, inspection of defendant's manufactory was resisted on the ground that his manufacture involved a secret process, the value of which would be lost if inspection were permitted, but the court said that some mode of inspection must be allowed, otherwise any patent might be infringed with impunity.

The court will, however, endeavour to prevent the inspection being used to the injury of the defendant. Thus, in *Russell* v. *Crichton*, cited above, the Court of Session, when ordering the inspection, said that all those who were admitted to it must be aware of its being their bounden duty to make no further disclosure afterwards than was required for doing justice in the action.

And in *Flower* v. *Lloyd*, cited above (p. 284), the court below had, notwithstanding an objection that the plaintiff was a trade competitor with the defendant, ordered that the plaintiff should himself be at liberty to inspect the defendant's works, but when the order came before the Court of Appeal, an arrangement was made that the defendant's works should be inspected by scientific men to be agreed upon, and not by the plaintiff (*q*). In *Cheetham* v. *Oldham* (*r*), however,

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(*m*) *Rylands* v. *Ashley's etc. Co.*, *ubi supra*.

(*n*) 19 L. T. (N.S.) 46. See also *Smith* v. *London and Great Western Co.*, *ubi supra*.

(*o*) 10 L. T. (N.S.) 94. See also *Ashworth* v. *Roberts*, 7 R. P. C. 451; 45 Ch. D. 623; *Benno Jaffé, etc. Fabrik* v. *Richardson*, 10 R. P. C. 136.

(*p*) 15 Dec. of the Court of Session, 1st Series, p. 1270.

(*q*) W. N. (1876), 230.

(*r*) 5 R. P. C. 617.

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the plaintiff, though a rival manufacturer, was allowed to take part in the inspection.

It is stated in Seton, p. 561, that in the order in *Flower* v. *Lloyd*, as drawn up, the words "under the obligation of confidence," used by their Lordships, were not inserted; and that on mentioning the matter to the court, their Lordships stated that all they meant was that the inspectors were not to communicate to the plaintiff any special or secret process which the defendant might be using, but were to be at liberty to report to the solicitors whether the process was or was not, in their opinion, an infringement of the plaintiff's patents, and state whether it was the ordinary process or not which the defendant used. The order for inspection made by the Court of Session in *Russell* v. *Crichton*, cited above, did not contain any direction to the inspectors as to not disclosing the information they might acquire by the inspection. But such a direction may be inserted (*s*).

The inspector may be ordered to report to the court whether the defendant's machines are trade secrets (*t*), and he has been directed to state his opinion whether the defendant's machines are infringements (*u*); but this course has not been followed in later cases, and it is believed that the direction now usually given is, in general terms, that the inspector shall "report to the court upon the facts, and his opinion founded upon them" (*x*). The court will not allow the inspector to be called as a witness or cross-examined (*y*).

What evidence sufficient to found inspection in cases of alleged trade secret.

The case of *Brown* v. *Moore* (*z*) is important, as showing what evidence is sufficient to found an application for inspection when the defendant's manufacture is alleged to be a trade secret. In that case the plaintiff was the patentee of a machine for making bobbin net; and, suspecting infringement by the defendant, he bought a piece of his net, which, from certain peculiarities in the work, it was sworn by plaintiff's witnesses must have been manufactured by a frame essentially similar to the plaintiff's (*a*); moreover, certain parts of defendant's machine which had been shown to the plaintiff were exactly similar to the latter's patent machine; and a former partner of the defendant had explained to a witness the construction of the defendant's machine, which, according to that description, was exactly like plaintiff's machine. An *ex parte* injunction having been obtained, a motion to

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(*s*) See order in *Plating Co.* v. *Farquharson*, Appendix, *post*, Griffin, P. C. 187.

(*t*) *Hill* v. *Tombs*, Appendix, *post*. See also an order in *Hall* v. *New Sedgwick Co.*, M. R. 5 April, 1881.

(*u*) *Hill* v. *Tombs*, *ubi supra*.

(*x*) *Plating Co.* v. *Farquharson*, Appendix, *post*.

(*y*) *Plating Co.* v. *Farquharson*, Griffin, P. C. 187.

(*z*) 3 Bligh, 178.

(*a*) See remarks of KAY, J., in *Germ Milling Co.* v. *Robinson*, 1 R. P. C. 217, 219.

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dissolve it was made, but the injunction was continued, the plaintiff being put under terms to bring an action. The action was brought and failed (*b*), partly for want of sufficient proof of the resemblance of the machines. Thereupon an application was made for an issue as to the novelty of the invention. This was refused, but on the plaintiff's undertaking to bring an action against the defendant for infringement, it was ordered (on the undertaking of the defendant) that he should admit on the trial that since the trial of the former action he had made lace with the machines *inspected* by A. Upon these facts the reporter observes that there had been an inspection of defendant's machines, and that he had been informed by plaintiff's solicitor that such inspection had been made under the order of the court, but he had been unable to find it in the Registrar's book. He mentions, however, a subsequent order for the inspection of a model of the *plaintiff's* machine.

The report of the case cited in Cooper's Reports as *Borill* v. *Moore* (*c*) appears, from the dates and other particulars, to refer to the judgment delivered by Lord ELDON on the occasion of the application for the issue, and it would seem most probable that it was on this occasion that the order to which the author of the report in Bligh refers was made. Lord ELDON's judgment, which alone is reported in 2 Cooper, was in the following terms —

"The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article, and, as the plaintiff alleges, he is making it with a machine constructed on the principle of the machine protected by the plaintiff's patent. Now, the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy at present is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No court can be content with evidence of this description. There must be an order that the plaintiff's witnesses shall be permitted, before the trial of the action, to inspect the defendant's machine, and see it work."

Samples allowed to be taken.

The court, when it orders inspection, will not stop short of what is necessary to make the jurisdiction effectual, and therefore, in a proper

(*b*) This seems to be the action reported as *Borill* v. *Moore* in Carpmael's Reports, pp. 320, 348.

(*c*) 2 Coop. C. C. 56.

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case, it will give the plaintiff liberty to take and carry away samples of the article the manufacture of which is complained of.

Thus, in *Russell* v. *Cowley* (*d*) (which, however, appears to have been by consent), the order provided that the viewers should be at liberty to carry away with them any specimen of the tubes operated on by them as they might think proper, in order to their production in court on the trial of the action. And this precedent was followed by Lord HATHERLEY, then Vice-Chancellor, in *The Patent Type Founding Co.* v. *Walter* (*e*), where, in a suit to restrain infringement of a patent for making type, the substance of the invention being the use of a large proportion of tin to give greater toughness, for which purpose a mixture of antimony and lead, with little or no tin, had been previously employed, the defendants were ordered to permit inspection of their type, and to deliver a competent part to the plaintiffs (*f*).

And this power to order samples to be taken is now expressly conferred by S. C. R. 1883, Order L. r. 3, cited above, p. 246 (*g*).

In *Morgan* v. *Seaward* (*h*), a case of a patent relating to paddle-wheels, the defendant having entered into a contract to make certain paddle-wheels which plaintiffs alleged were a violation of their patent, it was ordered that the plaintiffs and their witnesses be at liberty to inspect, at all seasonable times, giving reasonable notice, the paddle-wheels or machinery relating to paddle-wheels made, or to be made, pursuant to the said contract.

Reasonable notice to be given.

The order for inspection usually provides for reasonable notice being given to the parties against whom it is made (*i*), and in the case of machinery that the machine be put to work (*k*), and in the presence of persons named in the order (*l*). It has, however, been said that the court has no jurisdiction to order the defendant to work in the plaintiff's presence the machines inspected (*m*).

The number of inspections to be allowed ought to be named in the order (*n*).

(*d*) 1 Webst. 459.
(*e*) Johnson, 727.
(*f*) See also *Davenport* v. *Jepson*, 1 N. R. 308, where samples of chenille were ordered to be delivered. The orders in both these cases are given in Pemberton, pp. 484, 485.
(*g*) See also *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 11. The order is printed p. 14.
(*h*) 1 Webst. 169.
(*i*) *Russell* v. *Cowley*, 1 Webst. P. C. 458; *Davenport* v. *Jepson*, Pemberton, p. 484; *Flower* v. *Lloyd*, Seton, p. 561; *Germ Milling Co.* v. *Robinson*, *ubi supra*.
(*k*) *Russell* v. *Cowley*, 1 Webst. P. C. 458; *Beardsell* v. *Schwann*, Seton, 3rd ed. p. 910; *Davenport* v. *Jepson*, Seton, 5th ed. p. 554; Pemberton, p. 484; *Morgan* v. *Fuller*, Seton, p. 555; *Bovill* v. *Moore*, 2 Coop. C. C. 56; *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 11.
(*l*) *Russell* v. *Cowley*, 1 Webst. 458.
(*m*) *Drake* v. *Muntz's Metal Co.*, 3 R. P. C. 43.
(*n*) *Heathfield* v. *Braby*, Seton, p. 561. See, however, the order in *Germ Milling Co.* v. *Robinson*, *ubi supra*.

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Inspection by defendant of plaintiff's machines.

In *Russell* v. *Cowley* (*o*), the order provided for inspection of the plaintiff's machine by defendant, as well as for the inspection by the plaintiff of the machine of the defendant. This order was by consent. A similar course was pursued in *Davenport* v. *Jepson* (*p*). It does not appear from the report whether or not that order was by consent, but in *Germ Milling Co.* v. *Robinson* (*q*) an adverse order for inspection of the plaintiff's machine was made at the instance of the defendant, upon the ground that, looking to the nature of the patent and the questions at issue, the court would very probably be under some disadvantage if it had not very complete evidence as to the process which the plaintiff actually carried out under the patent, and also and mainly upon the question whether, in point of fact, what the defendants were doing was an infringement, and upon the further ground that inspection might materially assist the defendants in contesting the latter question. See also the judgments in *Brown* v. *Moore* (*r*) and *The Patent Type Founding Co.* v. *Walter* (*s*), where it is stated that the inspection is for the purpose of enabling the court to have the case properly tried, and to assist the court in forming a right conclusion at the trial. A plaintiff, however, cannot, in an action for infringement, be compelled to produce a specimen of the patent article to enable the defendant to prepare his defence (*t*).

It has been held that the court does not direct a forcible inspection. The usual form of an order was only to permit inspection; obedience could be enforced only by the ordinary process of contempt (*u*). But now, by S. C. R. 1883, Order L. r. 3, cited above (p. 246), the court may authorize any person, for the purpose of inspection, to enter any land or building in the possession of any party.

The inspection might, under the old practice, be ordered at common law before the delivery of the pleadings in the action (*x*). And where a plaintiff, on the application of the defendant, was ordered to deliver better particulars of breaches, the plaintiff was allowed to inspect the machines at the defendant's factory, and to examine the defendant *viva voce* (*y*). And now, by S. C. R. 1883, Order L. r. 3, cited above, it would seem that an order for inspection may be made at any stage of the action. "The court or a judge" being empowered to grant

(*o*) 1 Webst. P. C. 459.

(*p*) Pemberton, p. 484; *S. C.* 1 N. R. 308. See also *Russell* v. *Crichton*, 15 Dec. of Court of Session, p. 1270.

(*q*) 3 R. P. C. 11. See also *Cheetham* v. *Oldham* (2), 5 R. P. C. 622; *Rylands* v. *Ashley's etc. Co.* 7 R. P. C. 175.

(*r*) 2 Coop. C. C. 56, cited above.

(*s*) Johnson, 728.

(*t*) *Crofts* v. *Peach*, 1 Webst. P. C. 268.

(*u*) *East India Co.* v. *Kynaston*, 3 Bligh, 153, 163, 166.

(*x*) *Amies* v. *Kelsey*, 22 L. J. (N.S.) Q. B. 84.

(*y*) *Jones* v. *Lee*, 25 L. J. (N.S.) Ex. 241.

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inspection, the order may be made either on motion in court or on summons at chambers (*z*), subject, however, in the Chancery Division, to the provisions of Order LV. r. 15, and in the Queen's Bench Division to the provisions of Order LIV. r. 12.

As to the proceedings on applying for inspection, see S. C. R. 1883, Order L. r. 6.

The machines inspected may be ordered to be produced on any examination of witnesses in the action (*a*).

Delay no bar to inspection.

We have seen that undue delay is a bar to an application for an interlocutory injunction. In *The Patent Type Founding Co.* v. *Walter* (*b*) it was urged that such delay would be likewise a bar to a motion for inspection, on the ground that the inspection could be of no use for the injunction, as that could not be granted by reason of the *laches*, and it was too soon to ask for inspection for evidence for the hearing, because the cause was not at issue. But Sir W. P. WOOD, V.-C., after citing the rule laid down by Lord COTTENHAM in *Bacon* v. *Jones* (*c*), to the effect that a plaintiff ought, in a patent case, to bring his cause to a hearing in a state in which the court can adjudicate upon it, held that the delay was no bar to the inspection, and that it was reasonable and right for a plaintiff to come on an interlocutory motion and ask inspection, with a view to assist the court in arriving at a right conclusion at the hearing.

Upon an application for inspection the court will not consider the question of disconformity of the provisional and complete specification (*d*).

DISCOVERY.

By S. C. R. 1883, Order XXXI. r. 1, the plaintiff or defendant may in every cause or matter (other than certain specified actions which do not include patent actions), by leave of the court or a judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties. These rules apply to patent actions, notwithstanding particulars have been delivered in compliance with the statutory requirements (*e*).

On applying for such leave it is sufficient to state the general scope and object of the interrogatories (*f*), and the judge will not decide as

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(*z*) Judicature Act, 1873, s. 39; *Frearson* v. *Loe*, 26 W. R. 138.

(*a*) *Drake* v. *Muntz's Metal Co.*, 3 R. P. C. 43, 44.

(*b*) Johnson, 728.

(*c*) 4 My. & Cr. 433.

(*d*) *Cheetham* v. *Oldham* (1), 5 R. P. C. 617.

(*e*) *Birch* v. *Mather*, 22 Ch. D. 629. See also *Haddan's Patent*, 54 L. J. Ch. (N.S.) 126.

(*f*) *Hall* v. *Liardet*, W. N. 1883, 165.

to the relevancy of particular interrogatories (*g*). The costs of discovery by interrogatories or otherwise must be secured by the party seeking discovery (*h*).

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Discovery under old practice.

The Rules of the Court of Chancery as to discovery (which rules regulated the discovery to be obtained under the Judicature Rules (*i*), for which the Supreme Court Rules, 1883, are now substituted) were thus stated by Lord ROMILLY, M.R. :—

"A fundamental principle is to be found in all the decisions on this point, which is usually thus stated : that a defendant who submits to answer must answer fully (*k*). That is, that if a *primâ facie* case for relief be made by the bill, calling for an answer, the defendant may, if the circumstances of the case will permit it, bring forward any fact or series of facts, by way of plea, to dispute the right of the plaintiff to call upon him to answer either the whole bill or some particular portion of it ; but that if he be unable or decline to adopt this course, he must, technically and categorically, answer every statement in the bill to which he is interrogated which can assist the plaintiff in making out his title to relief" (*l*).

Defendant must answer everything tending to show fact of infringement.

In accordance with this principle, the defendant, in a suit to restrain infringement of a patent, is bound, if the infringement be denied, to set forth in his answer to the full extent of the interrogatories everything showing or merely tending to show the fact of infringement (*m*) Thus, where the defendant was charged with infringing a patent for making an aniline dye, it was held that he was bound to answer whether he used the ingredients mentioned in the plaintiff's specification, whether he added anything else, and whether the additions made any difference in the process (*n*). And, speaking generally, the plaintiff in an action for infringement is entitled to specific answers to specific interrogatories, taking the claims of the specification step by step (*o*) And the rule is the same in actions against a licensee (*p*).

(*g*) *Hall* v. *Liardet* (No. 2), W. N. 1883, 175 ; corrected, *ibid.* 194.

(*h*) Supreme Court Rules, 1883, Order XXXI. rr. 25 to 27.

(*i*) *Anderson* v. *Bank of British Columbia*, 2 Ch. D. 644 ; *Saunders* v. *Jones*, 7 Ch. D. 435 ; *Att.-Gen.* v. *Gaskill*, 20 Ch. D. 519.

(*k*) See now, however, Supreme Court Rules, 1883, Order XXXI. r. 20, and observations of CHITTY, J., in *Lister* v. *Norton*, 2 R. P. C. 69 ; *post*, p. 295.

(*l*) *Per* Lord ROMILLY, M.R., *Swinborne* v. *Nelson*, 16 Bea. 416, 417. See also *Elmer* v. *Creasy*, L. R. 9 Ch. 69 ; *Saull* v. *Browne*, L. R. 9 Ch. 364.

(*m*) *De la Rue* v. *Dickinson*, 3 K. & J. 388, 391 ; *Lister* v. *Norton*, 2 R. P. C. 68.

(*n*) *Renard* v. *Levinstein*, 10 L. T. (N.S.) 94. See also *Rolls* v. *Isaacs*, W. N. 1878, 37.

(*o*) *Benno Jaffé* v. *Richardson*, 10 R. P. C. 136. See also *Badische Anilin etc., Fabrik* v. *Levinstein*, 29 Ch. D. 366, 395.

(*p*) *Ashworth* v. *Roberts*, 45 Ch. D. 623.

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And where a plaintiff had filed several bills against previous infringers, and had succeeded in such suits, it was held that in a subsequent suit the defendant might be required to state whether his process was the same as that used by some one who had been a defendant in one of the former suits (*q*).

And in a suit against defendants, who were alleged to be selling, under the names "Nelson's Patent Refined Isinglass," and "Nelson's Gelatine Isinglass," articles made in infringement of the patent, but who denied infringement, the defendants were compelled to answer questions as to when they first manufactured, and to whom by name they first sold, any and what quantity of the articles sold by them under the above names, and what were the processes of manufacture. They were also compelled to set forth an account of all articles manufactured and sold by them since the date of the specification under the name of "Nelson's Gelatine Isinglass," etc., and the quantities thereof respectively, and the names and addresses of the persons to whom sold, and at what prices, and the profits which the defendants had realized thereby (*r*).

Names of customers required.

In *Tetley* v. *Easton* (*s*), which was an action at common law, it was said that if the infringement was admitted, the plaintiff was entitled to an answer to interrogatories asking the names and addresses of the persons to whom the defendant's machines had been sold, and a motion to strike out these interrogatories was refused.

So, also, where the bill alleged that the defendant had sold looms made in violation of a patent, and had received royalties for their use, and the defendant had, in answer to interrogatories, set forth the names and addresses of the persons, resident in England, from whom such royalties were received, he was ordered further to set forth the names and addresses of persons, resident abroad, from whom royalties had been received, in respect of machines made in England, on the ground that the answer might lead to very important discoveries as to the infringement (*t*).

A defendant was not allowed to refuse to answer an interrogatory as to the names of his customers merely on the ground that they might thereby be exposed to actions (*u*). And where a number of persons

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(*q*) *Bovill* v. *Smith*, L. R. 2 Eq. 459, 461.

(*r*) *Swinborne* v. *Nelson*, 16 Bea. 416. This decision as to profits is at variance with the decision in *De la Rue* v. *Dickinson*, 3 K. & J. 388, cited below. From statements of counsel in the latter case, it appears that *Swinborne* v. *Nelson* was appealed.

(*s*) 18 C. B. 643.

(*t*) *Crossley* v. *Stewart*, 1 N. R 436; *S. C.* 7 L. T. (N.S.) 848. And see further, *Leather Cloth Co.* v. *Hirschfield*, L. R. 1 Eq. 299; *Davenport* v. *Rylands*, L. R. 1 Eq. 302, 308.

(*u*) *Tetley* v. *Easton*, 18 C. B. 643. See also *Howe* v. *McKernan*, 30 Bea. 549.

had formed themselves into an association for the purpose of supporting each other against a patentee seeking to restrain them from infringing his patent, it was held that a member of the association against whom the patentee had filed a bill must give the names of the members of the association, but that he was not bound to disclose its proceedings unless they were shown to be connected with the matters in question in the suit (*x*).

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But the rule that a defendant who elects to answer must answer fully has been dispensed with where it has been seen plainly that the point raised is one which must be determined at the hearing, and that the discovery will be unnecessary for the purpose of the hearing, and useless if the decision be in one way (*y*).

Limits of rule as to answering fully.

Thus, in the case of *De la Rue* v. *Dickinson* (*z*), which was a suit to restrain infringement of a patent for the manufacture of envelopes by machinery, the plaintiff required the defendants to set out an account of machines in their possession, and a discovery from whom the same were procured, and whether they were purchased or hired, and, if purchased, the consideration of the purchase; an account of envelopes manufactured by any machine used by the defendants, and discovery of the persons to whom such had been sold; also accounts of the sales of such envelopes, the profits made by defendants, the stock in hand of such envelopes, and an account of moneys received by and due to the defendants for such envelopes. Lord HATHERLEY, when V.-C., refused to enforce an answer to these interrogatories, observing that they assumed the fact of infringement, and would be obtained under the decree at the hearing, as a matter of course, provided the fact of infringement were then established, while, on the other hand, if the fact were not established at the hearing, the discovery required would be utterly immaterial (*a*).

Defendant not bound to answer questions which assume infringement.

And in *Moore* v. *Craven* (*b*) it was laid down by Lord HATHERLEY, C., that although, where discovery is a matter of indifference to the defendant, the court does not weigh in golden scales the question of materiality or immateriality, still, where the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the court takes into consideration the special circumstances of the case; and whilst on the one hand it takes care that the plaintiff

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(*x*) *Borill* v. *Cowan*, W. N. 1867, 115.

(*y*) *Per* Lord HATHERLEY when V.-C., *Swabey* v. *Sutton*, 1 H. & M. 514, 516.

(*z*) *De la Rue* v. *Dickinson*, 3 K.& J. 388. Compare *Elmer* v. *Creasy*, L. R. 9 Ch. 69, 73; and see now *Parker* v. *Wells*, 18 Ch. D. 477; *Hennessy* v. *Clark*, 37 Ch. D. 184.

(*a*) See also *Lea* v. *Saxby*, 32 L. T. (N.S.) 731; and Supreme Court Rules, 1883, Ord. XXXI. r. 6.

(*b*) L. R. 7 Ch. 94, 96, n.

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obtains all the discovery which can be of use to him, on the other it is bound to protect the defendant against undue inquisition into his affairs.

What discovery refused.

Therefore, in a suit to restrain infringement of a patent for making dyes, where the interrogatories, after requiring the defendant to set forth the particulars of various ingredients therein named, which particulars the defendant did set out in his answer, also required him to state the name and address of each person who sold, and each person who delivered, each of the said ingredients at the defendant's premises, and the sum paid by him and any agent or clerk of his, and the use the defendant had made of each of the substances, and fully to account for each packet and parcel of the same, and the application, use, and disposal thereof, and the defendant declined to answer the latter part of the interrogatory, exceptions to the answer were overruled (*c*).

And the defendants to a suit charging infringement of a patent for making cartridges were held entitled to refuse to state the size of the wire used by them in making their cartridges, and the names of the persons from whom, and the places from which, they had purchased their wire (*d*).

And where a patentee of a new material for protecting stone, wood, and the like, sought to restrain infringement by the defendants, who used under their own patent a liquid in which the resinous part of gum euphorbia was employed, and required the defendants to state whether they used a composition in which euphorbia gum was an ingredient, and "not being a composition prepared exactly in accordance with their own specification," and if so to set forth the ingredients of such composition, an objection to the interrogatory was allowed (*e*).

So, also, in *Crossley* v. *Stewart* (*f*), the defendant was not required to set out the names and addresses of persons resident *abroad* to whom he had sold looms manufactured *abroad* in alleged infringement of plaintiff's patent.

And in *Rolls* v. *Isaacs*, cited above, the defendants were held to be not bound to answer an interrogatory asking not merely as to certain vessels mentioned in the particulars of breaches, but also as to the names and owners of the ships to which the defendants had, since the date of plaintiff's patent, applied any composition in which euphorbia gum was an ingredient, and requiring them to state how and in what

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(*c*) *Simpson* v. *Charlesworth*, W.N. 1866, 255.

(*d*) *Daw* v. *Eley*, 2 H. & M. 725.

(*e*) *Rolls* v. *Isaacs*, W. N. 1878, 37.

(*f*) 1 N. R. 436; *S. C.* 7 L. T. (N.S) 848.

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manner the gum entered into the composition, and when and by whom the same was manufactured, and by whom applied or used.

The plaintiff is not entitled by interrogatories to get at the names of defendant's witnesses, or to inquire into defendant's case merely for the purpose of finding out how the defendant intends to prove it (*g*).

The principle laid down in *Moore* v. *Craven* was cited with approval by the Lords Justices in the case of *Carver* v. *Pinto Leite* (*h*), where the court refused to compel a defendant in a suit to restrain infringement of trade mark to disclose the names of his customers, or the prices at which the goods marked with the mark complained of had been sold to them or bought from anybody else.

But where ship-owners had shipped goods bearing counterfeits of the plaintiffs' trade marks, it was held that an action would lie against them for discovery of the names of the consignors of the goods, on the ground that the plaintiffs could not otherwise know who were the invaders of their right (*i*).

Discovery under present practice.

The right to discovery is now, however, subject to S. C. R. 1883, Ord. XXXI. r. 20, under which, if the party from whom the discovery is sought objects to the same, the court or a judge may, if satisfied that the right to discovery depends on the determination of any issue or question in dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined before the right to the discovery, order that such issue or question be determined first, and reserve the question as to the discovery. Under this rule (which has limited to a considerable extent the old rule that a defendant answering must answer fully (*k*)), it was held that, where discovery cannot possibly help the plaintiff to obtain a decree, and will only be of use to him if he obtains a decree, the court has a discretion as to whether it will order it to be given before decree, and will not do so if to compel it would be oppressive (*l*).

Discovery of sales to named customers.

And accordingly, in *Lister* v. *Norton* (*m*), it was held that if the defendant would admit infringement, he also admitting sales which in the event of plaintiff succeeding would give a right to damages or an account, he need not answer interrogatories as to sales to particular named customers; but that if he did not admit infringement the interrogatories must be answered. An admission of infringement contained in an affidavit filed by the secretary of a defendant company

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(*g*) *Daw* v. *Eley*, 2 H. & M. 730, 731.
(*h*) L. R. 7 Ch. 90, 97.
(*i*) *Orr* v. *Diaper*, 4 Ch. D. 92.
(*k*) See *per* CHITTY, J., *Lister* v. *Norton*, 2 R. P. C. 69.
(*l*) *Parker* v. *Wells*, 18 Ch. D. 477. See also *Fennessy* v. *Clark*, 37 Ch. D. 184. Also observations of BOWEN, L.J. on this rule, *Rawes* v. *Chance*, 7 R. P. C. 275.
(*m*) 2 R. P. C. 68.

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in answer to interrogatories is not a sufficient admission to enable the court to dispense with an answer to an interrogatory asking as to sales to particular customers (*n*).

And in an action against a licensee for an account, the names of customers were ordered to be given (*o*).

Where it was not clear that the production of the defendant's books, containing analyses of the materials operated on in his process, was necessary to enable the plaintiff to prove either the validity of the patent or infringement, production was refused without prejudice to any application which the plaintiff might make during the trial (*p*).

It is very often right that the plaintiff should not be allowed to see his opponent's books under colour of trying to find out whether he is infringing a patent which is disputed. The defendant is justified in saying "Prove your patent first" (*q*). But a defendant in an action for infringement cannot refuse to answer interrogatories as to his process, framed on the lines of the allegations in plaintiff's specification, on the ground that till the validity of the patent is established the discovery is not material (*r*).

Where a defendant, being required to state whether he was not making water-gauges identical with those patented by the plaintiff, and to set forth in what particulars they differed from those of the plaintiff, stated that he had for many years before the date of the patent applied to water-gauges the same mode of treatment as that described in the plaintiff's specification, and that he now made water-gauges which, save so far as his own method or process adopted before the patent was similar to that described in the plaintiff's specification, differed from the water-gauges there described, but that it was impossible, without ocular demonstration, to show in what they differed, the answer was held sufficient (*s*).

Communications with patent agents not privileged.

Communications with a patent agent are not privileged, and therefore when plaintiff's solicitor was also a patent agent, and the plaintiff resisted the production of documents as being confidential communications between himself and his solicitor, he was ordered to make a further affidavit, and it was held that he was bound to distinguish between communications made to the solicitor in his character of solicitor and communications made to him in his character of patent agent (*t*).

(*n*) *Lister* v. *Norton*, *ubi supra*.
(*o*) *Ashworth* v. *Roberts*, 45 Ch. D. 623 ; 7 R. P. C. 451.
(*p*) *Rawes* v. *Chance*, *ubi supra*.
(*q*) *Ibid*, 281.
(*r*) *Benno Jaffé* v. *Richardson*, 10 R. P. C. 136.
(*s*) *Crossley* v. *Tomey*, 2 Ch. D. 533. See *Smith* v. *London & G. W. Rail. Co.*, Macr. P. C. 227 ; *S. C.* 6 E. & B. 405, where, after a similar answer, inspection was ordered.
(*t*) *Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351.

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Where an action was commenced on two cognate patents, both taken out by the plaintiff in two successive years, and the plaintiff discontinued as to one of the patents, it was held that he was nevertheless bound to answer interrogatories relating to communications as to that patent between the plaintiff and his patent agent (*u*).

The principle of *De la Rue* v. *Dickinson* will not extend to excuse defendants from answering fully on the ground that, if the plaintiff fails in proving the validity of the patent, such answers will be useless to him; and therefore, where defendants to numerous separate bills filed by a patentee moved before answer to consolidate the suits and to try the question of the validity of the patent in one suit, they undertaking to be bound by that decision, but not undertaking to be bound as to the infringement, it was held that the application was premature, and the defendants could not be absolved from giving discovery, but without prejudice to any proceedings for consolidating the suits after answer (*x*).

Trade secrets.

If the plaintiff be otherwise entitled to discovery, the mere fact that the disclosure asked may, if given, make the plaintiff acquainted with the defendant's trade secrets has been said to be no ground for refusing it. The court will be able at the proper time to protect the defendant from any improper disclosure of his secret. If the defendant in such a case might say, "I deny any infringement; I will give you no further discovery," there would be no use in filing a bill at all (*y*).

Discovery not enforced beyond what necessary to prove plaintiff's case.

The court will not carry the discovery further than is necessary for enabling the plaintiff to establish his case; and therefore, in *Renard* v. *Levinstein* (*z*), although the defendant was compelled to answer whether he used the ingredients mentioned in the specification, whether he added anything else, and whether the addition made any difference, he was not compelled to disclose in what proportions he used the specified materials, or the nature and quantities of the addition.

This was a case of alleged infringement of a patent for making a dye, and the plaintiff's specification described the invention as consisting in boiling a mixture of red aniline dye and aniline with hydrochloric acid and water. Interrogatories were delivered requiring the defendant to state:—

Whether he used in his process the red aniline dye *of commerce or red aniline dye in some and what form or some and what substances*

(*u*) *Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351.

(*x*) *Foxwell* v. *Webster*, 3 N. R. 193; 2 Dr. & Sm. 250; 4 D. J. & S. 77, 81. See also *Benno Jaffé* v. *Richardson*, 10 R. P. C. 136.

(*y*) *Per* Lord HATHERLEY, C., *Renard* v. *Levinstein*, 10 L. T. (N.S.) 94. *Ashworth* v. *Roberts*, 45 Ch. D. 623.

(*z*) 10 L. T. (N.S.) 94.

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combined which in combination form or are the chemical equivalents of red aniline dye.

Whether the defendant used in his said process aniline *or some and what chemical equivalent to aniline.*

On exceptions to the answer the defendant was not compelled to answer the parts of the above questions printed in italics (*a*).

And where, in an action for infringement of a patent, the only plea was that the plaintiff was not the true and first inventor, it was held, that the defendant need not answer interrogatories as to the inaccuracy of the specification or the novelty of the process, or the question of infringement (*b*).

So, also, a plaintiff who had not made his election between damages and account of profits, was held not entitled, before he had succeeded in the action, to discovery of the sales effected by the defendant, and production of defendant's books for that purpose (*c*).

Secret process.

And a defendant was allowed to refuse in cross-examination to answer questions tending to disclose his alleged secret process, but the court having during the arguments formed an opinion that the plaintiff's patent was valid, gave leave to the defendant to describe his secret process if he should think fit to do so, in order that the court might come to a conclusion on the question of infringement; and the defendant having elected to disclose his secret process, the hearing of the evidence and arguments was continued *in camerâ*, and the shorthand notes, which would disclose the secret process, were directed to be impounded in court (*d*).

Interrogatories as to prior user, notwithstanding particulars of objections delivered.

A defendant may be compelled to answer interrogatories requiring particulars of the prior user alleged by him (*e*), and this even though particulars of objections literally complying with the statutory requirements have been delivered (*f*).

And where defendant by his objections alleged "manufacture and sale by white lead manufacturers generally, in London and the vicinity" over a named period, it was held that he was bound to answer interrogatories asking for the names and addresses of such manufacturers and the places and dates of user (*g*).

(*a*) *Renard* v. *Levinstein*, 3 N. R. 665.

(*b*) *Young* v. *White*, 17 Beav. 532.

(*c*) *Fennessy* v. *Clark*, 37 Ch. D. 184.

(*d*) *Badische Anilin und Soda Fabrik* v. *Levenstein*, 24 Ch. D. 156, 158.

(*e*) *Finnegan* v. *James*, L. R. 19 Eq. 72; *Crossley* v. *Tomey*, 2 Ch. D. 533; *Saunders* v. *Jones*, 7 Ch. D. 449 (*per* JAMES, L.J.), contrary to what was formerly held; *Daw* v. *Eley*, 2 H. & M. 725; *Bovill* v. *Smith*, L. R. 2 Eq. 459.

(*f*) *Birch* v. *Mather*, 22 Ch. D. 629.

(*g*) *Alliance Pure White Lead Syndicate* v. *MacIvor's Patents*, 8 R. P. C. 321.

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But a plaintiff cannot require a defendant to state the names of the persons to whom the defendant alleges he sold articles similar to the patented article before the date of the patent. Such a question is a mere fishing question to help the plaintiff to get at the defendant's witnesses and see what he can make of them (*h*). Nor can a defendant be required to set forth a description of all machines similar to plaintiff's made or used by him prior to the patent (*i*), but he may be asked whether the machines mentioned in his objections are in existence, and the names and addresses of the alleged prior users (*k*). As to the right to production of articles alleged as prior user, see cases cited *ante*, p. 284.

Limits of the discovery.

A plaintiff is not allowed to put interrogatories depending on the construction of the patent (*l*).

The Merchanise Marks Act, 1887 (*m*), contains various provisions making the forging or false application of trade marks, etc., criminal offences, but the Act does not exempt any person from any action which might otherwise be brought against him or entitle him to refuse to make a complete discovery or to answer any question or interrogatory in any action. Such discovery or answer, however, is not to be evidence against such person in any prosecution under the Act (*n*).

Interrogatories for examination of plaintiff.

In *Hoffmann* v. *Postill* (*o*), it was said that interrogatories delivered by a defendant for the examination of a plaintiff are on a different footing from those for the examination of a defendant, in this respect, that a plaintiff is not entitled to a discovery of the defendant's case, but the defendant may ask questions tending to destroy the plaintiff's claim (*p*).

Interrogatories as to plaintiff's specification.

A plaintiff may be compelled to answer interrogatories as to his specification, and therefore the plaintiffs, owners of a patent for making blue and violet dye, were compelled to answer interrogatories administered by the defendant, asking in effect—

Whether it was not the fact that no true or pure blue could be produced according to the specification?

Whether they had not in their own manufacture added materials not mentioned in their specification?

(*h*) *Daw* v. *Eley*, 2 H. & M. 725.

(*i*) *Daw* v. *Eley*, cited above; and see *Delta Metal Co.*, v. *Maxim-Nordenfelt, etc., Co.*, 8 R. P. C. 169.

(*k*) *Birch* v. *Mather*, 22 Ch. D. 629.

(*l*) *Delta Metal Co.* v. *Maxim-Nordenfelt, etc., Co., ubi supra.*

(*m*) 50 & 51 Vict. c 28.

(*n*) Section 19.

(*o*) L. R. 4 Ch. 673.

(*p*) As to this case, see observations of KAY, J., *Bidder* v. *Bridges*, 29 Ch. D. 29. See also *Minet* v. *Morgan*, L. R. 8 Ch. 361, 364; *Commissioners of Sewers* v. *Glasse*, L. R. 15 Eq. 302; *Benbow* v. *Low*, 16 Ch. D. 98.

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Whether they had not wholly or to some extent abandoned making blue dyes strictly according to their patented process; and what quantity of blue dye made strictly according to the specification had been made and sold by them, as compared with the quantity not so made?

What was the chemical composition of the substance known at the date of the patent as "red aniline dye," mentioned in the specification?

Exceptions to an answer refusing to answer these questions were allowed, the defence being that the specification was insufficient, and that the invention as therein described was not useful (*q*).

To questions—

What was the meaning of an expression, "the acid being mixed with a large quantity of water"?

What was the proportion of water to hydrochloric acid used in the mixture for violet dye? Would any proportion of water to acid be sufficient, and what was the strength of the acid? State the lowest and greatest proportions respectively of water to be used in making the mixture. Would any proportion do?

What was the meaning of "hydrochloric acid of commercial strength"? What was that strength, and did not hydrochloric acid as sold in commerce vary much in strength, and what were the limits of such variation?

The plaintiffs put in an answer, submitting to the court, as a question of construction, what the words "acid being mixed with a large quantity of water" meant, and as to what was the proportion of water to hydrochloric acid used in the mixture for violet dye, as mentioned in the specification. They said the proportion was that described in the specification, and that they submitted to the court as a question of construction, and (save as aforesaid) they declined to answer the interrogatory, except by stating what they believed to be the specific gravity of the hydrochloric acid of commerce.

To this answer exceptions were taken, and Lord HATHERLEY, then V.-C.; said that the exceptions related to plain matters of fact as to which the plaintiffs were bound to answer. They were not bound to answer as to the intentions of the patentee, but those who practise an invention are bound to say what they do themselves. They must state the proportions they use. They must also state of their own knowledge the variations of strength of the acid (*r*).

(*q*) *Renard* v. *Levinstein*, 11 L.T. (N.S.) 79. See also *Few* v. *Guppy*, 1 My. & Cr. 509.

(*r*) *Renard* v. *Levinstein*, *ubi supra*.

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So also, in *Hoffmann* v. *Postill*, cited above, exceptions were allowed to an answer by which the plaintiff refused to answer questions as to certain improvements described in specifications prior to plaintiff's specification, and requiring him to point out the difference between those improvements and the invention comprised in the plaintiff's patent.

An interrogatory whether the patentee has not found it necessary to introduce modifications into his process in order to enable the article to be successfully manufactured thereby for commercial purposes, is relevant to the issue of utility and must be answered (*s*).

And in a trade mark case, where the plaintiff alleged that the defendant's user of his trade mark was calculated to induce, and had, in fact, induced, divers persons to purchase his goods as the goods of the plaintiff, the defendant was held entitled to discovery of the names and addresses of such persons, notwithstanding they might be called at the trial as witnesses on the part of the plaintiff (*t*).

Interrogatories by defendant as to infringement.

When the particulars of breaches are sufficient, and the plaintiff in his answer pledges his oath to their correctness, he will not be compelled to answer further questions as to the particulars of infringement (*u*).

And where defendant had, in answer to interrogatories, stated his process in detail, and afterwards delivered to plaintiff interrogatories requiring him to refer to defendant's answer, and show by reference to page and line which parts of plaintiff's specification were thereby infringed, it was held that plaintiff was not bound to answer this interrogatory (*x*).

And where an interrogatory referred to the defendant's instrument, and asked in what particulars it was identical with or a colourable imitation of the instrument described in the claim of plaintiff's specification with reference to five different specified heads, and required the plaintiff to state which of these heads he considered to be new, and which he admitted to be old, and to state which portions of the combination of the defendant's instrument plaintiff alleged to be infringements of his first claim, it was held that an answer that the several heads were, as to some (which were named), entirely new in form and arrangement, and as to another, new in a particular pointed out, was sufficient, the plaintiff having delivered particulars of breaches which were, with a slight alteration now made by consent, sufficient in form, and which referred to a particular instrument as an infringement (*y*).

(*s*) *Rylands* v. *Ashley's, etc., Co.*, 7 R. P. C. 175.

(*t*) *Humphries* v. *Taylor Drug Co.*, 39 Ch. D. 693.

(*u*) *Hoffmann* v. *Postill*, L. R. 4 Ch. 673, 679.

(*x*) *Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351.

(*y*) *Ehrlich* v. *Ihlee*, 5 R. P. C. 37.

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A plaintiff need not answer matters which are clearly immaterial to the defendant's case, and, therefore, it was held that the plaintiffs need not set forth the particulars of certain legal proceedings which had taken place in Saxony against infringers of their patent, which proceedings the defendant alleged had been unsuccessful (*z*).

An interrogatory by defendant in an action for infringement of a patent for a mechanical musical instrument, in which rotative perforated discs were used for actuating the levers by which the reeds were sounded, asking whether it was not the fact that the plaintiff's instrument could only play a short tune, and would continue repeating the same tune till the disc containing it was removed, while, if they were provided with an endless band, the performance might be extended to a long composition ; and an interrogatory requiring the plaintiff to state in which particulars he considered the perforated rotative disc to be superior to endless bands in the plaintiff's instrument, or in endless band instruments, were held not sufficiently relevant (*a*).

Interrogatories as to documents.

By S. C. R. 1883, Order XXXI. r. 12, any party may apply for an order directing any other party to any cause or matter to make discovery on oath of the documents in his possession or power, relating to any matter in question therein. And on the hearing of such application the court or a judge may either refuse or adjourn the same or make such order, either generally or limited to certain classes of documents, as may be thought fit (*b*).

Where the affidavit of documents is sufficient, a general roving interrogatory as to documents will not be allowed, but interrogatories may, with leave of court, be administered, directed to specific documents which the party interrogating has reason to suppose are in the possession of the party giving discovery, and which have not been disclosed (*c*) ; but it is doubtful whether an affidavit as to the existence and nature of such documents is admissible (*d*).

Where plaintiff has made a sufficient affidavit of documents, and the defendant desires to administer interrogatories as to particular documents, the court may require an affidavit that the application is not for vexation or delay (*e*).

A contentious affidavit to show that the affidavit of documents is insufficient will not be admitted (*f*). But under Order XXXI. r. 18,

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(*z*) *Hoffmann* v. *Postill*, L. R. 4 Ch. 673 ; and see Supreme Court Rules, 1883, Ord. XXXI. r. 6.

(*a*) *Ehrlich* v. *Ihlee*, 5 R. P. C. 37.

(*b*) As to this rule see *Downing* v. *Falmouth Board*, 37 Ch. D. 234.

(*c*) *Edison, etc. Co.* v. *Holland*, 5 R. P. C. 216 ; *Hall* v. *Truman, Hanbury & Co.*, 29 Ch. D. 307 ; and see S. C. R. Order XXXI. r. 19*a*.

(*d*) *Edison, etc. Co.* v. *Holland*, *ubi supra*.

(*e*) *Ibid.*

(*f*) *Jones* v. *Monte Video Gas Co.*, 5 Q. B. D. 556, 558 ; *Morris* v. *Edwards*, 37 W. R. 721 ; 23 Q. B. D.

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upon an affidavit specifying the documents of which inspection is asked, and stating they are in the opposite party's possession, the court may order inspection, even though they have not been disclosed in the affidavit of documents (*g*). Where a patent had been the subject of litigation between two companies, who afterwards compromised the action, and joined as co-plaintiffs in an action for infringement against a third person, it was held that the defendant in the latter action was entitled to administer interrogatories with reference to the particulars of objections delivered in the first action by one of the new co-plaintiffs, but which had not been referred to in the affidavit of documents in the present action (*h*).

Further affidavit of documents, when required.

When it appears probable from a document produced by a plaintiff or defendant that he has in his possession relevant documents besides those which are scheduled to his affidavit of documents, the proper course is to make an order calling upon him to make a further and better affidavit, and in particular to state whether he has not in his possession those documents which, from what has been said by him on affidavit, or from the documents he has produced, in all probability are in his possession. And a plaintiff who had, in an affidavit made in the present action, referred to certain affidavits made in a previous action on the same patent against another defendant, and omitted these latter from his schedule of documents, was ordered to make a further affidavit with especial reference to the affidavits in the first action (*i*).

Reports, etc., obtained by defendant as to infringements.

Where a defendant company had been warned by a plaintiff that he considered they were infringing his patent, but there was no threat of litigation, and the company obtained from their officers reports and letters as to the alleged infringement, it was held in an action which was subsequently commenced that these reports and letters were not privileged, and production of them was enforced (*k*).

And where, before purchasing the patent, the plaintiffs had contested, or made preparations for contesting, the patent in various legal proceedings, the documents relating to which were scheduled to their affidavit of documents, and included reports from witnesses and scientific advisers, it was held, on an application by the defendant for production, that the plaintiffs were bound to produce all the documents,

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287; affirmed H. L., 15 App. Cas. 309.

(*g*) *Wiedeman* v. *Walpole*, 24 Q. B. D. 537; reversed on the facts without giving an opinion as to the law, *ibid*, 626.

(*h*) *Edison, etc., Co.* v. *Holland*, *ubi supra*.

(*i*) *Bown* v. *Sansom*, 5 R. P. C. 510. See also *Jones* v. *Monte Video Gas Co.*, 5 Q. B. D. 556. And see S. C. R. Order 31, r. 19*a*.

(*k*) *Westinghouse* v. *Midland Rail. Co.*, 48 L. T. (N.S.) 98; affirmed, *ibid.* 462.

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except such as they should state on oath came into existence merely to be communicated to their solicitor for the purpose of litigation, actual or intended, and either as materials for briefs or for his advice or consideration (*l*).

ACCOUNT AND DAMAGES.

Account in Court of Chancery.

The Court of Chancery, in addition to granting an injunction restraining infringement of a patent, was accustomed (although before Lord Cairns' Act unable to give damages) to grant the further relief of an account of profits, in order that the remedy might be complete (*m*). But if the plaintiff was not entitled to an injunction, as, for instance, if the patent had expired before (*n*), or during (*o*), the litigation, the account could not be granted unless in cases of fraud (*p*).

After Lord Cairns' Act it was held that, although the patent had expired pending the litigation, so that there could be no injunction, the plaintiff might have damages, though he could not have an account (*q*), but not if the bill were filed immediately before the expiration of the patent, and no application for an injunction was made (*r*).

May now be had in all Divisions of the High Court

Now, however, that all the jurisdiction exercised by the old Courts of Chancery and Common Law is, by the Judicature Act, 1873, s. 16, transferred to the High Court of Justice, these questions cannot arise, and an account may be had in any Division of the Court (*s*), and every Division may grant damages for infringement, and this whether the action be commenced before or after the expiration of the patent.

Plaintiff cannot have both account of profits and damages.

It is now settled, in opposition to earlier cases (*t*), that a plaintiff must elect between an account of profits or damages, and that he cannot have both: "The two things are hardly reconcilable, for if you take an

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(*l*) *Haslam Co.* v. *Hall*, 5 R. P. C. 1. And see *Anderson* v. *Bank of British Columbia*, 2 Ch. D. 644; *Smithwark, etc., Co.* v. *Quick*, 3 Q. B. D. 315, 320.

(*m*) *Baily* v. *Taylor*, 1 R. & M. 73, 75. And see *Hocking* v. *Fraser*, 3 R. P. C. 8.

(*n*) *Smith* v. *London and South-Western Railway*, Macr. P. C. 209; *S. C.* Kay, 417.

(*o*) *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 727. See, however, *Fox* v. *Dellestable*, 15 W. R. 194.

(*p*) *Crossley* v. *Derby Gas Co.*, 1 Webst. 119.

(*q*) *Davenport* v. *Rylands*, L. R. 1 Eq. 302, 307.

(*r*) *Betts* v. *Gallais*, L. R. 10 Eq. 392.

(*s*) See S. C. R. 1883, Order XV. r. 1. *York* v. *Stowers*, W. N. 1883, 174. The order for the account is to contain the necessary inquiries and directions usual in the Chancery Division. See Order XV. r. 1.

(*t*) *Hill* v. *Evans*, 4 D. F. & J. 288, 309; L. R. 6 H. L. 321, note 2; *Betts* v. *De Vitre*, 11 Jur. (N.S.) 217; *Elmslie* v. *Boursier*, L. R. 9 Eq. 223.

account of profits you condone the infringement" (*u*). The rule applies generally and without distinction to every case of infringement (*x*).

But although a plaintiff cannot have both account of profits and damages against the same defendant, he may have both remedies, though against different persons, in respect of the same article.

Thus, in *Penn* v. *Bibby*, and *Penn* v. *Jack* (*y*), a plaintiff obtained in one suit an injunction against the manufacturer of the patented article, and in another suit an injunction against a person who had used the same article, having purchased it from the manufacturer above mentioned; an account of profits was granted against the manufacturer, and damages against the person using, and Lord HATHERLEY, then Sir W. P. WOOD V.-C., said: "It has never been held that an account directed against a manufacturer of a patented article licences the use of that article in the hands of all the purchasers. The patent is a continuing patent, and I do not see why the article should not be followed in every man's hand until the infringement is got rid of. So long as the article is used there is continuing damage" (*z*). In such a case, however, if the plaintiff is paid by the wrongful user of his invention a sum equal to the ordinary royalty which he had been accustomed to demand from his licensees, he cannot, in respect of the same article, recover any further sum from the manufacturer (*a*).

And if damages are paid by the manufacturer to the patentee in respect of infringing instruments equal to the royalty which the latter has been accustomed to receive for such instruments, they become "free instruments" in the market, and the purchasers of such instruments are under no liability in respect of them (*b*).

The patentee may, however, warn such purchasers not to pay the manufacturer, and that if the latter do not pay the damages the patentee will claim the amount from the purchasers (*c*).

But where, in an action against the manufacturer, the plaintiff accepted an agreed sum for damages, and it was part of the order that the manufacturer should give the names of the purchasers and the instruments he had supplied to them, it was held, in an action against

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(*u*) *Per* Lord WESTBURY, *Neilson* v. *Betts*, L. R. 5 H. L. 1, 22. See also *Watson* v. *Holliday*, 30 W. R. 747.

(*x*) *De Vitre* v. *Betts*, L. R. 6 H. L. 319. See also *Holland* v. *Fox*, 3 E. & B. 977; *Vidi* v. *Smith*, 3 E. & B. 969, as to the practice of Courts of Common Law under the corresponding section of the Act of 1852.

(*y*) L. R. 2 Eq. 200.

(*z*) See also *United Telephone Co.* v. *Walker*, 4 R. P. C. 63, 67, and *Boyd* v. *Tootal, etc. Co.*, 11 R. P. C. 175.

(*a*) *Penn* v. *Jack*, L. R. 5 Eq. 81, 86.

(*b*) *Per* CHITTY, J., *United Telephone Co.* v. *Walker*, 4 R. P. C. 63.

(*c*) *Cropper* v. *Smith*, 24 Ch. D. 305, 312.

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purchasers, that the acceptance by the plaintiff of the agreed damages did not make the purchased instruments free in their hands (*d*).

Extent of account of profits.

The account of profits may extend not only to direct profits, but also to collateral benefits derived by the defendant from using the patented invention.

Thus, where a defendant company had made and sold gas-meters in infringement of plaintiff's patent, and had also used them in carrying on their works, an account was directed, not only of what profit had been received, but of what benefit had been derived from the use of such gas-meters (*e*).

Where a defendant alleged that he had made no *profit* by the use of the patented apparatus, but it appeared that such use had been the cause of *saving* to the defendant in his manufacture, it was held that the plaintiff was entitled to claim something on account of the pecuniary value of that saving (*f*).

But if such an account be desired, it must be alleged in the pleadings and proved (*g*).

In a trade mark case, when defendants only sold to middlemen and not to retail purchasers, it was held that the plaintiffs were entitled to an account of the profit made by the defendants by selling the article in the form in which they were not entitled to sell it, without excluding from the account that which the retailers sold to persons who bought it as the defendants' article (*h*).

An account of profits will not be directed if it is clear that no profits have been made (*i*), or if the evidence of sale is insufficient to make it worth while (*k*).

Under the corresponding section of the Act of 1852 (*l*), it was held in the courts of common law that no retrospective account of profits made before action would be ordered before final judgment (*m*). Nor would such an account be ordered where at the trial there had been a verdict with damages; the plaintiff's loss up to that time is considered to be compensated by the damages (*n*).

(*d*) *United Telephone Co.* v. *Walker*, 4 R. P. C. 63, 67.

(*e*) *Crossley* v. *Derby Gas Light Co.*, 1 Webst. 119.

(*f*) *Household Co.* v. *Neilson*, 1 Webst. 697, note (*r*).

(*g*) *Bacon* v. *Spottiswoode*, 1 Ben. 382, 387. As to the practical difficulties of taking such an account see *Crossley* v. *Derby Gas Light Co.*, 3 My. & Cr. 428; *Automatic Coal Gas Retort Co.* v. *Mayor of Salford*, 14 R. P. C. 450.

(*h*) *Lever* v. *Goodwin*, 36 Ch. D. 1; *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. 893.

(*i*) *Bergmann* v. *McMillan*, 17 Ch. D. 423.

(*k*) *Sanitas Co.* v. *Condy*, 4 R.P.C. 530.

(*l*) 15 & 16 Vict. c. 83, s. 42.

(*m*) *Vidi* v. *Smith*, 3 E. & B. 969; *S. C.* 1 Jur. (N.S.) 14.

(*n*) *Holland* v. *Fox*, 3 E. & B. 977.

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The court had, however, power to order, pending the action and before the trial, an account of profits to be kept, but in such a case the plaintiff was required to give *primâ facie* evidence of infringement and of profit being made by the defendant, and to waive his claim for damages, and to undertake, in the event of the verdict being against him, to pay the expenses of keeping the account (*o*).

The amount due under an account of profits is not a demand in the nature of unliquidated damages within s. 31 of the Bankruptcy Act, 1869 (s. 37, Bankruptcy Act, 1883), and is provable in the infringer's liquidation (*p*).

On taking account of profits plaintiff not entitled to account of his own loss.

In taking an account of profits the plaintiff is only entitled to an account of the profits which have been made by the defendant. He is not entitled to any account of the loss which he has sustained by reason of the infringement (*q*).

Where the invention was for an appliance for operating on large forgings, and an account was directed of all forgings manufactured by the defendants by the use of the invention and of the profits made by the defendants by reason of such use, it was held that for the purpose of ascertaining these profits the defendants were bound to furnish an account of the cost of forging iron and steel forgings manufactured by the defendants prior to the use of the invention, as well as the cost of forging like forgings during such use (*r*). In such a case, the true test of comparison seems to be with what the defendants were likely to use, looking at all the circumstances of the case, if they had not used the plaintiff's appliance (*s*).

Inspection not ordered on taking account.

It was held by the Court of Common Pleas, under the Act of 1852, s. 2, that the court would not, on taking an account, order an inspection of the manufactures and warehouses of the defendant, in order to see if he had any articles in course of manufacture in violation of the patent (*t*).

Names and addresses of customers to be disclosed on an inquiry as to damages.

In the prosecution at Chambers of the inquiry as to damages, a defendant will be compelled to disclose the number of machines made by the defendant since the patent, and the names and addresses of the persons to whom they have been sold; and it is no objection to such a disclosure that the plaintiff might attack those persons and so injure the

(*o*) *Vidi* v. *Smith*, *ubi supra*.

(*p*) *Watson* v. *Holliday*, 30 W. R. 747, affirmed 31 W. R. 536; 52 L. J. Ch. 543.

(*q*) *Ellwood* v. *Christy*, 18 C. B. (N.S.) 494, overruling *Walton* v. *Lavater*, 8 C. B. (N.S.) 191. See also *Penn* v. *Jack*, L. R. 5 Eq. 81.

(*r*) *Siddell* v. *Vickers*, 6 R. P. C. 464.

(*s*) *Siddell* v. *Vickers*, 9 R. P. C. 152, 163.

(*t*) *Ellwood* v. *Christy*, cited above.

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business of the defendant (*u*). And the same principles apply on taking an account of profits in trade mark cases (*x*).

And in an action for an account against a licensee, the defendant will be compelled to answer inquiries as to the names of customers (*y*).

And books may be produced and interrogatories administered.

Where the plaintiff obtained a verdict in an action for infringement, and a rule to enter the verdict for defendants was discharged, and the defendants appealed, and subsequently an order was made for an account of profits which was not appealed against, it was held that the defendants' books must be produced, and that interrogatories might be administered notwithstanding the pendency of the appeal (*z*).

On an inquiry as to damages, the defendant will be ordered to make the usual affidavit of documents without the plaintiff being required first to give particulars or heads of his claim (*a*).

Where plaintiff did not surcharge defendant to extent of one-sixth, plaintiff ordered to pay costs of inquiry.

Where a defendant had filed an affidavit as to his profits it was ordered that if the plaintiff did not succeed in surcharging him to the extent of one-sixth beyond the amount admitted in the affidavit, the plaintiff should pay the costs of the inquiry before the master (*b*).

Where the defendant, a licensee under two patents belonging to the plaintiffs, was sued for infringing their third patent, and for an account of royalties, and for an account of profits of infringement, and did not appear, it was held that under S. C. R. Order XV., r. 1, an account of the royalties, but not of the profits of infringement might be granted (*c*).

Delay in suing may affect account of profits.

If a plaintiff lies by and does not prosecute his rights against the defendant, the delay, if unexplained, may affect his right to an account of profits (*d*), and, in actions to restrain infringement of trade mark, it has been held that where there is undue delay in taking proceedings the account will only be granted as from the commencement of the action (*e*).

Account of profits in trade mark cases.

In trade mark cases where the trade mark is used by the defendant in ignorance of the plaintiff's rights, the account of profits or compensation will only be directed as from the time when the defendant became

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(*u*) *Murray* v. *Clayton*, L. R. 15 Eq. 115, 120; *Leather Cloth Co.* v. *Hirschfeld*, 1 H. & M. 295; *American Braided Wire Co.* v. *Thomson* (2), 5 R. P. C. 375.

(*x*) *Powell* v. *Birmingham Vinegar Brewery*, 14 R. P. C. 1.

(*y*) *Ashworth* v. *Roberts*, 45 Ch. D. 623.

(*z*) *Saxby* v. *Easterbrook*, L. R. 7 Ex. 207.

(*a*) *Maxim-Nordenfelt* v. *Nordenfelt*, [1893] 3 Ch. 122.

(*b*) *Ellwood* v. *Christy*, 18 C. B. (N.S.) 494, 48.

(*c*) *Pneumatic Tyre Co.* v. *Ferguson*, 11 R. P. C. 459.

(*d*) *Crossley* v. *Derby Gas Co.*, 1 Webst. 120; *Harrison* v. *Taylor*, 11 Jur. (N.S.) 408; *Beard* v. *Turner*, 13 L. T. (N.S.) 746.

(*e*) *Ford* v. *Foster*, L. R. 7 Ch. 627.

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aware of the prior ownership (*f*). And if a man buys goods from a third party, believing them to be genuine, while in fact they are spurious, it is not until he has been told that they are so that he can be considered guilty of any fraud, or liable to render any account (*g*).

Same rule does not apply in patent cases.

But the principle does not apply in patent cases. In the case of a trade mark "the article is open to all the world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture, but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee" (*h*). And where the defendant had purchased in open market the article complained of, in ignorance of the process of its manufacture, and of the fact of infringement, the inquiry as to damages was nevertheless ordered to extend to the sale within six years of the filing of the bill (*i*).

Damages, form of inquiry.

From the above considerations it results that the proper form of the inquiry as to damages in a patent case is, "what damage the plaintiff has sustained," not "what damage, if any," he has sustained (*k*). And it should be an inquiry as to the particular articles proved in the action as infringements, and all others made in infringement of the patent (*l*).

As to various grounds of damages to be considered on an inquiry see the finding of the official referee in *American Braided Wire Co.* v. *Thomson* (*m*), and see also the summing up of MARTIN, B., in *Smith* v. *L. & N. W. Rail. Co.* (*n*).

Measure of damages.

The measure of damages is the extent to which the sales of the infringing articles interfered with the sales of the plaintiff's own goods, and the plaintiff can only recover compensation for the actual loss he has sustained by reason of the unlawful sales (*o*).

(*f*) *Edelsten* v. *Edelsten*, 1 D. J. & S. 185, 199. See also *Ellin* v. *Slack*, L. J. Notes of Cases, 1880, p. 15.

(*g*) *Per* Lord ROMILLY, M.R., *Moet* v. *Causton*, 10 L. T. (N.S.) 396.

(*h*) *Per* Sir W. PAGE WOOD, V.-C., *Davenport* v. *Rylands*, L. R. 1 Eq. 308; *United Horse Shoe and Nail Co.* v. *Stewart*, 13 App. Cas. 401. See also *Leather Cloth Co.* v. *Hirsohfield*, L. R. 1 Eq. 299, and *Alexander* v. *Henry*, 12 R. P. C. 360 (a trade mark case).

(*i*) *Davenport* v. *Rylands*, *ubi supra*.

(*k*) *Davenport* v. *Rylands*, *ubi supra*.

(*l*) *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 342, 360.

(*m*) 44 Ch. D. 274.

(*n*) Macr. P. C. 201, 202.

(*o*) *United Horse Shoe and Nail Co.* v. *Stewart*, *ubi supra*, p. 408; *Ledgard* v. *Bull*, 11 App. Cas. 648, 654.

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The loss must be the natural and direct consequence of the defendant's acts; and loss of profit to the plaintiffs by reason of their having, in consequence of the defendant's competition, reduced the price of their articles, is not to be taken into account (*p*). But this rule was held not to apply when the defendants were the first to reduce the prices and the official reference found that the reduction by the plaintiffs was made in consequence of the sales of the defendants (*q*).

Where licence granted.

In a simple case, as, for instance, of a licence having been granted, and of a fixed and definite royalty having been received, the court has the means of forming a judgment as to the injury sustained by the plaintiff, and will not send the parties to a jury. In such a case the court would simply ascertain the amount sold by the defendant and fix the wrongdoer with that (*r*).

Where the patentees were not in the habit of selling the patented article, but more usually let it out at a rent, the measure of damages was held to be the profit rent for the entire period during which the article was in the hands of defendants, whether it had or had not been used (*s*).

Reference to a jury.

Under the old practice, it was said that where no licences have been granted, or where for any reason there is extreme difficulty in the assessment by the court itself, the court would send the patentee before a jury. A jury composed of persons of business-like habits, and accustomed to deal with difficulties of this description, are more fit arbiters than the court can be in dealing with such a question (*t*).

And where the defendants in an action for infringement of trade mark commenced in the Chancery Division submitted, by their defence, to a perpetual injunction, and, the plaintiff waiving an account of profits, the question of damages was the only question to be tried, the action was, under the present practice, transferred to the Queen's Bench Division in order that it might be tried by a jury (*u*).

Where the action was tried in the Chancery Division, and the Court of Appeal granted an injunction and an inquiry as to damages, the plaintiffs applied to the judge before whom the action was tried that the inquiry as to damages might be referred to a judge and jury, and were refused, on the ground that the court at that stage had no jurisdiction

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(*p*) *United Horse Shoe and Nail Co.* v. *Stewart, ubi supra*; judgment of Lord MACNAGHTEN.

(*q*) *American Braided Wire Co.* v. *Thomson*, 44 Ch. D. 274.

(*r*) *Betts* v. *De Vitre*, 11 Jur. (N.S.) 10.

(*s*) *United Telephone Co.* v. *Walker*, 4 R. P. C. 63.

(*t*) *Betts* v. *De Vitre*, 11 Jur. (N.S.) 10. See also *Penn* v. *Jack*, L. R. 5 Eq. 81, 83.

(*u*) *Fennessy* v. *Rabbits*, 56 L. T. (N.S.) 138.

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to make such an order (*x*). On appeal, it was arranged that the inquiry should be referred to an official referee, and the court refrained from expressing an opinion on the question of jurisdiction, but ordered the plaintiffs to pay the costs of the appeal, on the ground that they ought to have made the present application when the order of the Court of Appeal was made, and that, after the order of the Court of Appeal, it was wrong to make the application to the judge of the court below (*y*).

Measure of plaintiff's loss.

In *The United Horse Shoe and Nail Co.* v. *Stewart* (*z*), it was held by the Lord Ordinary that the plaintiffs' loss was the amount of profit which they would have gained from the sale of the articles sold by the defendant if the defendant had not interfered so as to prevent the appellants from effecting those sales themselves, and this profit was the difference between the cost of manufacture and the prices at which the plaintiffs were at that time selling; and the decision was affirmed by the House of Lords.

Damages may be recovered against both manufacturer and user until the plaintiff has recovered the full amount of damage sustained, and, therefore, where plaintiff had succeeded in an action against the manufacturer, and obtained an order for damages which the manufacturer could not pay, he was held entitled to damages in respect of the same articles against the user (*a*).

A plaintiff's right to damages is not affected by his not having given notice to the defendant before the purchase of the infringing machine (*b*).

Plaintiff cannot claim manufacturing profit and royalty.

Where the plaintiff has been in the habit of granting licences, he will not be allowed to claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty, and if he has received this royalty from the user he cannot have anything further from the manufacturer.

This was decided in the case of *Penn* v. *Jack* (*c*), in which the principle on which the court acts in the assessment of damages for infringement of patent, where the court is able itself to assess them, was considered; and in that case the plaintiff had obtained an injunction against the defendants, who were manufacturers, to restrain them from using and selling his invention of "an improvement in the bearings or bushes for the shafts of screw and submerged propellers," with a decree for payment of damages sustained by the plaintiff "by reason of the user or

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(*x*) *American Braided Wire Co.* v. *Thomson* (3), 5 R. P. C. 538.

(*y*) *American Braided Wire Co.* v. *Thomson* (4), 5 R. P. C. 696.

(*z*) 3 R. P. C. 139; 13 App. Cas. 401, 415. See also *Betts* v. *De Vitre*, 11 Jur. (N.S.) 9, 10; *Boyd* v. *Tootal, etc. Co.*, 11 R. P. C. 175.

(*a*) *Boyd* v. *Tootal, etc. Co.*, 11 R. P. C. 175.

(*b*) *Ibid.*

(*c*) L. R. 5 Eq. 81.

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vending of the said invention." The plaintiff, who was not in the habit of manufacturing the patent article, but was accustomed to grant licences for its use at a royalty of 2*s.* 6*d.* per horse-power for each ship in which the invention was to be used, claimed to be paid not merely the ordinary royalty which he had been in the habit of accepting from the trade, but also, and in addition, the profits which the defendant's firm had made on the various items of material and labour expended in fitting the propeller shafts with the invention in the cases where it had been used by the defendants. This claim, however, was not allowed, and Lord HATHERLEY, then V.-C. WOOD, said :—

"It has been contended that the plaintiff has lost more than this 2*s.* 6*d.* per horse-power ; he is said to have lost a profit besides. But he has himself estimated that profit at 2*s.* 6*d.* per horse-power. If he had fitted these ships with his invention himself, he would no doubt have had to run risks of bad debts, of bad materials, of losses upon contracts arising from the rise and fall of timber, from strikes and the like ; and he would have expected to make a profit sufficient to cover these risks ; but he has shown that he considers he may as well hand over the right to everybody else on being paid 2*s.* 6*d.* per horse-power. He might prevent any ship-builder from using this invention at all, and there would then be the chance of business being brought to his yard ; but, taking everything into consideration, he finds he can afford to surrender all profit from fitting these ships, and all chance of profit from being employed to build ships himself, upon being paid this royalty."

In *English and American Machinery Co.* v. *Union Boot, etc. Co.* (*d*), the damages were ascertained by inquiring what amount of profits from licences the plaintiffs had been deprived of, and it was held that the plaintiffs were not entitled to the profits which had been made on the sale of the machines.

Defendant's profit not necessarily measure of plaintiff's loss.

And although the court will assume that every sale of the patented article without licence is a damage to the patentee, it will not assume that the defendant's profit is the measure of the plaintiff's loss, or that the plaintiff would have been employed to make every machine in which the patented article has been used without licence ; but loss of sales by reason of the defendant's competition will be taken into consideration (*e*). And a deduction may be made in favour of the defendants of a percentage representing sales due to increased activity produced by the rivalry of two competitors (*f*).

(*d*) 13 R. P. C. 64.

(*e*) See *Penn* v. *Jack*, L. R. 5 Eq. 84 ; *Ellwood* v. *Christy*, 18 C. B. (N.S.) 494 ; *United Horse Shoe and Nail Co.* v. *Stewart*, 13 App. Cas. 413.

(*f*) *United Horse Shoe and Nail Co.* v. *Stewart*, *ubi supra*, p. 417.

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But the principles above stated will not necessarily apply if a patentee has been in the habit of charging a higher royalty to infringers than to ordinary licensees (*g*); nor can a plaintiff be compelled to accept from a litigant the sames royalties as he has accepted from other persons (*h*).

Plaintiff may charge more to infringers than others.

Although where the plaintiff has elected to take an account of profits it is material to ascertain how much of the invention was actually appropriated, the case is altogether different when the claim is for damages, and the patentee does not grant licences. In that case every sale is an illegal transaction, however small a part of the invention is taken (*i*). But in such a case a deduction may be made on account of the non-patented part of the instrument complained of (*k*).

Where the patent was for improvements in the bearings of propeller shafts, the invention consisting in the use of certain wooden strips, the question arose whether the plaintiff was entitled as damages to the profit on the labour and materials only of putting the strips into the propellers, or upon the labour of the whole job of taking out the propeller shafts, fitting them with the strips, and putting them in again, and of all the labour and materials required in so doing; and Lord HATHERLEY, then V.-C. WOOD, while deciding against the plaintiff's claim on other grounds, said that if it had been necessary to go into the case he should have said that the plaintiff's claim for compensation for not having had the whole job to do was quite extravagant, and that it was clear that all the plaintiff was entitled to was the profit of putting in the particular article patented, and that he could not be heard to say that he had lost the job of taking out the propeller and putting it in again, and was consequently entitled to a profit on it (*l*).

In estimating damages the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee (*m*).

Where the patent was for the manufacture of certain horse-shoe nails, and other nails besides the patented nails were in the market, it was held, on a question of damages, that it was immaterial whether the defendant could have made nails equally good and equally cheap

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(*g*) *Penn* v. *Jack*, L. R. 5 Eq. 87.

(*h*) *Penn* v. *Bibby*, L. R. 3 Eq. 310, 312; *Boyd* v. *Tootal, etc., Co.*, 11 R. P. C. 175.

(*i*) *United Horse Shoe and Nail Co.* v. *Stewart, ubi supra.* See judgment of Lord WATSON.

(*k*) *United Telephone Co.* v. *Walker*, 4 R. P. C. 63. See as to this *United Horsenail Co.* v. *Stewart*, 3 R. P. C. 143, Lord KINNEAR.

(*l*) *Penn* v. *Jack*, L. R. 5 Eq. 86.

(*m*) *United Horse Shoe and Nail Co.* v. *Stewart, ubi supra*; judgment of Lord WATSON.

Sect. 30. without infringing the patent, it being admitted that the patented nails had in fact been sold by the defendant (*n*).

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When damages are given there is no set-off in respect of the value of any infringing instruments which are ordered to be given up (*o*).

Effect of former verdict against patent in reduction of damages.

If there has been a verdict against the patent, it would seem that in a subsequent action for infringement the defendant would be allowed, in reduction of damages, to go into evidence to show to what extent persons have acted upon the faith of the former verdict (*p*).

As to the effect on the question of damages of plaintiff lying by with knowledge of defendant's infringement for several years before taking proceedings, see *Smith* v. *London and North Western Rail. Co.* (*q*).

Annoyance and vexation to plaintiff not taken into account.

The annoyance and vexation to the plaintiff of the necessity of a law-suit to establish his rights is not to be estimated in the assessment of damages; the compensation for such annoyance and vexation, though possibly inadequate, is to be found in the costs of the suit (*r*).

Damages may be awarded, though not specifically prayed in the action (*s*).

But before the plaintiff can have an inquiry as to damages he must prove some damage not merely nominal (*t*). And where no damage had been proved at a trial before a judge without a jury, an inquiry as to damages was refused (*u*).

If the plaintiff prays in the alternative for an account of profits or damages, and, the case having been tried by a jury, no issue as to damages was submitted to the jury, the court will not send an inquiry as to damages to chambers, but will grant the account of profits. In such a case, if the plaintiff desires damages, it would seem that he ought to lay the matter before the jury for assessment (*x*).

Where by an oversight an inquiry as to damages and an order for delivery up of infringing articles, though claimed in the statement of claim, were not asked for at the trial, the minutes of the judgment

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(*n*) *United Horse Shoe and Nail Co.* v. *Stewart*, 13 App. Cas. 409. See also *Boyd* v. *Tootal, etc., Co.*, 11 R. P. C. 175.

(*o*) *United Telephone Co.* v. *Walker*, 4 R. P. C. 63.

(*p*) *Per* Lord LOUGHBOROUGH, *Arkwright* v. *Nightingale*, 1 Webst. P. C. 61.

(*q*) Macr. Pat. Cas. 201, 202, MARTIN, B.

(*r*) *Penn* v. *Jack*, L. R. 5 Eq. 84, 86; but *qu.* see the charge of the Lord Justice Clerk to the jury, *Household Co.* v. *Neilson*, 1 Webst. 697, n. (*r*).

(*s*) *Betts* v. *Neilson*, L. R. 3 Ch. 429, 441.

(*t*) *Dicks* v. *Brooks*, 15 Ch. D. 39, JAMES, L.J. See also *Colo* v. *Saqui*, 5 R. P. C. 489, 496; *Sanitas Co.* v. *Condy*, 4 R. P. C. 530.

(*u*) *United Telephone Co.* v. *Sharples*, 2 R. P. C. 28.

(*x*) *Needham* v. *Oxley*, 8 L. T. (N.S) 604.

were, on motion by the plaintiff made by special leave, subsequently varied so as to include this relief (*y*). Sect. 30. NOTE.

Where several defendants are infringing, and are liable to be sued jointly, each is liable for the whole of the damages caused to the plaintiff by the infringement (*z*). *Account and Damages.*

The account and also the inquiry as to damages extends to the sale of the articles complained of within six years of the commencement of the action (*a*). This, however, will be subject to the provisions of ss. 13 and 17 (4) (b). But where the plaintiff was assignee of a patent, the account of profits was only ordered from the date of the registration of the assignment (*b*). Extent of inquiry.

Where, however, the plaintiffs took over a business and certain patents, it was held that in estimating damages and to ascertain the loss of sales by the competition of the defendants, the plaintiffs might take into account the total quantities sold by the defendants before the plaintiffs acquired the business, they having succeeded to all the rights of their predecessors in title (*c*).

If damages are granted in substitution for an injunction, the court may assess the damages accrued after as well as before the issue of the writ (*d*); and by S. C. R. 1883, Order XXXVI. r. 58, where damages are to be assessed in respect of any continuing cause of action, they shall be assessed down to the time of assessment.

There is no jurisdiction under Lord Cairns' Act to award damages in substitution for an injunction when no wrongful act has been committed by the person against whom an injunction is sought (*e*).

The orders for account or for damages usually provide that the defendants shall pay the amount found due within a definite time after the filing of the certificate of the finding (*f*). But sometimes this is left to be dealt with on further consideration (*g*).

As to ascertainment of damages in the Queen's Bench Division, where the amount is a matter of calculation, see S. C. R. 1883,

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(*y*) *Edison, etc., Co.* v. *Holland*, 5 R. P. C. 459, 483.

(*z*) See *Clarke* v. *Newsom*, 1 Ex. 130. *Hume* v. *Oldacre*, 1 Starkie, 352.

(*a*) *Davenport* v. *Rylands*, L. R. 1 Eq. 302, 308.

(*b*) *Ellwood* v. *Christy*, 18 C. B. (N.S.) 494.

(*c*) *United Horse Shoe and Nail Co.* v. *Stewart*, 13 App. Cas. 401, 417.

(*d*) *Fritz* v. *Hobson*, 14 Ch. D. 543.

(*e*) *Dreyfus* v. *Peruvian Guano Co.* 43 Ch. D. 316.

(*f*) *Plimpton* v. *Malcolmson*, Seton, p. 565; *Cunningham* v. *Colling*, *ibid*, 567; *Young* v. *Fernie*, *Bovill* v. *Crate*, *Needham* v. *Oxley*, Pemberton, 485; *Westinghouse* v. *L. & Y. Rail. Co.*, 1 R. P. C. 253; *Otto* v. *Linford*, Appendix, *post*.

(*g*) *Davenport* v. *Rylands*, Pemberton, 484; *Betts* v. *Noel*, Seton, p. 567; *Hocking* v. *Fraser*, 3 R. P. C. 7.

Sect. 30. Order XXXVI. r. 57. The court may refer the damages to an official referee for inquiry and report (*h*).

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As to costs of inquiry as to damages or account of profits, see *ante*, p. 243, under s. 29 (6).

Certificate of validity questioned, and costs thereon.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs charges and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

These provisions are, in substance, a re-enactment of the Act of 1852, s. 43, which was in lieu of the Act of 1835, s. 3 (*i*), under which, upon a similar certificate being granted in the first trial, a plaintiff could, in a subsequent "suit or action touching such patent," recover treble costs.

Certificate not granted if verdict by consent.

"**Action for infringement of a patent.**"—Under the Act of 1835 it was held in *Stocker* v. *Rodgers* (*j*), that the certificate ought not to be granted if the verdict were for the plaintiff by consent, no evidence being offered. But where the validity of the patent had in part come in question, as for instance, where there was a plea that the invention was not new, and the defendant was prevented by the state of the pleadings from raising the further objection that the patent was illegal, it was held that, as the verdict on the plea of want of novelty was for the plaintiff, the certificate might be granted (*k*).

And under the present Act, where an action in which the validity of the patent was disputed was tried during some days and then a compromise was effected, and a consent order agreed to giving judgment for the plaintiff on the validity of the patent and for defendants on infringement, the certificate was given (*l*).

Where defendant does not appear at trial.

In *Peroni* v. *Hudson* (*m*) it was held that the section only applies when the patent is established in a case contested in court; and therefore, when the defendant put in a defence but did not appear at the trial, and the plaintiff proved his case, and obtained all the relief asked

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(*h*) *Westinghouse* v. *L. & Y. Rail. Co.*, 1 R. P. C. 253; and see *American Braided Wire Co.* v. *Thompson* (4), 5 R. P. C. 696.

(*i*) Now repealed: 5 & 6 Vict. c. 97.

(*j*) 1 C. & K. 99.

(*k*) *Gillett* v. *Wilby*, 1 Webst. 270; *S. C.* 9 C. & P. 334.

(*l*) *Delta Metal Co.* v. *Maxim-Nordenfelt, etc., Co.*, 8 R. P. C. 247.

(*m*) 1 R. P. C. 261.

by him, the certificate was refused. In *Haydock* v. *Bradbury* (*n*), and *Edison Bell Phonograph Co.* v. *Edison Phonograph Co.* (*o*), and *Edison United Phonograph Co.* v. *Young* (*p*), however, under like circumstances, the certificate was given.

Not given to defendant.

Under the Act of 1852 it was held that the certificate could not be given to the defendants in an action for infringement of patent (*q*).

Plaintiff failing in action.

In *Haslam Co.* v. *Hall* (*r*), a case under the present Act, the certificate was given to the plaintiff, although the patent was declared invalid. In this case the patent was established except as regarded one claim in the specification, but the learned judge refused to certify anything further than that the validity of the patent came in question.

The certificate has been given in actions in which the plaintiff succeeded as to the validity of the patent, but failed on the question of infringement (*s*). And this course was followed in *Tweedale* v. *Ashworth* (*t*), where after some evidence of the plaintiff had been given the defendant did not further dispute the validity of the patent.

Threats action not within this section,

In *Kurtz* v. *Spence* (*u*), it was held that an action under s. 32 of the present Act is not an "action for infringement of a patent," even though the questions of validity of the patent and infringement are raised, and that no certificate could be given under this section in such an action. In *Crampton* v. *Patents Investment Co.* (*x*), however, the certificate was given, but without prejudice to its validity if it should come into operation, the learned judge entertaining great doubt whether he had jurisdiction to grant it.

The certificate may be given although the patent has expired (*y*).

nor motion to commit.

It appears that the costs of a motion to commit for breach of an injunction are not within this section (*z*).

Where a certificate as to validity had been given in the first action, and in a second action, which resulted also in judgment for the plaintiff, the patent was attacked on grounds different from the grounds of attack in the first action, PEARSON, J., gave a second certificate certifying the extent to which the patent had been in controversy in the second action (*a*). But in *Edison, etc. Co.* v. *Holland* (*b*), where the certificate

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(*n*) 4 R. P. C. 75.
(*o*) 11 R. P. C. 33.
(*p*) 11 R. P. C. 489, 492.
(*q*) *Badische Anilin, etc. Fabrik*, v. *Levinstein*, 29 Ch. D. 366.
(*r*) 5 R. P. C. 1.
(*s*) *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 113, 120, 126; *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 342, 359; *Birch* v. *Harrap*, 13 R. P. C. 615, 627.
(*t*) 7 R. P. C. 426; 8 R. P. C. 49.
(*u*) 5 R. P. C. 161.
(*x*) 5 R. P. C. 382, 404.
(*y*) *Sunlight Incandescent, etc. Co.* v. *Incandescent Gaslight Co.*, 14 R. P. C. 757, 763, 776.
(*z*) *Spencer* v. *The Ancoats Vale Rubber Co.*, 6 R. P. C. 46, 68.
(*a*) *Otto* v. *Steel*, 3 R. P. C. 120.
(*b*) 6 R. P. C. 243, 287.

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had been given in the first action, the Court of Appeal under like circumstances refused to give any certificate in the second action on the ground that to give one might throw a doubt on the sufficiency of the former certificate.

"Court or a judge."—The Act of 1852, s. 43, required that the certificate should be given by "the judge before whom any such action should be tried," and therefore, where the court below had on the trial dismissed the action on the ground that the patent was invalid, and this decision was reversed on appeal, the Court of Appeal thought that the safer course was that application should be made for the certificate to the judge of the court below, and accordingly gave leave to apply to him for that purpose, and did not themselves grant the certificate (*c*). And in such a case the judge of the court below would, if necessary, apply to the Court of Appeal for information to enable him to determine what he would certify (*d*).

May now be given by Court of Appeal.

The present section removes this difficulty. The certificate may be given by "the court or a judge," that is, may be given in chambers (*e*), and "court," by the interpretation clause (s. 117 (1)), means the High Court of Justice; but by S. C. R. 1883, Order LVIII. r. 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court, and may, therefore, certify under this present section (*f*). The Act of 1852 provided that the certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent. There is no corresponding provision in the present Act in reference to proceedings for revocation.

The words "court or a judge" in this section were held not to include the Vice-Chancellor of the County Palatine of Lancaster, nor the Court of Appeal sitting on appeal from him (*g*). And, therefore, a certificate given by the Vice-Chancellor in an action where the plaintiff succeeded, and where the Vice-Chancellor's judgment was upheld by the Court of Appeal, was held not to be a certificate entitling the plaintiff in a subsequent action in the High Court to solicitor and client costs (*h*).

A certificate under this section is not a judgment or order within s. 19 of the Judicature Act, 1873, and is, therefore, not appealable (*i*).

(*c*) *Otto* v. *Linford*, Appendix, *post*.

(*d*) *Cropper* v. *Smith*, 2 R.P.C. 61.

(*e*) Judicature Act, 1873, s. 39.

(*f*) See *Birch* v. *Harrap*, 13 R. P. C. 615. See also *Shoe Machinery Co.* v. *Cutlan*, [1896] 1 Ch. 108, a case under s. 29.

(*g*) *Proctor* v. *Sutton Lodge Chemical Co.*, 5 R. P. C. 184.

(*h*) *Proctor* v. *Sutton Lodge Chemical Co.*, *ubi supra*. But see now 53 & 54 Vict. c. 23, ss. 3, 4, cited *post*, under s. 112 A.

(*i*) *Haslam Foundry, etc. Co.* v. *Hall*, 20 Q. B. D. 491; 5 R. P. C. 144, and see observations of PEARSON, J., *Cropper* v. *Smith*, 2 R. P. C. 63.

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"**In any subsequent action for infringement.**"—This section applies only to a second action for infringement, and therefore does not entitle a patentee to recover the full costs of a first trial (*k*).

NOTE. Section applies only to second action for infringement.

An action which was commenced before the date of the certificate in the first action is not a "subsequent action" within this section even though the defendants after that date amended their defence (*l*).

And when the second action was in the paper for trial at the same time as the first action, it was held that a certificate given in the first action did not make the defendant in the second action, although he raised the question of validity of the patent, liable to solicitor and client costs (*m*).

And apparently the certificate will not entitle a patentee who has succeeded in establishing his patent against one defendant to his costs as between solicitor and client in an action against another, a licensee, for royalties (*n*).

Under the express words of the Act of 1852, s. 43, the certificate was required to be given in evidence at the subsequent trial. These words are not in the present section. But the certificate should be pleaded in the second action (*o*).

"**Final order or judgment.**"—The corresponding words of the Act of 1852, "decree, decretal order or final judgment," were held not to apply to a motion for a new trial of the subsequent action, and the costs of an unsuccessful motion for a new trial were only given as between party and party (*p*).

"**Full costs charges and expenses,**" **etc.** — The result of the section appears to be that the *onus* is on the defendant in the subsequent action to show that the plaintiff ought not to have the full costs (*q*); and full costs will be given when the defendant on the motion for injunction consents to have the hearing of the motion treated as the trial of the action, and submits to an injunction notwithstanding previous negotiations for a settlement in which the question of costs was discussed (*r*).

Onus on defendant in second action to show why plaintiff should not have full costs.

(*k*) *Penn* v. *Bibby*, L. R. 3 Eq. 308.

(*l*) *Automatic Weighing Machine Co.* v. *International Hygienic Society*, 6 R. P. C. 475.

(*m*) *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 120.

(*n*) See *Bovill* v. *Hadley*, 17 C. B. (N.S.) 435. 5 & 6 Wm. 4, c. 83, s. 3, applied to every subsequent action *touching the patent.*

(*o*) *Pneumatic Tyre Co.* v. *Chisholm*, 13 R. P. C. 488.

(*p*) *Bovill* v. *Goodier*, Griffin, L. O. C. 49.

(*q*) *Davenport* v. *Rylands*, L. R. 1 Eq. 302, 309; *United Telephone Co.* v. *Patterson*, 6 R. P. C. 140. See also remarks of WILLES, J., in *Bovill* v. *Hadley*, 17 C. B. (N.S.) 439.

(*r*) *United Telephone Co.* v. *Townshend*, 3 R. P. C. 10.

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Full costs refused if first action collusive,

Or not conclusive.

The section appears not to apply to the costs of an appeal (*s*).

The court has a discretion to refuse these costs, and they would be refused where the first action was collusive, or the judge considered the case an improper one (*t*).

And full costs will be refused where, although the certificate was given in the former action, that action has not been conclusive between the parties, as where a verdict having been found for the plaintiff a new trial was directed, but was never had owing to the action having been compromised (*u*).

But plaintiff entitled to full costs, though validity of patent not contested in second action.

The mere fact of the validity of the patent not being called in question in a subsequent action is no ground by itself for the judge exercising his discretion in favour of the defendant and giving the certificate which will deprive the plaintiff of solicitor and client costs (*x*). And solicitor and client costs have been given when in the subsequent action judgment was given in default of defence (*y*).

In the case of *Otto* v. *Steel* (*z*), PEARSON, J., refused costs as between solicitor and client on the ground that the patent was impeached in the first action on different grounds to those on which it was impeached in the second action.

"Unless the court or judge trying the action certifies," etc.— Where the defendants did not dispute the validity of the patent, and all they had done was to try some years ago a process proved to be an infringement, which they had abandoned, and had never since used, and did not intend to use, and the damages were very trifling, the court considered the action vexatious, and certified under this section that the plaintiffs were not to have full costs (*a*). And full costs have been refused when the judge thought the litigation was owing to the lax manner in which the specification had been framed (*b*), and when the defendants were innocent infringers who took over the infringing machines when they bought a cotton mill, knowing little or nothing about them (*c*).

(*s*) *Incandescent, etc. Co.* v. *De Mare, etc. System*, 13 R. P. C. 559, 579. See also *Cole* v. *Saqui*, 40 Ch. D. 132.

(*t*) *Davenport* v. *Rylands*, L. R. 1 Eq. 309.

(*u*) *Betts* v. *De Vitre*, 11 Jur. (N.S) 9.

(*x*) See *per* CHITTY, J., *United Telephone Co.* v. *Patterson*, 6 R. P. C. 140, 142; see also *Davenport* v. *Rylands*, L. R. 1. Eq. 302, 308; see, however, *Automatic Weighing Machine Co.* v. *International Hygienic Society*, 6 R. P. C. 475.

(*y*) *Pneumatic Tyre Co.* v. *Chisholm*, 13 R. P. C. 488.

(*z*) 3 R. P. C. 120.

(*a*) *Proctor* v. *Sutton Lodge Chemical Co.*, 5 R. P. C. 184.

(*b*) *Automatic Weighing Machine Co.* v. *National Exhibitions Co.* 8 R. P. C. 345, 352.

(*c*) *Boyd* v. *Tootal, etc. Co.*, 11 R. P. C. 175, 185.

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But where the defendant, although not contesting the validity of the patent, denied infringement, and after a trial of several days the court decided against him, the court refused to give any certificate that the plaintiffs were not entitled to their full costs (*d*).

Decree in second action should direct the taxation as between solicitor and client.

The practice of the Court of Chancery being to tax costs as between party and party, in the absence of special directions to the contrary, it was held in *Lister* v. *Leather* (*e*), that the decree or order under s. 43 of the Act of 1852 should contain an express direction for the taxing master to tax the plaintiff's costs as between solicitor and client.

For form of certificate under this section and s. 29 (6), see Seton, p. 567, and Pemberton, p. 482.

The certificate is now usually embodied in the judgment (*f*).

By s. 18 of the Act of 1888 (*g*), similar provisions to the provisions of this section are enacted with respect to actions for infringements of a registered trade mark.

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention, by circulars advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture use sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Old law as to threatening notices.

"Where any person . . . threatens," etc.—In *Halsey* v. *Brotherhood* (*h*) it was held by the Court of Appeal, on the authority of *Wren* v. *Weild* (*i*), that a patentee who issued notices against purchasing certain articles, alleging they were infringements of his patent, was not liable to an action by the vendor for damages, provided he issued the

(*d*) *United Telephone Co.* v. *St. George*, 3 R. P. C. 321, 339.

(*e*) 4 K. & J. 425. See *North Metropolitan Tramways Co.* v. *London County Council*, [1898] 2 Ch. 145.

(*f*) Seton, p. 567.

(*g*) *Post*, p. 512.

(*h*) 19 Ch. D. 386, affirming decision of JESSEL, M.R., 15 Ch. D. 514.

(*i*) L. R. 4 Q. B. 730.

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notices *bonâ fide*, and in the belief that the articles complained of were infringements of his patent. And it was further held that such a patentee was not liable to be restrained by injunction from continuing to issue the notices unless they were proved to be untrue, so that the further issue of them would not be *bonâ fide*; and Lord COLERIDGE, C.J., said (*k*): "If the statement" (as to infringement) "is made in defence of the defendant's own property, although it injures and is untrue, it is still what the law calls a privileged statement; it is a statement that the defendant has a right to make unless, besides its untruth and besides its injury, express malice is proved, that is to say, want of *bona fides* or the presence of *mala fides*." The statements were not actionable if they were made with reasonable and probable cause (*l*). If, however, the statements were not mere allegations of piracy, which is matter of law, but went on to allege, and allege untruly, matters of fact, an action, it seems, would lie. "A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts" (*m*).

In *Rollins* v. *Hinks* (*n*), and *Axmann* v. *Lund* (*o*), MALINS, V.-C., had held that a patentee issuing notices as above was liable to be restrained by injunction if he had no *bonâ fide* intention of bringing an action against the vendor of the articles to assert the validity of his patent. But in *Halsey* v. *Brotherhood*, JESSEL, M.R., dissented from this view, and held there was no law in this country to compel a man to assert such a right by action. The person might desist, and then there would be no occasion for the action, or he might not be worth suing.

It appears, then, that the above section makes a considerable alteration in the law as to threats of legal proceedings in patent cases. The section imposes an absolute prohibition against a person threatening unless the threatener can bring himself within either of the two saving clauses at the end of the section. The meaning of the section is that a man shall not threaten legal proceedings unless the manufacture to which the threat applies infringes the legal right of the threatener, or unless the threatener is about forthwith to commence an action to show the validity of his threats. And it is *nihil ad rem* to say what he did was *bonâ fide* (*p*).

The question whether the statements of the patentee were in fact true might be tried in the action in which damages or an injunction

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(*k*) 19 Ch. D. 388.

(*l*) See judgment of BAGGALLAY, L.J., 19 Ch. D. 390.

(*m*) *Dicks* v. *Brooks*, 15 Ch. D. 22. See judgment of BRAMWELL, L.J., pp. 39, 40.

(*n*) L. R. 13 Eq. 355.

(*o*) L. R. 18 Eq. 335.

(*p*) See *per* A. L. SMITH, L.J.; see *Skinner* v. *Shew*, [1893] 1 Ch. 413, 426.

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was sought by the party aggrieved (*q*), and if the statements were in fact not true, the plaintiff to obtain an injunction was bound to make out that the defendant intended to persevere in making the representations complained of, although his allegation of infringement by the plaintiff was untrue (*r*). In such a case the injunction would be granted, because after the statements had been, in the presence of the patentee, proved to be false, it would be malicious and fraudulent to continue them (*s*).

But the mere assertion at the trial of the action of a right to issue the notices originally is no evidence of a threat to issue them, in the event of its being decided that there was no infringement (*t*).

In such an action the burden of proof that the patentee's statements are false lay on the plaintiff (*u*). On the question whether the patentee's statements as to infringement could be justified, the patent, if it had not been repealed by *scire facias*, was assumed to be valid (*x*).

Where after an action for infringement had been commenced a threats action alleging express malice was brought, it was held that in the absence of sufficient evidence no interlocutory injunction could be granted (*y*).

Where, in an action brought before but tried after this Act, it was proved that plaintiff had not infringed, but that the defendant's statements were made *bonâ fide*, the action was dismissed, but, each party having been partially successful, without costs (*z*). But in actions since the Act it is *nihil ad rem* to say that what the defendant did was *bonâ fide*, or that what he did was on a privileged occasion (*a*).

Where an action for an injunction to restrain the issue of circulars, etc., alleging infringement of a patent, had been commenced before the Act, a summons taken out after the action had been set down for trial (which summons was not, however, heard till after the Act), that the statement of claim might be amended by adding a claim for a declaration that the plaintiffs had not infringed the defendant's patent, or if they had that the patent was invalid, was dismissed (*b*).

(*q*) *Halsey* v. *Brotherhood*, 15 Ch. D. 518, judgment of JESSEL, M.R. and *Burnett* v. *Tak*, 45 L. .T (N.S.) 743.

(*r*) *Per* JESSEL, M.R., *Halsey* v. *Brotherhood*, 15 Ch. D. 523.

(*s*) *Per* KAY, J., *Burnett* v. *Tak*, 45 L. T. (N.S.) 743. See also *Household* v. *Fairburn*, 1 R. P. C. 109; *Sugg* v. *Bray*, 2 R. P. C. 224, 246.

(*t*) *Sugg* v. *Bray*, *ubi supra*.

(*u*) *Burnett* v. *Tak*, cited above; and see *Anderson* v. *Liebig's Extract of Meat Co.*, 45 L. T. (N.S.) 757, 759.

(*x*) *Per* BAGGALLAY, L.J., in *Halsey* v. *Brotherhood*, 19 Ch. D. 390, overruling the *dicta* of MALINS, V.-C., on this point, in *Rollins* v. *Hinks*, cited above.

(*y*) *Dredge* v. *Parnell*, 13 R. P. C. 392.

(*z*) *Sugg* v. *Bray*, 2 R. P. C. 224.

(*a*) *Per* A. L. SMITH, L.J., *Skinner* v. *Shew*, [1893] 1 Ch. 413, 426.

(*b*) *Sugg* v. *Bray*, 1 R. P. C. 45.

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"Any person claiming to be the patentee."—Only persons "claiming to be the patentees" can be sued under this section, and therefore where a threats action was brought against the agents of the owner of the patent, and it was proved that they had acted *bonâ fide*, the action was dismissed (*c*).

"By circulars advertisements or otherwise."—The words "or otherwise" are words to which an enlarging effect should be given so as to increase the methods by which an actionable threat can be made (*d*). And a private letter from the patentee (*e*) or his solicitor (*f*) threatening proceedings for infringement, and whether addressed to the infringer himself or a third person (*g*), is within this section. So also threats may be made by a letter in answer to inquiries (*h*) or at a personal interview, and by correspondence, although the interview and correspondence were with a view to a settlement and "without prejudice" (*i*).

And a letter may be a threat within the section, though it does not in terms refer to any patent in particular or set forth that the letter is written on behalf of a person claiming as patentee (*k*).

If the patentee complains not of the actual use of plaintiff's apparatus but of the use of certain apparatus in such a way as to infringe, he must make this clear in any circular or threat which he issues (*l*).

If a letter threatening proceedings is not withdrawn, it is to be taken as being continued (*m*).

"Threatens any other person," etc.—In *Challender* v. *Royle* (*n*) it was said by BOWEN, L.J., that: "The threat must not be merely a warning about something that is going to be done, but must be a threat about an act done, a threat of legal proceedings in respect of an alleged manufacture, use, sale, or purchase of the invention, not in respect of a proposed manufacture, use, sale, or purchase. . . . Everybody has still a right to issue a general warning to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled, and under which he claims, is one which he

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(*c*) *Temler* v. *Stevenson*, 15 R. P. C. 24.

(*d*) *Per* A. L. SMITH, L.J., *Skinner* v. *Shew*, [1893] 1 Ch. 427. See also *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 382, 393.

(*e*) *Walker* v. *Clarke*, 4 R. P. C. 113.

(*f*) *Driffield, etc. Co.* v. *Waterlow, etc. Co.*, 31 Ch. D. 638; *Combined Weighing etc. Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(*g*) *Skinner* v. *Shew*, [1893] 1 Ch. 413.

(*h*) *Skinner* v. *Shew*, [1893] 1 Ch. 413.

(*i*) *Kurtz* v. *Spence*, 5 R. P. C. 161, 172, 173. As to letters "without prejudice," see *Walker* v. *Wilsher*, 23 Q. B. D. 335.

(*k*) *Douglass* v. *Pintsch's Patent Lighting Co.*, [1897] 1 Ch. 176.

(*l*) *Burt* v. *Morgan*, 4 R. P. C. 279.

(*m*) *Driffield, etc. Co.* v. *Waterloo etc. Co.*, 31 Ch. D. 638, 643.

(*n*) 36 Ch. D. 425.

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intends to enforce." But "it does not follow that because a threat is so worded as grammatically to apply only to the future, therefore it may not in any particular case be in substance and in fact applicable to what has been done."

And in *Ungar* v. *Sugg* (*o*) it was said by WRIGHT, J., that the "section does not subject a patentee to an action for publishing a general statement that he claims to be the owner of a valid patent which covers all articles of a particular description, or that he has an action pending against a third party for infringement unless that statement is in fact meant or calculated to operate as a threat."

But when a circular stated that information of extensive violation of the patent rights had been received, and that all parties were warned not to infringe those rights, it was held that the circular was a threat within the section (*p*).

Where a defendant had consented to an injunction restraining him from representing that D.'s Little Fire Queen Extinguishers were infringements of his patent, it was held, on a motion to commit for breach of injunction, that evidence that defendant had stated that all conical-shaped fire extinguishers were infringements, and that the manufacture by the plaintiff of extinguishers similar in shape to defendant's was an infringement, was not enough to justify a committal (*q*).

"**Any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction,**" etc.—A person may be aggrieved within this section, though the threats are not addressed to himself (*r*).

In *Barney* v. *United Telephone Co.* (*s*), it was held that, to obtain an interlocutory injunction under this section, the applicant must show as a condition precedent that there is no infringement, and that if on the motion for injunction a case of alleged infringement is raised by the respondent's affidavits the motion will not be granted, although the respondent declines to take legal proceedings in respect of such infringement. This view of the section was dissented from in *Walker* v. *Clarke* (*t*), though the injunction was, under the circumstances, refused.

And in *Challender* v. *Royle* (*u*), it was held by the Court of Appeal that to obtain an interlocutory injunction under this section the plaintiff

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(*o*) 8 R. P. C. 385.

(*p*) *Johnson* v. *Edge*, [1892] 2 Ch. 1.

(*q*) *Dick* v. *Haslam*, 8 R. P. C. 196.

(*r*) *Burt* v. *Morgan*, 4 R. P. C. 278; *Walker* v. *Clarke*, 4 R. P. C. 111, 114; *Challender* v. *Royle*, 36 Ch. D. 425; *Johnson* v. *Edge*, [1892] 2 Ch. 1.

(*s*) 28 Ch. D. 394.

(*t*) 4 R. P. C. 114.

(*u*) 36 Ch. D. 425.

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must make out a *primâ facie* case that the matter to which the threats related is not, in fact, an infringement, and that, unless this is done, the court will not interfere on the mere balance of convenience and inconvenience.

In *Société Anonyme des Manufactures de Glaces* v. *Tilghman's Patent Sand Blast Co.* (*v*), a case before the Act, it was said that generally, where circulars of this kind are honestly issued, the court will not interfere at least till the hearing of the cause, unless there is some strong *primâ facie* case on the evidence before the court of the violation of some contract entered into between the plaintiff and defendant.

But if on the balance of the evidence on the motion the court considers that the plaintiff has not infringed, and if, further, the defendant does not bring an action, the interlocutory injunction will be granted (*w*). And when there is a doubt as to the infringement, the fact that the defendant refrains from bringing an action will be taken into consideration by the court in forming an opinion whether he has any rights within this section (*x*).

Where an action was brought to restrain the issue, by a company who were only limited exclusive licensees, of circulars within this section, and the patentees subsequently commenced against the plaintiff an action for infringement in which the company had applied to be joined as co-plaintiffs, a motion for an injunction in the first action was ordered to stand over till the result of the infringement action should be known, with liberty to any person to apply, all question of costs being reserved (*y*).

Where the patentee, defendant to an action seeking to restrain the issue of circulars alleging infringement, brought an action against the plaintiff for infringement, the court, in the absence of *mala fides*, or breach of contract, refused to grant an injunction pending the trial of the infringement action, the patentee undertaking to prosecute this latter action with due dilgence; and the injunction action was stayed meanwhile (*z*); and this undertaking not having been observed, the injunction was subsequently granted (*a*). And in *Mackie* v. *The Solvo Laundry Supply Co.* (*b*), where the infringement action was commenced after the notice of motion for injunction, but before the hearing of the motion, on the defendant disclaiming any intention of issuing further

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(*v*) 25 Ch. D. 9.
(*w*) *Colley* v. *Hart*, 6 R. P. C. 17.
(*x*) *Colley* v. *Hart*, *ubi supra*.
(*y*) *Barnett* v. *Barrett's Screw Stopper Bottling Co., Limited*, 1 R. P. C. 9.
(*z*) *Household* v. *Fairburn*, 1 R. P. C. 109. See also *Combined Weighing, etc. Co.* v. *Automatic Weighing Machine Co.*, 6 R. P. C. 502, 504, 42 Ch. D. 665, where, however, the threats action was not stayed.
(*a*) *Household* v. *Fairburn*, 2 R. P. C. 140.
(*b*) 9 R. P. C. 465.

threats and undertaking to prosecute the infringement action diligently, no order was made except that the costs should be costs in the action. Sect. 32.

But the threats action will not be stayed if the infringement action is only in respect of one of several patents mentioned in the threats action (*c*). NOTE.

Where there was a question whether certain letters complained of were intended as threats, and the defendants disclaimed any intention to threaten, the motion for injunction was ordered to stand to the trial with liberty to the plaintiff to bring it on on two days' notice (*d*).

It appears that application under this section ought not to be made *ex parte* (*e*).

An objection that the acts alleged are not threats within the Act cannot be taken as a preliminary objection on the trial of the action (*f*).

The interlocutory injunction should in form restrain the defendant from issuing the particular circular and "from by circular letters or otherwise threatening any person with proceedings or liability in respect of the following articles . . . . . manufactured by the plaintiff" (*g*). Form of injunction.

In an action against a patentee for falsely alleging infringement, the defendant may be ordered to deliver particulars showing in what respect plaintiff's machines are alleged to infringe defendant's patent, and pointing out, by reference to pages and lines of defendant's specification, which part of the invention therein described he alleges to have been infringed (*h*). Particulars in threats actions.

The plaintiff may be ordered to give particulars of the threats complained of (*i*) and of the names of the defendant's agents whom he alleged made the threats (*k*).

Where particulars of objections which had been delivered with the statement of claim in a threats action were insufficient, it was held that the defendants were entitled to further particulars before delivering their defence (*l*).

In an action under this section the plaintiffs, as a condition of being allowed to raise the question whether they could successfully impeach

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(*c*) *Dowson* v. *Drosophore Co.*, 12 R. P. C. 95.

(*d*) *Douglass* v. *Pintsch's Lighting Co.*, 13 R. P. C. 60.

(*e*) *Wilson* v. *W. E. Church Engineering Co.*, 2 R. P. C. 175; *Commercial Development Corporation* v. *Caxtner-Kellner Alkali Co.*, 14 R. P. C. 939.

(*f*) *Kurtz* v. *Spence*, 5 R. P. C. 161, 170.

(*g*) *Colley* v. *Hart*, 6 R. P. C. 17, 22.

(*h*) *Wren* v. *Weild*, L. R. 4 Q. B. 213.

(*i*) *Law* v. *Ashworth*, 7 R. P. C. 86.

(*k*) *Dowson* v. *Drosophore Co.*, 11 R. P. C. 536.

(*l*) *Law* v. *Ashworth*, 7 R. P. C. 86.

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the validity of the patent, were ordered to give to the defendants the same rights as to objections, and to allow them the same right of beginning and replying as the defendants would have had if an action had been brought by them to restrain the violation of their patent (*m*).

But where the threats complained of were contained in an advertisement referring generally to the defendants' patents, the order that the plaintiffs should deliver particulars of objections was made conditional upon the defendants first giving a list of the patents on which they relied as justifying their threats. And the plaintiffs agreed to amend their statement of claim by confining their allegation of invalidity to these particular patents (*n*).

Where the plaintiffs alleged that they had suffered damages by the threats, and had been compelled to indemnify customers continuing to purchase from them, it was held that they were not bound to furnish the names of those customers (*o*).

"And may recover such damages," etc.—Where no special damage was proved, and the plaintiffs, who had a rival patent which was alleged to infringe the defendants' patent, had only worked their process to a small extent, and had not as yet erected machinery for carrying out their process, and the threats were made in the course of a correspondence as to the relative rights of the parties under the rival patents, it was held that the circumstances under which the threats were made precluded the notion that serious damage was sustained, and the court refused to direct a reference, and itself assessed the damages at 40*s.* (*p*).

The necessity of suspending building operations and of making inquiries into the alleged infringement are not of themselves grounds for damages in an action by the person threatened (*q*).

The defendants are liable for damages caused by their own threats, not for damages caused by threats made by their travellers without their authority and without their knowledge (*r*).

Where a contract, providing that S. should have the exclusive right to buy the plaintiffs' patented article and should take a minimum quantity yearly, fell through on account of the defendant's threats, it was held that the measure of damages was the lost profits of the contract and not the difference between that amount and what the

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(*m*) *Kurtz* v. *Spence*, 36 Ch. D. 770.

(*n*) *The Union Electrical Power and Light Co.* v. *The Electrical Power Storage Co.*, 38 Ch. D. 325.

(*o*) *Law* v. *Ashworth*, 7 R. P. C. 86.

(*p*) *Kurtz* v. *Spence*, 5 R. P. C. 161, 177.

(*q*) *Driffield, etc. Co.* v. *Waterlow, etc. Co.*, 3 R. P. C. 48; 31 Ch. D. 638.

(*r*) *Ungar* v. *Sugg*, 9 R. P. C. 113.

plaintiffs might have made if they had gone on manufacturing the articles and sold them in the market (*s*).

When it was shown that all the falling off in the plaintiff's trade was due to the defendant's threats, but that some damage had been inflicted on the leading branch of his business, it was held to be reasonable to ascribe some damage to his general business also (*t*).

The difficulty of assessing the damages is no ground for giving only a nominal sum (*u*).

"Was not in fact an infringement of any legal rights," etc.—In *Kurtz* v. *Spence* (*x*) it was held that under this section only the question of infringement could be tried, and an allegation of the invalidity of the defendants' patent was ordered to be struck out of the statement of claim. In the subsequent case of *Challender* v. *Royle* (*y*), an opinion was expressed by COTTON and BOWEN, L.JJ., disapproving of the above decision. The plaintiffs in *Kurtz* v. *Spence* accordingly applied to the Court of Appeal for leave to appeal from the order striking the above-mentioned allegation from the statement of claim, notwithstanding the time for appealing had expired, and applied also to the judge before whom the action was set down for trial for leave to amend the pleadings by adding the allegation above mentioned. The judge refused this leave and both applications came on before the Court of Appeal. The leave to appeal was refused, but the majority of the court, FRY, L.J., *diss.*, gave leave to amend the statement of claim as desired, upon payment by the plaintiffs of the costs, as between solicitor and client, of the application, and of all costs thrown away in consequence of the amendment not having been made on the day following the order of the court below, and upon the plaintiffs undertaking to deliver particulars of objections and to give the defendants the right at the trial to begin and reply on the question of the validity of the patent (*z*).

When the action was ultimately tried, however, it was found inconvenient thus to limit the defendants' right, and they were allowed to open and reply on the whole case (*a*).

In *Herrburger* v. *Squire* (*b*), where the defendant by counterclaim alleged infringement of his patent and claimed the usual relief, this course was not followed and the action was tried in the usual way.

In *Challender* v. *Royle* there was no final judgment though there was an expression of opinion that the question of the validity of the

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(*s*) *Skinner* v. *Perry*, 11 R. P. C. 406, 420.

(*t*) *Ungar* v. *Sugg*, 8 R. P. C. 385; 9 R. P. C. 115.

(*u*) *Ungar* v. *Sugg*, *ubi supra*.

(*x*) 33 Ch. D. 579; 3 R. P. C. 368.

(*y*) 36 Ch. D. 425.

(*z*) *Kurtz* v. *Spence*, 36 Ch. D. 770.

(*a*) 5 R. P. C. 176.

(*b*) 5 R. P. C. 581.

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NOTE.

patent might be raised in an action under this section (*c*). But the question was raised on the trial of *Kurtz* v. *Spence*, and it was decided in that action that the words "legal rights" in the section meant rights enforceable in a court of law, and that the defendants could not protect themselves by the mere production of their letters patent, but were bound to support them as if plaintiff in an action for infringement (*d*). And, accordingly, in a threats action under this section when the defendant's patent is found invalid the injunction will be granted (*e*), and when the patent is found to be valid and infringed the action will fail (*f*).

A company having only an agreement with the registered proprietor for the assignment of the patent has no "legal rights" within the meaning of this section (*g*).

If the statement of claim does not allege the invalidity of the patent, the allegation may be made by reply subject to the defendant's right in that case to put in a special rejoinder (*h*).

"Provided that this section shall not apply," etc.—It is not necessary in order to be within the proviso that the action for infringement should be brought after the threats action, or that it should be an action in which the validity of the patent can be tried (*i*).

But an action for infringement pending at the time when the threats were made is not within the proviso when the infringement complained of is different from that which was the subject of the threats (*k*). So, also, where though the action for infringement was brought by the patentee, the threats were made not by him but by a company who had only an agreement with him for the assignment of the patent upon terms which were not disclosed to the court (*l*).

The defendant in a threats action is not bound to assert his right by defence or counterclaim, but may bring a separate action for infringement (*m*). But in such a case some arrangement should be made to avoid the unnecessary costs of trying the same action in different

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(*c*) 36 Ch. D. 443.

(*d*) 5 R. P. C. 161, 177. See also *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 382, 393; *Herrburger* v. *Squire*, 5 R. P. C. 581.

(*e*) *Kurtz* v. *Spence*, 5 R. P. C. 161. *Herrburger* v. *Squire*, *ubi supra*.

(*f*) *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 382, 404. And see *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 120, 125.

(*g*) *Kensington, etc. Electric Lighting Co.* v. *Lane Fox Electrical Co.*, [1891] 2 Ch. 573.

(*h*) *Dawson* v. *Drosophore Co.*, 12 R. P. C. 95.

(*i*) *Per* NORTH, J., *Barrett* v. *Day*, 43 Ch. D. 435, 447.

(*k*) *Combined Weighing Machine Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(*l*) *Kensington, etc. Electric Lighting Co.* v. *Lane Fox Electrical Co.*, [1891] 2 Ch. 573. But see *Incandescent Gas Light Co.* v. *New Incandescent, etc. Co.*, 76 L. T. (N.S.) 47.

(*m*) *Combined Weighing Machine Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D 665.

forms (*n*). And where this was not done, and the plaintiff in the threats action had offered to stay proceedings till the trial of the infringement action and the offer was refused by the defendants, and the actions came on for trial together, the threats action was dismissed without costs, although the plaintiffs were held not to have infringed the patent (*o*). Sect. 32 — Note.

Where by reason of the proviso being complied with the section does not apply, the case stands upon the old law, and in the absence of malice, an interlocutory injunction will not be granted (*p*). On the trial the threats action will in such a case be dismissed, although there has been no infringement (*q*). So, also, where the patent was shown in the infringement action to be invalid (*r*).

Where there was an action for threats and a cross-action for infringement, and at the trial the court, being of opinion that there was an infringement, dismissed the threats action with costs, and on appeal the judgment in the infringement action was reversed, the Court of Appeal referred the threats action back to the judge (*s*).

The section does not apply to threats relating to trade marks (*t*).

"With due diligence commences and prosecutes," etc.—If the action for infringement is commenced and prosecuted with due diligence the section does not apply (*u*). And therefore, where, after the commencement of the threats action, the patentee commenced and prosecuted with due diligence an action for infringement in which he failed, the threats action was dismissed (*x*).

So, also, where the infringement action was commenced and prosecuted with due diligence after the threat, a subsequent threats action was stayed as being vexatious within S. C. R. Order XXV., r. 4 (*y*).

Due diligence.

The words "with due diligence" do not mean that the action must be commenced with due diligence from the time when the defendant first knew that the plaintiff was doing what the defendant alleges to be an infringement, but within a reasonable time after the threats have

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(*n*) *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 367; *Combined Weighing Machine Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(*o*) *Combined Weighing Machine Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(*p*) *Incandescent Gas Light Co.* v. *Sunlight Incandescent, etc. Co.*, 14 R. P. C. 180; *Temler* v. *Stevenson*, 15 R. P. C. 24.

(*q*) *Colley* v. *Hart*, 44 Ch. D. 179; 7 R. P. C. 101, 114; *Combined Weighing Machine Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D. 665

(*r*) *Sharp* v. *Brauer*, 3 R. P. C. 193.

(*s*) *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 367, 371.

(*t*) *Colley* v. *Hart*, 6 R. P. C. 17.

(*u*) *Per* KEKEWICH, J., *Combined Weighing Machine Co.* v. *Automatic, etc. Co.* 42 Ch. D. 665.

(*x*) *Combined Weighing Machine Co.* v. *Automatic, etc. Co., ubi supra.*

(*y*) *Barrett* v. *Day*, 43 Ch. D. 435.

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been made (*z*). And an interval of three months is not an unreasonable time for a man to consider whether he should bring an action in respect of a supposed infringement of his patent (*a*).

Note.

But there is no hard and fast rule (*b*). And a patentee is not guilty of unreasonable delay if, after the commencement of the threats action, he waits to see if he cannot combine the two causes of action in one action and proceed by counterclaim (*c*).

And where the threats had been going on for a long time, during which the parties had been negotiating as to the use of the patent, and the plaintiff at last brought an action for threats and moved for injunction, and the defendants, after inspecting the plaintiff's machine, brought their action for infringement, it was held that there was no want of due diligence (*d*).

But when threats were made in October, 1886, and no proceeding to restrain infringement was taken by the patentee till after the commencement, in October, 1887, of an action under this section, in which the patentee by counterclaim alleged infringement, and claimed the usual relief, it was held that the patentee had not shown "due diligence" within the proviso (*e*).

And where after the commencement of a threats action the patentees brought their action for infringement, and undertook to prosecute it with diligence, and did not comply with their undertaking, the injunction was granted (*f*).

And when the infringement action is set down by the defendant, that is *primâ facie* evidence of want of due diligence in the prosecution of the action (*g*).

Where the patentee has brought his action for infringement, it would seem that, if it is prosecuted with due diligence, there is no ground for the court to interfere against him merely because he has not applied for an interlocutory injunction in his action (*h*).

Action need not be prosecuted to judgment.

It is not necessary in order to be within the proviso that the infringement action should be prosecuted to recovery of judgment if the action has been brought and prosecuted with due diligence. The

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(*z*) *Per* Cotton, L.J., *Challender* v. *Royle*, 36 Ch. D. 437.

(*a*) *Challender* v. *Royle*, *ubi supra*; *Colley* v. *Hart*, 44 Ch. D. 179.

(*b*) See *Colley* v. *Hart*, 44 Ch. D. 179, 187.

(*c*) *Colley* v. *Hart*, *ubi supra*.

(*d*) *Edlin* v. *Pneumatic Tyre, etc. Agency*, 10 R. P. C. 311.

(*e*) *Herrburger* v. *Squire*, 5 R. P. C. 581.

(*f*) *Household* v. *Fairburn*, 2 R. P. C. 140,

(*g*) *Combined Weighing Machine Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D. 665, 673.

(*h*) *Anderson* v. *Liebig's Extract of Meat Co.*, 45 L. T. (N.S.) 757.

threats action in such a case will be dismissed, although the infringement action is discontinued (*i*). Sect. 32.

NOTE.

And this rule was applied where the threats had been *bonâ fide* made in respect of three patents, and one of them was dropped out of the action for infringement (*j*).

But, where, in an action under this section, it was shown that a previous action for infringement brought by the defendant (the patentee) against the plaintiff had been discontinued, each party bearing certain costs, *it was held that the defendant in the threats action was not* protected by the proviso, even though the plaintiff in that action had failed to pay the agreed costs of the infringement action (*k*).

Against and by whom action may be brought.

The proviso will be satisfied if the patentee with due diligence commences and prosecutes an action for infringement, even though it be against a different person from the person aggrieved by the patentee's threats; it is sufficient if it be brought against any person to whom the threat has been made (*l*).

Where the owner of the patent had brought an action for infringement, exclusive licensees from him with an option of purchase were held to be within the proviso (*m*).

Infringement action must be *bonâ fide*.

The action for infringement must be an honest action, honestly brought in order to test the validity of the patent or the fact of infringement, whichever may be in question (*n*). And where the proceedings for infringement were only commenced by amendment of an existing action instituted for another purpose, and were abandoned almost as soon as put forward, it was held that the action was not within the proviso (*o*).

Where, by consent in a threats action, the motion for injunction was treated as the trial, and it was admitted that the defendants had not brought, and did not intend to bring, an action for infringement, and that as proceedings for amendment of their specification were pending, they were not in a position to bring such an action, the injunction was granted with an inquiry as to damages (*p*).

(*i*) *Colley* v. *Hart*, 44 Ch. D. 179; 7 R. P. C. 101; *English and American Machinery Co.* v. *Gare*, 11 R.P.C. 627; *Temler* v. *Stevenson*, 15 R. P. C. 24.

(*j*) *Temler* v. *Stevenson*, *ubi supra*.

(*k*) *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 382, 393.

(*l*) *Challender* v. *Royle*, 36 Ch. D. 425.

(*m*) *Incandescent Gas Light Co.* v. *New Incandescent Gas, etc. Co.*, 76 L. T. (N.S.) 47. But see *Kensington, etc. Co.* v. *Lane Fox, etc. Co.*, [1891] 2 Ch. 573.

(*n*) *Challender* v. *Royle*, *ubi supra*.

(*o*) *Johnson* v. *Edge*, [1892] 2 Ch. 1.

(*p*) *Skinner* v. *Shew*, [1893] 1 Ch. 413.

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NOTE.

To be within the proviso, the action must be an action for infringement in respect of the same manufacture, sale, or use as that to which the threats relate (*q*).

Advertisements by patentee licensor.

A patentee who has agreed to grant a licence will not be allowed, pending the settlement of disputes as to the validity of the agreement and the form of the licence, to publish advertisements and circulars, which will have the effect of deterring usual customers or the public from dealing with the licensee (*r*).

But the owners of English and foreign patents for the same invention, who have granted to a foreign firm a licence for the use of it in the foreign country and not elsewhere, will not be restrained at the suit of the foreign licensees from issuing circulars warning the trade that the importation into and sale in England of articles made abroad according to the invention is an infringement of the English patent (*s*).

Pending an action for infringement, a plaintiff is not at liberty to advertise a positive statement that the defendants have infringed (*t*), or simply that users of particular articles are liable to damages and injunction (*u*), but there is no objection to an advertisement stating the fact of the action having been brought and warning others from infringing (*x*).

An advertisement stating that in an action complaining of a certain alleged representation by the defendant, the defendant was ordered to give an undertaking not to make the representation when in fact he had volunteered the undertaking, and upon that the court had dismissed the action, was restrained as untrue and injurious to the plaintiff's trade (*y*). So, also, an advertisement by the plaintiff containing a report of the proceedings on a motion, and placing in heavily leaded type the statement of the plaintiff's counsel only, was held to be a contempt of court (*z*).

Plaintiffs who have brought an action for infringement, and in that action have obtained from the court liberty to apply to the Patent Office for leave to amend, are not entitled, pending the proceedings in

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(*q*) *Combined Weighing Machine Co.* v. *Automatic Weighing Machine Co.*, 42 Ch. D. 665, 670.

(*r*) *Clark* v. *Adie*, 21 W. R. 456; affirmed on appeal, *ibid*, 764. See also *Guyot* v. *Thomson*, [1894] 3 Ch. 388.

(*s*) *Société Anonyme des Manufactures de Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 Ch. D. 1.

(*t*) *Gaulard* v. *Lindsay*, 4 R. P. C. 189.

(*u*) *Fenner* v. *Wilson*, 10 R. P. C. 283.

(*x*) *Gaulard* v. *Lindsay*, 4 R. P. C. 189; *Incandescent Gas Light Co.* v. *Sunlight, etc. Co.* 14 R. P. C. 180. See also *Nähmaschinen Fabrik* v. *Singer Manufacturing Co.*, 10 R.P.C. 310.

(*y*) *Hayward* v. *Hayward* 34 Ch. D. 198.

(*z*) *Edlin* v. *Pneumatic Tyre, etc. Agency* (2), 10 R. P. C. 317.

the Patent Office, to issue notices threatening customers of the defendants (*a*). Sect. 32.

In such a case, it seems that the defendants seeking an injunction ought to undertake at the proper time to put in a counterclaim (*b*). NOTE.

Miscellaneous.

33. Every patent may be in the form in the First Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention. Patent for one invention only.

"**Every patent may be in the form,**" **etc.**—The form in the first schedule *does not contain any condition avoiding the patent if the* specification is insufficient which has hitherto been contained in all letters patent. But the use of this form is not obligatory, and under s. 116 the Crown may, if it is found necessary, insert such a condition in the patent.

"**One invention only.**"—The general object of the invention is the test by which the question of one invention is to be decided. If there is a particular general object and two or three devices of an analogous nature, cognate devices, for carrying it into effect, then they are all one invention. If, however, there is no common purpose, so that it might be said, "I use this as a substitute for that," both serving the same purpose though there is some difference between them, but they are to serve some different purpose, then the devices are different inventions (*c*).

Alternative devices for producing a particular object would be one invention (*d*).

A combination and all the subordinate parts of that combination, so far as claimed to be used for the one main purpose, may be included in one patent; but if a subordinate part, or one of the elements of the combination, is claimed for a purpose independent of the purpose of the combination, then there is an extra invention and it is not all one (*d*).

Thus where the law officer held that the applicant had invented, *first* an improved cock or arrangement of cocks, which he described as

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(*a*) *Fusee Vesta Co.* v. *Bryant & May* (2), 4 R. P. C. 191.
(*b*) *Ibid.*
(*c*) See *per* HERSCHELL, S.-G., *Jones' Patent*, Griffin, P. C. 265.
(*d*) *Jones' Patent*, *ubi supra*.

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applicable not only to geysers and the particular apparatus described by him, but also to other apparatus, and *second* an apparatus for an improved geyser consisting of a combination of several parts of which one was his new and improved arrangement of cocks, the applicant was not allowed to include both the inventions in one patent (*e*).

Use of the words "other purposes."

Under this section the applicant has been directed to omit from his title the words "a part of which improvement is applicable to other purposes," and also to omit corresponding words from his provisional specification (*f*).

When the application was for "improvements in the art of producing and utilising induced electrical currents *for telegraphy and other purposes*," the invention, consisting in the employment in telegraphic transmitting and receiving instruments of a certain appliance, HERSCHELL, S.-G., gave the applicant the option of protecting the appliance for all purposes, or of protecting improved telegraphic apparatus which consisted in the employment of the appliance therein, and the applicant electing to take the former alternative the title was altered by the omission of the words in italics, and the description of the telegraphic apparatus was struck out of the provisional specification (*g*).

Where the provisional specification did not sufficiently point out the common purpose which bound together the respective parts as one invention, the law officer required words to be inserted showing to his satisfaction that they had one common object (*h*).

If by inadvertence more than one invention is included, the application may, after the comptroller's refusal to accept it, be amended and separate patents may be applied for, but such application shall, if the applicant so desires, bear the date of the first application, and is together therewith to proceed as if such application had been originally made on that date (*i*).

If an invention omitted from the original application is claimed separately in a contemporary application, and is also part of the combination claimed by the original application, the latter should be amended so as to refer to the contemporary application (*k*).

Patent on application of representative of deceased inventor.

34.—(1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(*e*) *Hearson's Patent*, Griffin, P. C. 266.
(*f*) *Hearson's Patent*, *ubi supra*.
(*g*) *Robinson's Patent*, Griffin, P. C. 267.
(*h*) *Jones' Patent*, Griffin, P. C. 265.
(*i*) P. R. r. 19, *post*.
(*k*) *Hearson's Patent*, Griffin, P. C. 266.

(2.) Every such application (*l*) must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention. Sect. 34 (2).

This section alters the law as it was before the Act. In *Marsden* v. *The Saville Street Foundry and Engineering Co.* (*m*) it had been held that the legal personal representative of a person who had made an invention, but who had not taken out letters patent, could not take out such letters patent.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. Patent to first inventor not invalidated by application in fraud of him.

This section substantially re-enacts s. 10 of the Act of 1852. Under that Act it was held that where, on an opposition to the sealing of a patent on the ground of previous public user of the invention, the applicant alleged that such user took place in consequence of a fraud which, under the Act, would destroy its effect, such a question ought to be tried by a jury, and that the patent ought to be sealed, so that an opportunity for such trial might be given (*n*).

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only. Assignment for particular places.

The corresponding section (s. 35) of the Act of 1852 was that a patentee might "assign the letters patent for England, Scotland, and Ireland respectively as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only."

On this section it was said by the Court of Common Pleas that the Legislature appeared "to consider and treat the grants for England, Ireland, and Scotland, although in future they might be technically contained in one instrument under the Great Seal, as separate and separable grants in substance and operation" (*o*).

(*l*) P. R. r. 20.

(*m*) 3 Ex. D. 203.

(*n*) *Re Vincent's Patent*, L. R. 2 Ch. 341. See as to this *Stuart's Patent*, 9 R. P. C. 452.

(*o*) *Bovill* v. *Finch*, L. R. 5 C. P. 533. See *post*, s. 110.

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Where a patentee had granted an exclusive licence for the use of an invention within a limited district, and afterwards sold outside the district certain of the patented machines to persons who sold them, also outside the district, to the defendants, and the defendants without notice of the exclusive licence used the machines within the district, an injunction at the suit of the exclusive licensee seeking to restrain the defendants from such user was refused (*p*).

So, also, where the defendants had purchased from a licensee for a limited district, certain of the patented articles and afterwards sold them outside the district, it was held that patentee could not interfere with such sales (*q*).

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed (*r*).

This section is a re-enactment in effect of s. 22 of the Act of 1852.

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court.

The power to the law officers to examine witnesses on oath was introduced by the present Act. Under the old practice the Lord Chancellor had, in case of opposition, power to examine witnesses *viâ voce* (*s*).

"May make . . . . . rules."—See Law Officers' Rules, *post*.

"The law officer may order costs," etc.—The comptroller has no power as to costs.

It was held by Lord ELDON, in *Ex parte Fox* (*t*), that where the opposition failed but was not unreasonable no costs would be given.

(*p*) *Heap* v. *Hartley*, 5 R. P. C. 603. See *S.C.* on appeal, 42 Ch. D. 461.

(*q*) *Smith* v. *Buchanan*, 26 S. J. 347.

(*r*) See P. R., *post*, Second Schedule, Form N.

(*s*) *In re Gething*, L. R. 9 Ch. 633.

(*t*) 1 Webst. P. C. 431; *S.C.* 1 V. & B. 67.

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But in the later case of *Re Cutler's Patent* (*u*), Lord COTTENHAM, C., ordered the party who had lodged an unsuccessful *caveat* against the grant of letters patent to pay to the patentee the taxed costs occasioned by the *caveat*, and this notwithstanding the opposition was alleged to be reasonable. And this was the rule under the old practice (*x*), and *à fortiori* when the conduct of the opponents was open to suspicion (*y*).

And where objections were filed to the sealing of a patent, but were afterwards withdrawn, the opponent was ordered to pay the costs (*z*). But where the opponent's affidavits were only filed on the morning of hearing, and he was not allowed to use them, and the opposition failed, Lord CAMPBELL, C., said it was not a case for costs (*a*).

Where a patent was refused on the ground of previous dedication of the invention by the inventor to the public (*b*), the petition for patent was dismissed with costs (*c*).

So, also, where the application was refused on the ground that the invention was the same as in an existing patent (*d*).

Where, however, the opposition succeeded, but the case was one of first impression, no costs were given (*e*).

As between rival applicants for patents, the applicant who failed was ordered to pay costs (*f*). In a case between master and servant, the servant's patent was sealed, but as there appeared to have been some unfairness on the part of the latter, the master's patent was refused without costs (*g*).

Where the law officer reported in favour of the patent, but terms were imposed on the patentee, no costs were given (*h*).

Under the new practice the costs as a rule follow the event (*i*).

But where the opponents appealed from the decision of the comptroller on the ground that the excision of a claim which had been ordered necessitated an alteration in the description contained in the specification, and the applicants assented to this, but had not been asked before the appeal to agree to the modification, and it did not appear to be the fault of the opponents that the matter had arisen, an application

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(*u*) 4 My. & Cr. 510.

(*x*) *Re Harrison*, L. R. 9 Ch. 632; *Re Gething*, L. R. 9 Ch. 634.

(*y*) *Ex parte Scott and Young*, L. R. 6 Ch. 277.

(*z*) *Re Cobley's Patent*, 8 Jur. (N.S.) 106; *Re Ashenhurst Patent*, 2 W. R. 3.

(*a*) *Re McKean's Patent*, 1 D. F. J. 2, 4.

(*b*) Not now a ground of opposition. See s. 11 (1), *ante*.

(*c*) *Re Adamson's Patent*, 6 De G. M. & G. 420; *S.C.* 25 L. J. Ch. 456.

(*d*) *Ex parte Yates*, L. R. 5 Ch. 1.

(*e*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 577, 580.

(*f*) *Ex parte Henry*, L. R. 8 Ch. 171.

(*g*) *Re Lowe's Patent*, 25 L. J. Ch. 456.

(*h*) *Re Daine's Patent*, 26 L. J. Ch. 298.

(*i*) *Anderton's Application*, Griffin L. O. C. 25.

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of the applicants for costs was refused, and no costs were allowed (*k*). And where the law officer considered that a statement in one of the applicant's declarations was not quite candid, the applicant, though succeeding in the appeal, was not allowed costs (*l*).

Where an adjournment of the hearing was asked for the purpose of amending a notice of opposition, the adjournment was allowed on payment of costs (*m*).

Where an appeal was withdrawn after the notice of hearing had been given, the appellant was ordered to pay the costs (*n*). And when the appellant did not appear at the hearing, the appeal was dismissed with costs (*o*).

In the absence of any special circumstances, the comptroller, on an appeal to the law officer, neither gives nor receives costs (*p*).

Under the old practice, the taxation of costs in cases of opposition to patents was conducted on the principle on which taxation of costs between party and party in Chancery suits was conducted, and a petition that the applicants might be allowed all costs, charges, and expenses reasonably incurred in consequence of the opposition to the patent was dismissed with costs (*q*). The law officer may now fix the amount of the costs or direct how it is to be ascertained (L. O. R. r. 11, *post*); and this power of naming a specific sum for costs has been exercised in many cases (*r*). And where there were several opponents one sum has been allowed for costs, to be divided among the opponents (*s*).

When the appellant succeeds, the law officer, in fixing the costs, will have regard to the stamp which has been paid on the notice of appeal (*t*). And for this purpose it is desirable that on appeal each party should hand in a statement of what fees have been paid before the law officer (*u*).

The section does not empower the Attorney-General to order payment of costs in case of an abandoned application under s. 26 (4)(b), for his authority to present a petition for revocation of a patent (*x*).

(*k*) *Woodhead's Application*, Griffin, L. O. C. 44.

(*l*) *Anderton's Application*, *ubi supra*.

(*m*) *Lake's Application*, Griffin, L. O. C. 35.

(*n*) *Knight's Application*, Griffin, L. O. C. 35.

(*o*) *Dietz's Patent*, 6 R. P. C. 297.

(*p*) *Lake's Application*, Griffin, L. O. C. 16.

(*q*) *Re Cutler's Patent*, 4 My. & Cr. 511.

(*r*) See *Hall and Hall's Patent*, 5 R. P. C. 285; *Macevoy's Patent*, *ibid*; *Sielaff's Application*, 5 R. P. C. 485; *Lake's Patent*, 6 R. P. C. 548, 550; *Stuart's Patent*, 9 R. P. C. 452.

(*s*) *Johnson's Patent*, 13 R. P. C. 659, 664.

(*t*) *Aire and Calder, etc. Works Co. and Walker's Application*, 5 R. P. C. 345; *Wallis and Ratcliff's Application*, *ibid*. 347.

(*u*) *Sielaff's Application*, 5 R.P.C. 484, 486.

(*x*) *Martin's Patent*, Griffin, P. C. 320.

For form of order of law officer for taxation of costs, see Seton, p. 1980. Sect. 38.

As to costs in amendment cases, see *ante*, p. 76. NOTE.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,— Exhibition at industrial or international exhibition not to prejudice patent rights.

(a.) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so ; and

(b.) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

A re-enactment, with modifications, of the provisions of 28 Vict. c. 3, and 33 & 34 Vict. c. 27. As to proceedings by intending exhibitor of unpatented invention, see P. R. r. 15.

This section is now, by the Act of 1886 (s. 3), *post*, extended to industrial and international exhibitions held out of the United Kingdom.

40.—(1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important. Publication of illustrated journal, indexes, etc.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete

Sect. 40 (2). specifications of patents for the time being in force, with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

Patent museum.

41. The control and management of the existing Patent Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as Her Majesty in Council may see fit to give.

Power to require models on payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

43.—(1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything

intended to be sold in or exported from the territories of such foreign state. Sect. 43 (2).

Substantially a re-enactment of s. 26 of the Act of 1852, which altered the law as laid down in *Caldwell* v. *Vanvlissengen* (*y*), where an injunction was granted restraining subjects of the kingdom of Holland from using on board their ships, within the dominions of England, without licence of the plaintiffs, certain propellers made according to the plaintiff's patent.

Assignment to Secretary for War of certain inventions.

44.—(1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to Her Majesty's Principal Secretary of State for the War Department (herein-after referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and

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(*y*) 9 Ha. 415.

Sect. 44 (4). any copies of such documents and drawings, shall, instead, of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

(8.) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications documents and drawings shall be thenceforth kept and dealt with in the ordinary way. Sect. 44 (11).

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Substantially a re-enactment of 22 Vict. c. 13.

Existing Patents.

45.—(1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act. Provisions respecting existing patents.

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses.

(3.) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

The provisions of this section have now, or shortly will, become inoperative by lapse of time; but it has been thought desirable to retain the following note, somewhat abridged from the earlier editions.

Sect. 45 (4). The effect of sub-s. (3) was that the provisions of this Act as to amendment (*z*) (ss. 18 and 19) and extension (s. 25) applied to all patents whether existing at the commencement of the Act, or granted on applications then pending, or granted on applications after the commencement of the Act, subject, however, to the provisions of s. 113 (*post*) safeguarding vested rights and interests to the extent to which that section applies (*a*).

NOTE.

25th section of Act of 1852.

An important question may arise as to how far existing patents and patents granted on pending applications are affected in regard to s. 25 of the Act of 1852, which is repealed by the present Act and not re-enacted. By that section it was provided that where letters patent "are granted in the United Kingdom for or in respect of any invention first invented in any foreign country, or by the subject of any foreign power or State, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force; or when more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of the several patents or like privileges. Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted, or was in force, shall be of any validity."

Section 113, *post*, provides that the repeal effected by the present Act shall not affect the past operation of any of the enactments repealed.

It may well happen that there were, at the commencement of this Act, English patents posterior in date to foreign patents for the same invention, but which foreign patents have expired or otherwise determined. In such cases it would seem that under the above provision of s. 113 those English patents are void, and that advantage may after the Act be taken of that fact in any proceeding respecting the patent.

So also if the foreign patent was in force at the commencement of this Act, the subsequent English patent by virtue of s. 113, is subject to

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(*z*) See *Singer* v. *Stassen*, 1 R. P. C. 121, 125, 126.

(*a*) *Singer* v. *Stassen*, *ubi supra*; judgment of BOWEN, L.J.; *Brandon's Patent*, 9 App. Cas. 589.

the liability to fail if the foreign patent subsequently expire or be determined (*b*). Sect. 45 (4).

In view of the possible application above suggested of the provisions of s. 25 of the Act of 1852 to certain existing patents, the following short statement of the effect of the decided cases may be useful. NOTE.

Under that section it was held :—

That it did not apply at all to the case of an English patent obtained before any foreign patent was taken out, whether the patent were granted to an Englishman (*c*) or to a foreigner (*d*).

That where the English patent was subsequent to the foreign patent, and the latter ceased or became void, the English patent became void also (*e*), and this whether the English and foreign patentees were or were not *independent inventors* (*f*).

That, even if the foreign patent were void *ab initio*, s. 25 would apply, and that the existence of a void foreign patent was not equivalent to there being no foreign patent (*g*).

That if the foreign law required a formal declaration of *déchéance* in order to determine a patent, the English court would consider the English patent in force until that declaration were actually obtained (*h*).

That, for the purposes of the section, the date when the foreign patent was perfected, and not the day on which it is dated, is to be considered as the day when the patent was "obtained" within the meaning of the section (*i*).

That, when certain parts of the English patent were identical with the foreign patent, it did not follow as a necessary result that when the foreign patent was determined the rest of the English patent which was not identical was void also (*k*).

That, for the purposes of s. 25 of the Act of 1852, the date of the patent, and not the date of the sealing, was to be regarded (*l*).

That the defence of invalidity of the patent on the ground of the expiry of a previous foreign patent must be raised by the pleadings (*m*).

Upon applications for prolongation of the term of a patent, the Judicial Committee of the Privy Council were in the habit of acting

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(*b*) *Jablochkoff's Patent*, [1891] A. C. 293.

(*c*) *Re Betts' Patent*, 1 Moo. P. C. C. (N.S.) 49 ; *Re Poole's Patent*, L. R. 1 P. C. C. 515.

(*d*) *Winan's Patent*, L. R. 4 P. C. C. 93 ; *Blake's Patent*, *ibid.* 535.

(*e*) *Daw* v. *Eley*, L. R. 3 Eq. 497.

(*f*) *Hills' Patent*, 1 Moo. P. C. C. (N.S.) 258 ; 9 Jur. (N.S.) 1210.

(*g*) *Daw* v. *Eley*, L. R. 3 Eq. 511.

(*h*) *Ibid.* 496, 510.

(*i*) *Nordenfelt* v. *Gardner*, 1 R. P. C. 10.

(*k*) *Daw* v. *Eley*, L. R. 3 Eq. 512.

(*l*) *Holste* v. *Robertson*, 4 Ch. D. 9.

(*m*) *Bovill* v. *Goodier* (No. 2), L. R. 2 Eq. 195.

Sect. 45 (4). NOTE.

on the spirit of s. 25 of the Act of 1852, and would refuse a prolongation even if the English patent were prior to the foreign patent in cases where one of two or more foreign patents had, by the patentees under the English patents (being themselves foreigners), been allowed to expire (*n*).

For the present practice of the Judicial Committee, see under s. 25 (4).

Definitions.

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning Monopolies and Dispensations with Penal Laws and the Forfeiture thereof"), and includes an alleged invention.

In Scotland "injunction" means "interdict."

"**Patentee.**"—This definition allows an assignee (as under the old law) to apply for leave to amend a specification (s. 18) or for extension (s. 25). And see *ante*, pp. 69, 99.

"**Person**" includes "persons" (*o*), and "a body corporate" (*p*).

"**Invention.**"—See "Subject-matter," *ante*, p. 96.

PART III.

DESIGNS.

Registration of Designs.

Application for registration of designs.

47. (1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any

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(*n*) *Winan's Patent*, L. R. 4 P. C. C. 93; *Blake's Patent*, *ibid.* 535; *Newton's Patent*, 15 Moo. P. C. 176; *Normand's Patent*, L. R. 3 P. C. C. 193.

(*o*) 52 & 53 Vict. c. 63, s. 1. And see *Powell* v. *Head*, 12 Ch. D. 686, 690.

(*p*) Section 117, *post*.

new or original design not previously published in the United Kingdom, register the design under this part of this Act. Sect. 47 (1).

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed (*q*), and must be left at, or sent by post to, the Patent Office in the prescribed manner (*r*).

(3.) The application must contain a statement of the nature (*s*) of the design, and the class or classes of goods in which the applicant desires that the design be registered (*t*).

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6.) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade (*u*).

(7.) The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

SUB-SECTION 1.

"**Proprietor.**"—In the Act of 1861 (*x*) there was an express enactment that the Designs Act should extend to any proprietor, whether or not a subject of her Majesty. That Act is now repealed, and there is no corresponding provision in the present Act; but since the word "proprietor" is there used without any limitation, it is presumed that a foreigner may, subject to the provisions of s. 54, register a design equally with a British subject (*y*); and see *post*, s. 61.

(*q*) D. R., r. 4, *post*.

(*r*) *Ibid.* r. 11; all communications may be signed by agents, r. 6.

(*s*) *Ibid.* r. 9, and Form E, Second Schedule to D. R.

(*t*) *Ibid.* r. 5 (for the classes, see Third Schedule to D. R., *post*).

(*u*) D. R., rr. 15—19.

(*x*) 24 & 25 Vict. c. 73, s. 1.

(*y*) *Guiterman's Design*, 55 L.J. (N.S.) Ch. 309, reported as *Ex parte Wild*, 2 Times R. 174.

Sect. 47 (1). "**New or original.**"—That is, the design mus. ither be substantially novel or substantially original, having regr . to the nature and character of the subject-matter to which it is t . plied (*z*). "It must be new or original with reference to th . article for which it is registered, meaning by kind of article the class of article mentioned in the schedule to the rules, but the kind of article having regard to its general character and use. A design may be new for a coal-scuttle but not for a bonnet. On the other hand, a design for a shade of a gas-lamp can hardly be new if it was old for an oi. lamp" (*a*).

NOTE.

And therefore where a design has been registered in one class for a particular article of a certain material, it cannot be registered by another person in another class for a similar article of a different material, as such a design would not be new or original (*b*).

But a design already on the register may be registered in another class for an article applied to a different purpose (*c*).

Under the Act of 1842 the design was required to be "new *and* original," and the same words are used in s. 61 of the present Act.

There is a distinction between the words "new" and "original." Every design which is original is new, but every design which is new is not necessarily original (*d*).

Thus, a design applicable to ornamental tiles, consisting of a new arrangement of well-known parts, was held to be new, but not original. If there had never been any ornamental tiles, and a designer had designed the design in question, that would have been original (*e*).

And a design may be new though it is founded upon one which the designer has previously registered (*f*).

On the question of the novelty of a design applicable to articles of utility, effect has been given to the fact that directly the design was put on the market it at once commanded a large sale, and that the so-called anticipations were never practically sold at all (*g*).

In considering whether a design is new or original, no part of the description under which it was registered can be rejected (*h*).

Meaning of "design."

The interpretation clause (s. 60) does not throw much light on the meaning of the word "design" *per se*, since it merely says that "design" in the Act means a "*design* applicable," etc.

(*z*) *Per* FRY, L.J., *Le May* v. *Welch*, 28 Ch. D. 35.

(*a*) *Per* LINDLEY, L.J., *Clarke's Design*, [1896] 2 Ch. 38, 45.

(*b*) *Read and Greswell's Design*, 42 Ch. D. 260; *Bach's Design*, 42 Ch. D. 661.

(*c*) *Bach's Design*, *ubi supra*.

(*d*) See *per* CHITTY, L.J., *Rollason's Design*, [1898] 1 Ch. 248; 14 R. P. C. 909, 914.

(*e*) *Per* MANISTY, J., *Sherwood* v. *Decorative Art Tile Co.*, 4 R. P. C. 207, 209.

(*f*) *Harper* v. *Wright*, [1896] 1 Ch. 142, 151.

(*g*) *Tyler* v. *Sharpe*, 11 R. P. C. 35.

(*h*) *Smout* v. *Slaymaker*, 7 R. P. C. 90.

Sect. 47 (1). NOTE.

In *Harrison* v. *Taylor* (*i*), a case under the old Acts, BYLES, J., thus defined a "design": "I think 'design' imports, among other things, variations on old forms in respect of size, configuration, colour, and other qualities; but where size may introduce novelty into some parts of a design it may not do so in other parts. Configuration may constitute a new design, for where there is alteration of proportions that may be a new design"; and in the same case, WIGHTMAN, J., said: "I apprehend a design to be not a project or invention, but a picture or drawing—something which the inventor has for the first time produced."

Must appeal to the eye.

A "design" within this section must be something which appeals to the eye (*k*), it must be capable of existence outside the article itself (*l*). The question whether it adds to the utility of the articles to which it is applied or not is immaterial (*m*). Therefore an arrangement for fastening the busk in a corset which did not show any novelty in appearance, or shape, or configuration, was held not proper subject for a design (*n*).

And a design for a basket, the claim being for the pattern of the basket consisting in the oziers being worked in singly with all the butt ends outside, was held incapable of registration, the claim being in fact for a process or mode of manufacture (*o*).

Combination designs.

A new and original combination may be a design within the Act, as the result of simultaneously applying two old and known designs to the ornamenting of a button (*p*).

So, also, a honeycomb pattern consisting of a combination of a large honeycomb and a small honeycomb arranged to form a large honeycomb stripe on a small honeycomb ground, both the large and small honeycomb pattern being previously well known, but the combination being new, was protected (*q*).

And a figure of six-pointed stars on an Albert chain arranged in a particular manner, and shaded, was a good design as applied to a woven fabric (*r*).

(*i*) 4 H. & N. 815; *S.C.* 5 Jur. (N.S.) 1219.

(*k*) *Cooper* v. *Symington*, 10 R. P. C. 264.

(*l*) See *per* VAUGHAN WILLIAMS, J., *Moody* v. *Tree*, 9 R. P. C. 333.

(*m*) See *per* LINDLEY, L.J., *Clarke's Design*, [1896] 2 Ch. 43.

(*n*) *Cooper* v. *Symington*, *ubi supra*.

(*o*) *Moody* v. *Tree*, *ubi supra*.

(*p*) *R.* v. *Firmin*, cited *Harrison* v. *Taylor*, 3 H. & N. 304; *Norton* v. *Nicholls*, 1 E. & E. 765; *S.C.* 5 Jur. (N.S.) 1203; *Sherwood* v. *Decorative Tile Co.*, 4 R. P. C. 207.

(*q*) *Harrison* v. *Taylor*, 4 H. & N. 815; *S.C.* 5 Jur. (N.S.) 1219. See also *Rollason's Design*, [1898] 1 Ch. 237; 14 R. P. C. 909.

(*r*) *Holdsworth* v. *McCrea*, L. R. 2 H. L. 380.

Sect. 47 (1).

NOTE.

And when the general idea of a design for lace, viz., a scalloped border and a flowing backing, was old, and the class of border and class of backing was old, and a coral backing with a scalloped border was old, it was held that a new and pretty example of the general idea was a good design (*s*).

And a writing table of which no part was new in itself, but which was novel in its arrangements, novel in its details as a combination, and novel also in its general design and appearance, was held to be within the Act (*t*).

If a combination design be registered, it is the combination which is protected, and not the separate parts (*u*).

Must be one design, and not a multiplicity of designs.

But in order that a combination design may be good, the result must be one design, and not a multiplicity of designs. And therefore a design for a shawl which had five peculiarities, each of which was in itself old, was not a design which could be registered under the old Acts. What is protected is not the article of manufacture, but the design applicable to the article of manufacture, and this was not a case of several designs going to make up one design, but of several designs applicable to one article of manufacture (*x*).

And where there were four old designs applied respectively to three ribbons and a button, and the three ribbons were then united so as to form a badge, this was held by Lord HATHERLEY, then V.-C., not to be a design within the Act (*y*).

And something novel must be introduced into the combination.

In *Lazarus* v. *Charles* (*z*), MALINS, V.-C., observed that the cases of *Harrison* v. *Taylor* and *R.* v. *Firmin* had given an exceedingly liberal interpretation to the Act, and said that he would follow them with great reluctance unless something novel were introduced into the combination; and he held that a mere combination of two old card-baskets into one basket, making a double basket, could not be registered.

So, also, a design for a shirt collar which showed no marked novelty, but differed from previous collars only in small particulars (*a*).

And a design for the shape of a lamp reflector which differed from known reflectors only by the addition or omission of details which were immaterial, and did not substantially alter the shape, was held incapable of registration (*b*).

(*s*) *Birkin* v. *Pratt*, 12 R. P. C. 371.

(*t*) *Heinrichs* v. *Bastendorff*, 10 R. P. C. 160

(*u*) *Holdsworth* v. *McCrea*, *ubi supra*.

(*x*) *Norton* v. *Nicholls*, 1 E. & E. 765; *S.C.* 5 Jur. (N.S.) 1203.

(*y*) *Mulloney* v. *Stevens*, 10 L. T. (N.S.) 190.

(*z*) L. R. 16 Eq. 117.

(*a*) *Le May* v. *Welch*, 28 Ch. D. 24; *Smith* v. *Hope*, 6 R. P. C. 201.

(*b*) *Clarke's Design*, [1896] 2 Ch. 38; see also *Sherwood's Design*, 9 R. P. C. 268.

Sect. 47 (1).

NOTE.

And an old border taken from a well-known duster and applied to a previously existing fabric was held not to constitute a new design within the Act (*c*).

A copy of a photograph of a public character is not a new or original design which can be registered (*d*); nor was the use of an arch under the body of a carriage for the purpose of enabling the wheels to pass under the carriage during the turning of the carriage, when the novelty was that the arch proposed was only larger than that formerly used for the same purpose (*e*).

When during the existence of the copyright in a design, the same design is registered with a slight variation as an improvement, it is open to any one as soon as the term of the original registration has expired to copy the original design, omitting the variation (*f*).

Article in two parts may be registered.

But an article in two parts, such as a butter-dish consisting of a dish and a cover, is one article of manufacture, and the design may be registered (*g*).

Question for originality is for jury, and is matter of eyesight.

The question whether a design is new and original is for the jury, and is to be decided from the evidence of experts, and principally from eyesight (*h*).

A design may be registered in respect of an article not complete in itself, but which is to be used in combination with another article (*i*).

No analogy between patents and designs.

There is little or no analogy between patents and designs (*k*); and, therefore, where the design was for a combination of large and small honeycomb patterns, and it was shown that a pattern called "hopsack" pattern had been used in the same way, the Court of Exchequer Chamber, reversing the decision of the Court below, refused to follow the analogy of the case of *Brook* v. *Aston* (*l*), where it was held that there could be no patent for a mere application of old means to a new purpose, and held the honeycomb combination to be a good design (*m*). So also where doors having mouldings along the top had been in use in articles of furniture, such as sideboard covers, and the like, a kitchen

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(*c*) *Hothersall* v. *Moore*, 9 R. P. C. 27.

(*d*) *Adams* v. *Clementson*, 12 Ch. D. 714; see, however, observations on this case in *Saunders* v. *Wiel*, 9 R. P. C. 467, [1893] 1 Q. B. 470.

(*e*) *Windover* v. *Smith*, 32 Beav. 200; 9 Jur. (N.S.) 397.

(*f*) *Harper* v. *Wright*, [1896] 1 Ch. 142, 153.

(*g*) *Fielding, app.* v. *Hawley, resp.*, 48 L. T. (N.S.) 639.

(*h*) *Harrison* v. *Taylor*, 4 H. & N. 815; *S.C.* 5 Jur. (N.S.) 1219. See also *per* FRY, L.J., *Le May* v. *Welch*, 28 Ch. D. 37, and *per* CHITTY, L.J., *Rollason's Design*, [1898] 1 Ch. 249; 14 R. P. C. 909, 914.

(*i*) *Walker* v. *Falkirk Iron Foundry Co.*, 4 R. P. C. 392.

(*k*) *Harrison* v. *Taylor*, 4 H. & N. 815; 5 Jur. (N.S.) 1219.

(*l*) 8 E. & B. 478.

(*m*) *Harrison* v. *Taylor*, cited above.

Sect. 47 (1).

NOTE.

range door with a moulding along the top edge, which would make a continuous moulding with the other part of the range, was held to possess sufficient novelty to sustain the design (*n*). Nor is the proprietor of the design bound to distinguish what is new from what is old (*o*), nor to describe it with the same nicety and accuracy as is required in the specification of a patent (*p*). The fact that a patent might have been obtained for the article does not prevent its registration as a design (*q*).

And on the question of novelty or originality it is wholly immaterial how or by what movements of machinery the design is produced (*r*).

A design may be registered as an improvement upon one previously registered, and the registration may be good even though the new design contains all the essential features of the original design (*s*).

Idea of the design.

The Act does not require novelty in the idea of the design, but novelty in the design itself, that is, novelty in the way in which the idea is to be made applicable to some special subject matter. And, therefore, a design may be a good design, although it is taken from a source common to all mankind (*t*).

And a design in metal for a spoon handle consisting of a representation of Westminster Abbey taken from a photograph, was held a proper subject for registration (*u*).

Novelty distinct from publication.

"Not previously published in the United Kingdom." etc.—The question of novelty of a design is not necessarily the same as the question of publication in the United Kingdom (*x*). If the design has been previously so published, of course the design cannot be registered, although it may have been independently invented (*y*); but even if the particular design may not have been so published, the case of *Lazarus* v. *Charles*, and the other cases cited above, show that the Court will sometimes take upon itself to say that a particular design does not contain a sufficient element of novelty to entitle it to registration.

What is publication.

Under the 4th section of the Act of 1842, which required the design to be registered "before publication thereof," a doubt was expressed

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(*n*) *Walker* v. *Falkirk Iron Foundry Co.*, *ubi supra*.

(*o*) *McCrea* v. *Holdsworth*, L. R. 6 Ch. 420, *per* Lord HATHERLEY, C.

(*p*) *Holdsworth* v. *McCrea*, L. R. 2 H. L. 385, *per* Lord CRANWORTH. See also judgment of Lord WESTBURY.

(*q*) *Walker* v. *Falkirk Iron Co.*, *ubi supra*.

(*r*) *Plackett's Design*, 9 R. P. C. 436.

(*s*) *Harper* v. *Wright*, [1896] 1 Ch. 142, 151.

(*t*) *Saunders* v. *Wiel*, [1893] 1 Q. B. 470, 474. See also *Hollinrake* v. *Truswell*, [1894] 3 Ch. 420, 427, a copyright case.

(*u*) *Saunders* v. *Wiel*, *ubi supra*. *S. C.*, before CAVE, J., 9 R. P. C. 467.

(*x*) *Rivett* v. *Grimshaw*, 11 R. P. C. 352.

(*y*) *Smout* v. *Slaymaker*, 7 R. P. C. 99.

whether the term "publication" was limited to publication of the design itself or to publication after the design had been embodied and introduced into some fabric (*z*). **Sect. 47 (1).** NOTE.

Where the inventor before registration showed the design to a commission agent to ascertain whether the latter thought it was likely to succeed, and the commission agent showed it to customers and obtained orders for the article: it was held under the present Act that there had been a publication of the design (*a*).

It is evidence against the defendant of the novelty and originality of the design that he has copied into his own catalogue a pictorial representation of the design in the plaintiff's catalogue (*b*).

If a design, not new or original, has been registered, it may be removed from the register. See *post*, under s. 90.

In the Act of 1842, s. 3, after the words United Kingdom were the words "or elsewhere."

SUB-SECTION (2).

As to correction of clerical errors in, or in connection with, an application for registration of a design, see s. 91 (*a*), *post*, and as to amendments, see D. R., r, 30, *post*. In certain cases the comptroller has a discretion as to evidence, *ibid.* r. 29.

SUB-SECTION (3).

"**Statement of the nature of the design.**"—The Designs Rules, 1890, r. 9, require that the applicant shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

The forms of application (forms E and O) do not require any statement of the means by which the design is applicable, and against the words "statement of nature of design" is a marginal note "such as whether it is applicable for the pattern or for the shape."

The rule makes it essential for the person claiming the design to distinguish between the several things named in the rule, and to show for which of them he makes his claim (*c*). And if the applicant chooses in his application to draw such distinction, this must be borne in mind in the consideration of every question of novelty and originality (*d*).

(*z*) *Dalglish* v. *Jarvie*, 2 Mac. & G. 231.

(*a*) *Blank* v. *Footman*, 39 Ch. D. 678; *Winfield* v. *Snow*, 8 R. P. C. 15. See also *Hunt* v. *Sterens*, W.N. 1878, 79, under the old Act.

(*b*) *Heinrichs* v. *Bastendorff*, 10 R. P. C. 160.

(*c*) *Per* Lord HERSCHELL, *Harper* v. *Wright*, [1896] 1 Ch. 142, 149.

(*d*) See *per* VAUGHAN WILLIAMS, L. J., *Rollason's Design*, [1898] 1 Ch. 252; 14 R. P. C. 909, 916.

Sect. 47 (3).

NOTE.

When the design is registered as "applicable to pattern, shape, and configuration," the registration applies to the design as a whole (*e*).

"Class or classes of goods."—For the purposes of registration of designs, goods are classified in the manner appearing in the third schedule to the Designs Rules, 1890.

"Set" of articles.

A design may be registered as applied to single articles in a class, or as applied to a "set" of articles for a class; and the term "set" includes any number of articles ordinarily on sale together, irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate "set" of articles. See D. R., First Schedule, *post*.

SUB-SECTION (4).

A design already on the register may be registered in another class for an article applied to a different purpose (*f*), but not for an article merely of a different material (*g*).

SUB-SECTION (5).

"Piece goods" (class 13) denotes goods measured by the piece and sold by the piece; goods which, though woven in the piece, are subdivided in pattern by cross lines or other demarcations, showing that they would be sold not by measurement but by number, fall within the class of handkerchiefs and shawls (class 14); but to avoid any difficulty a person may register under both classes (*h*).

SUB-SECTION 7.

Under the corresponding provision in the case of refusal by the comptroller to register a trade mark (*i*), it was held that the applicant could not appeal direct to the Court from such refusal as a person aggrieved within s. 90 of this Act, but must appeal to the Board of Trade (*k*).

The sub-section differs from the corresponding provisions as to trade marks in not giving authority to the Board of Trade to refer the appeal to the Court; see s. 62 (5), *post*, and notes thereto. Proceedings under this Act by or before the Board of Trade are now regulated by s. 102A added by the Act of 1888, s. 25, *post*.

(*e*) *Harper* v. *Wright*, *ubi supra*.
(*f*) *Bach's design*, 42 Ch. D. 661.
(*g*) *Bach's design*, *ubi supra*. *Read and Greswell's design*, 42 Ch. D. 260, 262.
(*h*) *Hothersall* v. *Moore*, 9 R. P. C. 27, 38.
(*i*) Sect. 62 (4), *post*.
(*k*) *Re Trade Mark* "*Normal*," 35 Ch. D. 231.

The provisions of the repealed Act of 1850 (*l*) as to provisional registration are not re-enacted in this Act.

See further as to affect of registration, s. 58, *post*.

Sect. 47 (7)

NOTE.

48. (1.) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings photographs or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design (*m*).

Drawings, etc., to be furnished on application.

(2.) The comptroller may, if he thinks fit, refuse any drawing photograph tracing representation or specimen which is not, in his opinion, suitable for the official records.

SUB-SECTION (1).

"**Exact representations or specimens.**"—The privilege of registering a pattern was expressly conferred by the Act of 1858 (*n*), under which it was held that if the pattern consisted of different parts, each of which separately might have been registered as a design, the registering the pattern was a claim only to the combination shown in the pattern, and not to the separate parts (*o*).

Under the special words of the Act of 1858 it was held that if a pattern were registered, there was no need of a written description, which was in certain cases required by the other Acts (*p*). In the present Act, however, the "specimen" is only to be instead of a copy of the design. It is presumed, therefore, that a description sufficient to satisfy s. 47, sub-s. (3), will be necessary, whether a specimen is or is not furnished to the comptroller.

Exact representations or specimens, if not furnished on the application to register, must be furnished to the comptroller before the articles to which the design is to be applied are offered for sale. See s. 50 (2), *post*.

(*l*) 13 & 14 Vict. c. 104.

(*m*) D. R., *post*, rr. 8, 9.

(*n*) 21 & 22 Vict. c. 70, s. 5. In *Norton* v. *Nicholls*, 4 K. & J. 475. Wood, V.-C., held that the registration of a specimen was registration of a copy within the 5 & 6 Vict. c. 100, s. 15, contrary to the opinion of the Court of Queen's Bench in the same case, 5 Jur (N.S.) 1203.

(*o*) *Holdsworth* v. *McCrea*, L. R. 2 H. L. 380; *Grafton* v. *Watson*, 50 L. T. (N.S.) 420, affirmed 51 L. T. (N.S.) 143.

(*p*) *Holdsworth* v. *McCrea*, *ubi supra*.

Sect. 48 (1). As to the extent of protection when the design is registered by sample, see *post*, under s. 58.

NOTE.

SUB-SECTION (2).

"The comptroller may . . . refuse," etc.—When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs shall be furnished (*q*).

Certificate of registration.

49. (1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

See *post*, s. 96.

Copyright in Registered Designs.

Copyright on registration.

50. (1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2.) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

SUB-SECTION (1).

"Copyright" is defined *post*, s. 60.

SUB-SECTION (2).

"Before delivery on sale."—These words remove the doubt as to the meaning of "publication" expressed in *Dalglish* v. *Jarvie*, cited *ante*, p. 355. And see *post*, s. 51.

"Shall cease."—See *post*, s. 51.

(*q*) D. R. r. 9.

Sect. 51.

Marking registered designs

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered (*r*); and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

"Delivery on sale."—Where lace according to a registered design was made in a "brown" state (in which state it was really unfinished and not saleable to the public) and was sold to a "finishing" firm by whom it was "finished" and sold to the public, it was held that the sale to the "finishing" firm was a sale within this section and, the lace not having been marked with the prescribed mark, that the copyright had ceased (*s*).

The section was held to apply to the delivery on sale after the Act of an article made according to a design registered under the old Act (*t*).

"Shall cause each article to be marked," etc.—Under the corresponding provisions in the Acts of 1842 and 1843 (*u*), where the words were that no person should be "entitled to the benefit" of the Act unless the register mark was placed on "every" article of manufacture on which the design was used, it was held that the provisions of the Act were imperative, and that there was no equity in the Court to relieve against the statute (*x*); and where it was shown in one case (*y*) that two articles, and in another (*z*) that one article, had not been stamped with these marks, the plaintiffs could not establish their copyright, and an injunction was refused. And it was necessary that this mark should be placed on all the articles, whether sold abroad or in this country (*a*).

A book of copies of registered designs was under the old Acts held not to require the registration mark (*b*).

Patterns.

It was also held under the old Acts that every portion of the article containing the design which is published and put forth by the

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(*r*) D. R. r. 32.

(*s*) *Woolley* v. *Broad*, 9 R. P. C. 429.

(*t*) *Wittman* v. *Oppenheim*, 27 Ch. D. 260.

(*u*) 5 & 6 Vict. c. 100, s. 4; 6 & 7 Vict. c. 65, s. 3.

(*x*) *Peirce* v. *Worth*, 18 L. T. (N.S.) 710; W. N. (1868), 217.

(*y*) *Peirce* v. *Worth*, cited above.

(*z*) *Hunt* v. *Stevens*, W.N. [1878], 79.

(*a*) *Sarazin* v. *Hamel* (No. 1), 32 Bea. 145; *S.C.* (No. 2), *ibid.* 151; 9 Jur. (N.S.) 192.

(*b*) *Branchardière* v. *Elvery*, 4 Ex. 380; 18 L. J. (N.S.) Ex. 381.

Sect. 51.

NOTE.

manufacturer as such must contain the prescribed mark; and therefore, where a manufacturer of wall papers sold as patterns small pieces containing the whole design, but not marked as required by the Act, it was held that he was not protected, and could not maintain an action for infringement (*c*). But now, since articles need only be marked before "delivery on sale," it would seem that mere patterns if not sold need not be marked.

If the article itself were in two parts it was, under the old Acts, held sufficient if one part was marked with the prescribed marks (*d*).

And where a trimming could not itself be conveniently marked, and was sold in parcels, each containing a certain number of yards, each parcel having round it a paper band properly marked, it was held, under the present Act, that the provisions of this section had been sufficiently complied with (*e*).

But where a design, registered in class 13 for textile piece goods was applied to a set of dusters woven in sets of twelve, it was held not sufficient to mark the piece only and that each duster must be marked (*f*).

If during the progress of manufacture part of the registered mark on the article becomes illegible, it seems that this will not deprive the proprietor of the protection of the statute (*g*).

The putting Regd. on an article instead of the letters Rd. which were prescribed by the Design Rules was held not to vitiate the registration (*h*). Nor if the proper registered number is on the articles sold is the protection lost because the proprietor has mistakenly placed on them other registered numbers which ought not to be there (*i*).

"Unless the proprietor," etc.—This provision was introduced by the present Act.

Where the proprietors of the design had directed the manufacturer to affix the proper mark, but the manufacturer had inadvertently affixed another mark belonging to the same proprietors, but both marks contained the word Rd. (meaning registered), it was held that the proprietors were protected by this proviso (*k*). But it is doubtful whether the proviso would apply to a case where there had been an omission on the part of the manufacturer to affix any mark to the article (*l*).

(*c*) *Heywood* v. *Potter*, 1 E. & B. 439.

(*d*) *Fielding*, *app.*, *Hawley*, *resp.*, 46 L. T. (N.S.) 639.

(*e*) *Blank* v. *Footman*, 39 Ch. D. 678.

(*f*) *Hothersall* v. *Moore*, 9 R. P. C. 27.

(*g*) *Fielding*, *app.*, *Hawley*, *resp.*, *ubi supra*. But see *Johnson* v. *Bailey*, 11 R. P. C. 21.

(*h*) *Heinrichs* v. *Bastendorff*, 10 R. P. C. 160.

(*i*) *Harper* v. *Wright*, [1896]. 1 Ch. 142.

(*k*) *Whitman* v. *Oppenheim*, 27 Ch. D. 260.

(*l*) *Ibid.*

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NOTE.

Where the proprietor had given proper instructions to a die sinker to prepare a series of eight dies for stamping the articles with the registered number and by error of the die sinker 5 was substituted for 3 in one of the dies, and the error was not found out till several articles wrongly stamped had been sold, and it was shown that the proprietor had himself examined the first impressions of the dies and had overlooked the error, it was held that the proviso applied and that the copyright had not ceased (*m*).

But the mere giving instructions that the articles are to be marked without taking adequate means to see that the instructions are carried out is not sufficient (*n*).

Inspection of registered designs.

52.—(1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee (*o*).

This and the next section re-enact, with modifications (the most important of which is the power given to the Court to authorise an inspection), s. 17 of the Act of 1842.

By s. 6 of the Act of 1888 the following words are added after sub-s. (1) of this section :—

"Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered."

Information as to existence of copyright.

53. On the request of any person producing a particular design, together with its mark of registration, or producing

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(*m*) *Rollason's design*, 14 R. P. C. 893, 909.

(*n*) *Johnson* v. *Bailey*, 11 R. P. C. 21.

(*o*) D. R. r. 33.

Sect. 53.

only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design (*p*), and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Cesser of copyright in certain events.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

Register of Designs.

Register of designs.

55.—(1.) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed (*q*).

(2.) The Register of Designs shall be *primâ facie* evidence of any matters by this Act directed or authorised to be entered therein.

See *post*, ss. 87, 88, 89, 90, 91, 93.

"**Assignment.**"—Under the Act of 1842 it was held that no assignment or licence could be made or granted by the proprietor before he himself had registered (*r*). There is no express enactment to this effect in the present Act, but looking to s. 87, and to the fact that the provisions of the Designs Rules apply only to a "registered design" (see r. 21 also Forms K and K1 in D. R., Second Schedule), it would appear that the law remains the same in this respect also.

Under the Act of 1842, s. 6, which contained forms of assignment, and required the "writing" to be produced to the registrar, it was held

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(*p*) Or whether a particular design produced is identical with or an obvious imitation of a registered design, D. R. r. 35, *post*.

(*q*) D. R. rr. 20—28.

(*r*) *Jewitt* v. *Eckhardt*, 8 Ch. D. 404, 409.

that an assignment or licence must be in writing (*s*). There is no such provision in terms in the present Act or Rules, nor is there any requirement as to the mode of assignment or licence. But s. 58 (a) prohibits the application of the design by any person without the "licence or written consent" of the registered proprietor. Sect. 55. NOTE.

"**Transmission.**"—Copyright in a design will devolve on the executor of the proprietor (*t*).

"**Such other matters,**" **etc.**—D. R., r. 21, *post*, extends the operation of this section to "any share or interest" in the copyright of a registered design, and to the case of a person acquiring "any right to apply the design either exclusively or otherwise." Where the name of a company registered as proprietors of a design has been changed the court may order the name on the register to be changed to the new name (*u*).

Under the Act of 1842, ss. 3 and 5 (substantially re-enacted in ss. 60 and 61 of the present Act, pp. 372, 374, *post*), the exclusive right to apply the design might be the subject of licence, or might be assigned wholly or partially (*x*).

Moreover, the right might be divided so that a right might be given to apply the design to certain articles but not to others (*y*). This would appear, reading the above Rule in connection with ss. 60, 61, and 87, of this Act, to be still the law.

See also notes under s. 61, *post*.

Fees.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct (*z*). Fees on registration, etc.

Industrial and International Exhibitions (*a*).

57. The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition Exhibition at industrial or international

(*s*) *Jewitt* v *Eckhardt*, 8 Ch. D. 404, 409.
(*t*) *Ibid.* p. 409.
(*u*) *Pneumatic Tyre Co.'s Registered Design*, 11 R. P. C. 636.
(*x*) *Jewitt* v. *Eckhardt*, 8 Ch. D. 404, 409.
(*y*) *Ibid.*
(*z*) D. R. First Schedule, *post*.
(*a*) D. R. r. 36, Form L.

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exhibition not to prevent or invalidate registration.

elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; namely,—

(a) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and

(b) The application for registration must be made before or within six months from the date of the opening of the exhibition.

A re-enactment, with modifications, of the provisions of 28 Vict. c. 3, and 33 & 34 Vict. c. 27, applying to designs.

This section is now, by s. 3 of the Act of 1886, extended to industrial and international exhibitions held out of the United Kingdom. See *post*, p. 511.

Legal Proceedings.

Penalty on piracy of registered design.

58. During the existence of copyright in any design—

(a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Sect. 58.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any Court of competent jurisdiction.

This section is, by the Act of 1888, s. 7, amended as follows :—

(1.) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

(2.) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

The section is a re-enactment, with modifications, of s. 7 of the Act of 1842. An important modification is that in clause (b) the word "knowing" is substituted for the more complicated provisions of the old Act.

Distinction between the manufacturer and retailer.

Clause (a), it will be noted, deals with the manufacturer, and clause (b) with the retailer; and the latter is only liable if he sells the article knowing that the design has been applied without the proprietor's consent.

See also s. 59.

Where a defendant, a lace merchant, and not a manufacturer, had bought undressed lace and sent a pattern of plaintiff's registered design (which had been sent him) to another manufacturer, who applied the design to the lace, the lace merchant was held to have "caused to be done" the *acts forbidden by s. 7 of the Act of 1842, and to be liable to* the plaintiff (*b*).

The manufacturer of an article within the provisions of the Act is bound to inquire whether the design is already registered (*c*).

Infringement

"It shall not be lawful . . . to apply such design," etc.— Infringement of a design consists in the production of the goods in this country, and therefore the application in Lisbon by British subjects having works there of a design registered in England to articles for which the design was registered, and which were sold in Lisbon, was held to be no infringement (*d*).

(*b*) *Mallet* v. *Howitt*, W.N. [1879], p. 107. See also *Sykes* v. *Howarth*, 12 Ch. D. 826.

(*c*) *Per* JESSEL, M.R., *Mallet* v. *Howitt*, W. N. [1879], p. 107.

(*d*) *Potter* v. *Braca de Prata Printing Co.*, 8 R. P. C. 218.

Sect. 58.

NOTE.

"Such design or a fraudulent or obvious imitation."—The words "such design," without the words "fraudulent imitation," will prohibit anything which is substantially the same design. "Fraudulent imitation" is "imitation with knowledge, ... conscious imitation, the man having the design before him" (*e*).

In this Act the words "or obvious" have been added after the word "fraudulent" in the corresponding sentence of the Act of 1843.

"Obvious" does not mean that which is obvious at a glance to the uneducated or unskilled eye; it means obvious to the judge or to the jury with the assistance of experts—persons conversant with the particular trade (*f*). An imitation may be fraudulent without being obvious (*g*). And where the registered design is known and there is imitation, the burden of proving that the registered design was not copied is thrown on the person who produces the pattern like that which is imitated (*h*).

The Court may take into account the state of knowledge at the time of registration, and in what respects the design was new or original, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial (*i*).

On question of infringement of design, the appeal is to the eye.

On the question whether a design has been infringed, "the appeal is to the eye, and the eye alone is the judge of the identity of the two things" (*k*), and this is a question for the jury (*l*).

It is not necessary, in order to establish a case of infringement, that every detail should be actually copied. It is sufficient if the thing complained of is, to all appearance, the same as the registered design (*m*).

Thus the plaintiff had a design of a metal stove supported on feet, above which was a base sloping upwards with open tracery, and above that a gothic window, and above that again other tracery, and a projecting cornice and a cover sloping up to an apex surmounted by a

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(*e*) *Per* JESSEL, M.R., *Barran* v. *Lomas* 28 W. R. 973, 974, 975. See also judgment of COTTON, L.J., *Grafton* v. *Watson*, 51 L. T. (N.S.) 143.

(*f*) *Per* CHITTY, J., *Grafton* v. *Watson*, 50 L. T. (N.S.) 420, affirmed 51 L. T. (N.S.) 143.

(*g*) *Sherwood* v. *Decorative Tile Co.*, 4 R. P. C. 207, 210.

(*h*) *Grafton* v. *Watson*, *ubi supra*.

(*i*) *Heela Foundry Co.* v. *Walker*, 14 App. Cas. 550, 555; *Harper* v. *Wright*, [1896] 1 Ch. 142, 146.

(*k*) *Per* Lord WESTBURY, *Holdsworth* v. *McCrea*, L. R. 2. H. L. 388. See also *Heela Foundry Co.* v. *Walker*, 14 App. Cas. 550, 557. See also *Barran* v. *Lomas*, 28 W. R. 975; and compare *Mitchell* v. *Henry*, 15 Ch. D. 181, and observations of CHITTY, J., in *Grafton* v. *Watson*, 50 L. T. (N.S.) 420.

(*l*) *McCrea* v. *Holdsworth*, L. R. 1 Q. B. 264.

(*m*) *McCrea* v. *Holdsworth*, L. R. 6. Ch. 419; *Harper* v. *Wright*, [1896] 1 Ch. 142; *Oliver* v. *Thornley*, 13 R. P. C. 490.

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knob. The defendants sold a stove which could be described by the above general description, but in which the tracery, the style of architecture of the window, and other details were different from the corresponding details in the plaintiff's stove. It was held by the Court of Appeal that the stoves being alike in all their essential features, the defendant's stove was an "obvious imitation" of the plaintiff's, and an infringement of the registered design (*n*).

"But a fair imitation, that is to say something to which the idea of the original design has been applied, is not prohibited. I take an illustration from architecture, though a man could not take either Teutonic capitals or the Greek capitals, the Act would not prevent his using the composite capitals" (*o*). And if one man takes a particular view of Westminster Abbey and puts it on the top of a spoon by way of ornamentation, anyone may take a different view (*p*). And if the whole point of the design consists merely of a cathedral window of a particular kind, a design consisting of a cathedral window of another kind would not infringe (*q*). So, also, when the resemblance between the plaintiff's and defendant's designs for lace were only in the general ideas of the plaintiff's design which were common and old (*r*). Or where the only novelty in a design for an oil-can for cyclists was a rounded edge, which the defendants did not take (*s*), it was held that there was no infringement.

And in *Demartial* v. *Booth* (*t*), where a design for a china dinner-service was registered as for a "richly embossed shape," and it appeared that the shape itself was old, and the defendant's article differed entirely in ornamentation from the design of the plaintiff's, it was held that the plaintiff's design had not been infringed.

One test of infringement is whether the defendants would obtain any right by registering their design consistently with the plaintiff's registration (*u*).

Registration by sample.

Where a design was registered by sample, it was said under the old law, by Lord WESTBURY, that in such a case all that was protected was the thing in the exact form and relation, position and proportions, as they appeared on the pattern (*x*), and that anything

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(*n*) *Harper* v. *Wright*, [1896] 1 Ch. 142.

(*o*) *Per* JESSEL, M.R., *Barran* v. *Lomas*, 28 W. R. 974; and see also *Hollingrake* v. *Truswell*, [1894] 3 Ch. 420, 427, a copyright case.

(*p*) *Per* CAVE, J., *Saunders* v. *Wiel*, 9 R. P. C. 469.

(*q*) See *per* Lord HERSCHELL *Harper* v. *Wright*, [1896] 1 Ch. 142, 148, and see *S.C.* [1895] 2 Ch. 593.

(*r*) *Birkin* v. *Pratt*, 12 R. P. C. 371.

(*s*) *Walker* v. *Scott*, 9 R. P. C. 482.

(*t*) 9 R. P. C. 499.

(*u*) *Walker* v. *Hecla Foundry Co.*, 5 R. P. C. 73.

(*x*) *Holdsworth* v. *McCrea*, L.R. 2 H. L. 388.

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which was a *fac simile* of that drawing—any other pattern which was a reproduction of that in its integrity—became an infringement. But that which was different in shape and form, or in the relative position of the several parts, which was not a production of it, as a *replica* or copy of a picture, would not be an infringement of the thing so specified.

But in the subsequent case of *McCrea* v. *Holdsworth* (*y*), these words were explained by Lord Hatherley, L.C., to mean merely that the design could be only as it was represented, and that the learned lords considered that the question whether there was any difference in the effect would be left to the jury, and he added: "Their lordships seem to have meant that the designer is not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing what is new from what is old; but if he chooses to put it in that way, it will not be protected as against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect, or nearly the same effect, then of course the shifting or turning round of a star, as in this particular place, cannot be allowed to protect the defendant from the consequences of the piracy." And the defendant's design being for all practical purposes identical with the plaintiff's design, a decree was made in favour of the plaintiff.

When the design is for shape or configuration, this alone is to be looked to on a question of infringement, and the court ought not to consider whether the defendant's design accomplishes the same useful end as the plaintiff's (*z*).

Working on plaintiff's design.

Under the old Act it was held that the mere fact of working on the plaintiff's design did not constitute the patterns so produced an infringement of designs which had been registered by sample only (*a*) And this is the same under the present Act (*b*).

But where plaintiff's designs had been registered by sample, and it was admitted that defendants had worked on them and had instructed their artists to produce the same effect, but to avoid the *minutiæ* of plaintiff's design, it was held, under the present Act, that a combination of drawings similar to plaintiff's, and so arranged and coloured as to produce a similar effect, was legally a fraudulent and obvious imitation

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(*y*) L. R. 6 Ch. 418.
(*z*) *Hecla Foundry Co.* v. *Walker*, 14 App. Cas. 550.
(*a*) *Thom* v. *Syddall*, 26 L. T. (N.S.) 15; 20 W. R. 291.
(*b*) *Demartial* v. *Booth*, 9 R. P. C. 499, 502.

within this section, though it imitated neither the dominant nor subservient parts of plaintiff's design (*c*).

NOTE.

A design may, however, be an infringement, though it be devised independently of the plaintiff's design (*d*).

Design may be registered as applied to a particular thing, but it cannot be claimed apart from that thing.

A design may be registered in respect of an article to be used in combination with another article (*e*). But if a design be registered as applied to any particular thing, it seems that it cannot be claimed apart from that thing (*f*).

"**For purposes of sale.**"—Under corresponding words in the Act of 1842, s. 7, an injunction was granted by KNIGHT BRUCE, V.-C., to restrain not merely the sale but the manufacture of articles to which the design was applied during the continuance of the registration, and this although it was not intended that they should be sold till the term of protection had expired. And the articles complained of were ordered to be given up to the plaintiff for the purpose of being destroyed (*g*).

"**Knowing that the same has been so applied without the consent,**" **etc.**—These words differ somewhat from the corresponding part of s. 7 of the Act of 1842, under which the retailer was not liable to be sued till he had received "knowledge" that the proprietor's consent had not been given, or had been served with written notice to that effect by the proprietor (*h*); but the effect of the present words appears to be substantially the same. If written notice is relied on it should show the defendant distinctly and intelligibly that the design was applied without the plaintiff's consent (*i*).

A mere notice by the proprietor that the retailer is selling goods (the sale of which was open) with registered patterns, the notice not containing any pattern of the design, or giving any detail of what is claimed, is not of itself sufficient to fix the retailer with knowledge within the sub-section (*k*).

Where the defendants, on complaint made by a notice which the court held insufficient to fix them with knowledge within this

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(*c*) *Grafton* v. *Watson*, 50 L. T. (N.S.) 420, affirmed 51 L. T. (N.S.) 143. See also *Harper* v. *Wright*, [1896] 1 Ch. 142.

(*d*) *Walker* v. *Hecla Foundry Co.*, 5 R. P. C. 73, 368.

(*e*) *Walker* v. *Falkirk Iron Co.*, 4 R. P. C. 392.

(*f*) *Barran* v. *Lomas*, 28 W. R. 973.

(*g*) *McCrea* v. *Holdsworth*, 2 De G. & Sm. 499; *S. C.* 12 Jur. 820. See the form of the decree also in Pemberton, p. 484. See also *Crossley* v. *Beverley*, 1 Webst. 119, a patent case.

(*h*) *Norton* v. *Nicholls*, 1 E. & E. 765; 5 Jur. (N.S.) 1203; see remarks of JESSEL, M.R., *Halsey* v. *Brotherhood*, 15 Ch. D. 517.

(*i*) *Norton* v. *Nicholls*, *ubi supra*; *Smith* v. *Roberts*, 5 R. P. C. 611.

(*k*) *Smith* v. *Roberts*, 5 R. P. C. 611.

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section, at once stopped their sale of goods of the class complained of, and did not know, till after an inspection subsequent to the commencement of the action, of the plaintiff's designs, that they had infringed the plaintiff's copyright, and had then at once returned the goods bearing infringing designs to the manufacturers, it was held that they had done no wrong within this section, and the action was dismissed with costs (*l*)

"**Any person who acts in contravention,**" **etc.**—This section imposes a penalty, and the plaintiff in an action to recover such penalty for infringement of his copyright in a design cannot interrogate the defendant as to the infringement charged (*m*).

"**Who may recover,**" **etc.**—Under the old law (Act of 1842, s. 8) the penalty could be recovered by action or by summary proceedings before justices of the peace. On similar words in the corresponding section of the Copyright (Works of Art) Act (*n*), it was held that process before a magistrate to enforce the penalty was of a criminal nature, and not for a debt (*o*). It will be observed that in this sub-section the penalty is recoverable only by action, and is made a simple contract debt.

The plaintiff is not confined to the recovery of the penalty. He may have also the ancillary remedy by injunction (*p*).

"**For every offence.**"—Where, in an action for an infringement of a design for ornamental tiles, the only sale proved against the defendants was one sale of 100 tiles, this sale was treated as one offence only, and judgment was given for one penalty of 50*l*. (*q*). The court or jury may assess the penalty at less than 50*l*. (*r*).

The total sum to be forfeited in respect of any one design is now limited to 100*l*. (*s*).

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture

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(*l*) *Smith* v. *Roberts*, 5 R. P. C. 611. See also *Jan* v. *Grossman*, 12 R. P. C. 539.

(*m*) *Saunders* v. *Wiel*, [1892] 2 Q. B. 18, 321 ; 9 R. P. C. 459.

(*n*) 25 & 26 Vict. c. 68. s. 6.

(*o*) *Ex parte Graves*, L. R. 3 Ch. 642.

(*p*) *Cooper* v. *Whittingham*, 15 Ch. D. 501, 506 ; see also *Sheriff* v. *Coates*, 1 R. & M. 159.

(*q*) *Sherwood* v. *Decorative Tile Co.*, 4 R. P. C. 207, 212.

(*r*) *Saunders* v. *Wiel*, [1892] 2 Q. B. 321, 323 ; 9 R. P. C. 464, 470.

(*s*) *Ante*, p. 365.

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or substance, or from the publication sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

See s. 58.

A substantial re-enactment of s. 9 of the Act of 1842, adding, however, the words "or obvious" after "fraudulent."

"The registered proprietor . . . may, if he elects," etc., "bring an action."—The registered proprietor alone is entitled to sue, and therefore where certain persons had verbally agreed with the registered proprietor for the exclusive sale of goods to which the design was applied, it was held that they had no right of action against infringement of the design (*t*). The action is only given to the registered proprietor if he elects not to proceed for penalties (*u*).

It is no answer to an action to recover penalties for an infringement that a design has been registered under a wrong class (*x*).

The publication and sale of a book of registered designs is not a licence to the purchaser to sell articles to which the designs had been applied (*y*).

It is sufficient in the pleadings to allege that the design and the proprietorship have been duly registered, and it is not necessary expressly to allege that all the provisions of the Act have been complied with (*z*).

"Knowing that the proprietor," etc.—See notes under s. 58 (b), *ante*, p. 369.

In *Wittman* v. *Oppenheim* (*a*), it was held by PEARSON, J., that an innocent infringer of a registered design must pay the costs of a motion for an injunction to restrain him from infringing, even though the plaintiff had given him no notice before commencing the action.

But in *Smith* v. *Roberts* (*b*), BRISTOWE, V.-C., refused to apply this rule to the trial of an action; and where the action had been continued after the plaintiff had by interrogatories discovered certain facts, which

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(*t*) *Woolley* v. *Broad*, [1892] 1 Q. B. 806.

(*u*) *Woolley* v. *Broad*, *ubi supra*; *Saunders* v. *Wiel*, 9 R. P. C. 459, 465.

(*x*) *Lowndes* v. *Browne*, 12 Ir. L. R. 293.

(*y*) *Branchardière* v. *Elvery*, 4 Ex. 380; S. C. 18 L. J. (N.S.) Ex. 381.

(*z*) *Sirazin* v. *Hamel* (No. 1), 32 Ben. 145.

(*a*) 27 Ch. D. 260.

(*b*) 5 R. P. C. 611.

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in the opini n of the court showed that the defendant had no knowledge within s. 58 (b) of the present Act, the action was dismissed with costs.

In an action for infringement the plaintiff may go into evidence as to the purpose for which the design was registered, and, if necessary, the court will call for the statement as to the nature of the design which was lodged, under s. 17 (3), when the application to register was made (*e*).

The practice in patent actions whereby a defendant desiring to amend particulars of objections, may be compelled to allow the plaintiff a time in which to elect to discontinue (*ante*, p. 175), has been followed in an action for infringement of design (*d*). But there is nothing in such a practice to fetter the absolute discretion of the judge as to the terms on which such an amendment will be allowed (*e*).

An action for infringement of design is not, on the question of costs, analogous to a patent case (*f*); and where the defendants raised several defences, and succeeded on one only, viz., that of previous publication of the design, and failed on one other issue, and the other defences were not fought out, it was held that the defendants were entitled to all the costs of the action except those of the issue on which they failed (*g*).

And see under s. 29 (6), *ante*, p. 231.

Definitions.

Definition of "design," "copyright."

60. In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the

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(*c*) *Walker* v. *Falkirk Iron Co.*, 4 R. P. C. 390, 394, 395.

(*d*) *Morris Wilson & Co.* v. *Coventry Machinists Co.*, [1891] 3 Ch. 418.

(*e*) *Woolley* v. *Broad*, [1892] 2 Q. B. 317; 9 R. P. C. 429.

(*f*) *Per* KEKEWICH, J., *Blank* v. *Footman*, 39 Ch. D. 678, 685.

(*g*) *Blank* v. *Footman*, *ubi supra*.

protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six). Sect. 60.

"Copyright" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

"'Design' means any design," etc.—See *ante*, under s. 47, p. 350.

The above definition of "design" is taken nearly *verbatim* from s. 3 of the Act of 1842, omitting in the present Act, after the words "applicable to," the words "the ornamenting of." The Act of 1842 *dealt only with ornamental designs.* "*Useful*" *designs were dealt with* by the 6 & 7 Vict. c. 65, which, by s. 2, gave protection to a new and original design for any article of manufacture having reference to some purpose of utility, so far as such design should be for the shape or configuration of such article, and that whether it should be for the whole of such shape or configuration, or only for a part thereof.

Questions arose under the old Act as to whether a particular arrangement was or was not a "useful design" within the latter Act, or whether it was not properly an article of manufacture the subject of a patent (*h*). These questions cannot now arise, there being no distinction in the present Act between ornamental and useful designs.

But it was said under the old Act, and there appears to be nothing in the present Act to the contrary, that if the invention was not merely a good "useful" design, but was also a proper subject of a patent, there was nothing to prevent an inventor from having a concurrent right to take out a patent, or to take the smaller protection given by the Designs Act (*i*).

"For the pattern or for the shape or configuration."—There is a distinction drawn in the Act and the rules in respect of pattern, and shape or configuration, but the distinction between pattern and shape is not necessarily scientific and precise (*k*).

Where the design is registered as "applicable to pattern, shape and configuration," the registration applies to the design as a whole (*l*).

As to the words "richly embossed shape," see *Demartial* v. *Booth*, *ante*, p. 367.

(*h*) *Millingen* v. *Picken*, 1 C. B. 799; *Rogers* v. *Driver*, 1 Q. B. 103; *R.* v. *Bessell*, 16 Q. B. 810; *Margetson* v. *Wright*, 2 De G. & Sm. 420; *White* v. *Toms*, 37 L.J. (N.S.) 204.

(*i*) *Per* ERLE, J., and COLERIDGE, J., *Rogers* v. *Driver*, 16 Q. B. 108.

(*k*) *Rollason's Design*, [1898] 1 Ch. 248; 14 R. P. C. 909, 914, 916.

(*l*) *Harper* v. *Wright*, [1896] 1 Ch. 142, 150, 152.

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NOTE.

"**Shape or configuration.**"—It has been considered doubtful whether a mechanical contrivance in the stem of a parasol (*m*), or a design for a protector label, which consisted in making in the label an eyelet-hole and lining it with a metallic substance (*n*), could be considered designs for "shape or configuration."

On the other hand, a design of a new form of brick with corresponding apertures in the sides, so that passages were formed when the bricks were laid together through which ventilation could take place, was held under the old Act a good design for "shape or configuration having reference to some purpose of utility" (*o*).

Utility immaterial.

It was also held that a mere combination of parts for a useful purpose, independently of shape or configuration, was not within the Act (*p*).

The rule is the same under the present Act. The statute applies to all such designs as are within it whether they add to the utility of the articles to which they are applied or whether they do not. The question of utility is wholly immaterial (*q*).

"**Ornament.**"—Under a registration "ornamental design," not only the ornament but the combination with the shape is protected (*r*).

"**Copyright.**"—Under the Act of 1842, s. 3, the proprietor had the sole right to apply the registered design, "provided the same were done within the United Kingdom of Great Britain and Ireland." This limitation was repealed by the Act of 1861, and is not contained in the present Act.

See also s. 58, *ante*

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design

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(*m*) *Millingen* v. *Picken*, 1 C. B. 799.

(*n*) *Margetson* v. *Wright*, 2 De G. & Sm. 421.

(*o*) *Rogers* v. *Driver*, 16 Q. B. 103.

(*p*) *R.* v. *Bessell*, 16 Q. B. 810.

(*q*) *Per* LINDLEY, L.J., *Clarke's Design*, [1896] 2 Ch. 38, 43; see also *Cooper* v. *Symington*, 10 R. P. C. 264.

(*r*) *Gordon* v. *Patrick*, 12 R. P. C. 22.

or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise. Sect. 61.

This section is substantially the same as s. 5 of the Act of 1842, under which it was held that where a person has a workman in his employ under him, and the workman makes a design which is new and original, that design becomes the property of the master; but that persons who were not the original designers, nor the employers of the actual designer, but who had merely contracted with the foreign designer to purchase articles made by him according to the design abroad, were not proprietors within the Act (*s*). So, also, where an American manufacturer purported to sell to the plaintiff the sole right to sell an article newly designed and about to be manufactured, it being stipulated that the plaintiff should obtain the articles exclusively from the manufacturer, it was held that the plaintiff, not having under the contract the right to manufacture, had not acquired the right to apply the design, and could not be registered as proprietor (*t*). And a mere agent in this country of a foreign firm for the sale of certain goods of a particular design, not being the author of the design, nor otherwise fulfilling the requirements of the section, is not "proprietor of" the design, and cannot register it (*u*).

See also notes under s. 55.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

62. (1.) The comptroller may, on application (*x*) by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark. Application for registration.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be

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(*s*) *Lazarus* v. *Charles*, L. R. 16 Eq. 117, 122.

(*t*) *Jewitt* v. *Eckhardt*, 8 Ch. D. 404.

(*u*) *Re Guiterman's Design*, 55 L. J. (N.S.) Ch. 309, reported as *Ex parte Wild*, 2 Times R. 174.

(*x*) T. M. R. rr. 7—16.

Sect. 62 (2). from time to time prescribed, and must be left at, or sent by post to, *the Patent Office in the prescribed manner* (*y*).

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connexion with which the applicant desires the trade mark to be registered (*z*).

(4.) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade (*a*), who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid (*b*).

This section is, by the Act of 1888, s. 8, amended as follows :—

(1.) In sub-section two of section sixty-two of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed."

(2.) To the same section of the principal Act the following sub-section shall be added :—

"(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given."

This section does not, in terms, refer to cases of opposition, which are dealt with in s. 69. But it may be doubtful whether this present section does not also extend to opposition cases (*c*).

(*y*) T. M. R. r. 8. In exceptional cases a specimen may be deposited, r. 13.

(*z*) *Ibid.* rr. 13, 14.

(*a*) *Ibid.* rr. 20—26.

(*b*) T. M. R. r. 23.

(*c*) See *Re Australian Wine Importers and Mason*, 41 Ch. D. 285, COTTON, L.J.

SUB-SECTION (1). Sect. 62 (1).

NOTE.

"**Any person.**"—Under the Rules of 1875, r. 5, express permission was given to a foreigner to register. There is no such provision in the present Act or rules, but the word "person," sub-s. (1), is used without any limitation.

And see s. 103, *post*, and the International Convention, *post*.

An importer of foreign goods cannot, even with the consent of the foreign producer, register the trade mark of the latter as his own. And for this purpose the foreign owner of a natural source of the article is in the same position as a manufacturer. And the rule is the same whether the importer has or has not an exclusive contract for this country (*d*).

In *Re Rivière's Trade Mark* (*e*), it was held by PEARSON, J., under the Act of 1875, that foreigners who neither used nor intended to use the trade mark in England were not entitled to register. The decision in this case was reversed in the Court of Appeal on grounds not affecting this point, which the Court of Appeal expressly refrained from deciding. In the same case the question whether it was necessary that a person desiring to register should be carrying on, or intending to carry on, business in this country, was also left open.

In *Edwards* v. *Dennis* (*f*) it was said in the Court of Appeal that the Act of 1875 appeared to contemplate a user of the particular mark contemporaneously with, if not before, registration. But in *Re Hudson's Trade Marks* (*g*) it was expressly decided that the true meaning of the Act was to enable a person who had invented a trade mark which had not been previously used by some other person to obtain registration of that trade mark, and to treat its being on the register as evidence of public user, or equivalent to public user. And that in this respect there is no difference between the Act of 1875 and the present Act (*g*).

A person who has once acquired a trade mark by user may register it, though he has discontinued it for a time, if he has not abandoned it (*h*).

Abandonment of a trade mark is a question of intention (*i*); and where the applicant had, before 1875, ceased to sell the article in respect of which the trade mark was used, and had destroyed the labels to which it was attached, it was held that he had abandoned it, and could not now register it as an old mark (*k*).

(*d*) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 226, 234, 235.

(*e*) 26 Ch. D. 48.

(*f*) 30 Ch. D. 455, 473. See also *Lyndon's Trade Mark*, 32 Ch. D. 109; 3 R. P. C. 102; *Anderson's Trade Mark*, 54 L. J. Ch. 1084.

(*g*) 32 Ch. D. 311, 326. See judgment of FRY, L.J.

(*h*) *Mouson* v. *Boehm*, 26 Ch. D. 398.

(*i*) *Mouson* v. *Boehm*, *ubi supra*.

(*k*) *Grossmith's Trade Mark*, W. N. (1889), 2; 6 R. P. C. 180.

Sect. 62 (1).

NOTE.

When an application under the Act of 1875 for registration had not been completed within the twelve months, it was held not to be a pending application saved under s. 113, *post*, of this Act (*l*).

Applications under this Act may be made by or through agents (*m*), and the comptroller may require particulars. See T. M. R. 1897, r. 13, *post*.

Applications for registration of marks for cutlery, if made by a person carrying on business in Hallamshire, or within six miles thereof, are to be made to the Cutlers' Company (see s. 81 (3), *post*), who may enter the mark in the "Sheffield Registry" established by that section, and thereupon notice is to be given to the comptroller, who is to enter the mark in the Register of Trade Marks (see s. 81 (6), *post*).

SUB-SECTION 2.

As to correction of clerical errors in or in connection with an application for registration of a trade mark, see s. 91 (a), *post*, and T. M. R., Form Q.

SUB-SECTION 3.

"**Particular goods or classes of goods.**"—For the purposes of registration goods are classified in the manner appearing in the Third Schedule to the Trade Marks Rules, 1890, *post*, which is practically the same as the classification under the repealed Trade Mark Rules, 1883. Applications for the registration of the same mark in different classes are to be treated as separate and distinct applications. See T. M. R., 1897, r. 13, *post*.

Mark not used for all goods in the class for which registered.

Under the Act of 1875, it was held that it is not the intention of the Act that a man registering a trade mark for the entire class, and yet only using it for one article in the class, can claim for himself the exclusive right to use it for every article in the class; and where this was shown to have been done, the register was, on the application of persons aggrieved, rectified by confining the registration to those articles in the class in connection with which the mark was actually used (*n*). If the person on the register desires to extend his business to other articles in the class, and to apply his trade mark to them, he should register it in respect of those goods (*o*).

The right to sue for infringement is limited to the class of goods in respect of which the mark has been registered (*p*).

(*l*) *Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(*m*) T. M. R. r. 9, *post*; and see remarks of STIRLING, J., *Jackson* v. *Napper*, 35 Ch. D. 172.

(*n*) *Edwards* v. *Dennis*, 30 Ch. D. 454. See also *Batt & Co.'s Trade Mark*, [1898] W. N. 44 (15) under present Act.

(*o*) *Edwards* v. *Dennis*, *ubi supra*.

(*p*) *Hart* v. *Colley*, 44 Ch. D. 193.

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NOTE.

And when a trade mark was registered for the whole of class 45, viz., "tobacco, whether manufactured or unmanufactured," and the plaintiffs had only used it for cut tobacco, and it contained a word which was inapplicable to cigars and which was omitted from the mark as used by the plaintiffs for cigars, it was held that the plaintiffs were not entitled to an injunction to restrain the defendants from using the mark in reference to cigars without the word in question (*q*).

But where, although the mark was registered for only some goods in a class, the plaintiff had used it for other goods, and it had acquired by user a public reputation as designating the plaintiff's goods in the market, the plaintiff was held to be protected by the general law, and an injunction was granted (*r*).

Each of the classes of goods is to be treated as separate and distinct, and the registration of a mark in each class is to be taken as a separate registration. And a person who has registered a mark in one class may be prevented from registering the same mark for another class, if any other person has used the same or a sufficiently similar mark for the latter class (*s*).

SUB-SECTION 4.

"The comptroller may refuse," etc.—Under the Act of 1875 it was held that if the applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and the trade mark is one within the definition of the Act (*post*, s. 64), he was entitled to registration *ex debito justitiæ*. The burden of proof lay on the applicant, but if he produced such proof as would, in the opinion of the court, entitle him to an injunction, the words in s. 5 of that Act, "if satisfied of the justice of the case" (*t*), were not to be construed as meaning to give the court a discretion whether the nature of the trade mark was such as to make it inconvenient that the applicant should exercise the right of property which he was proved to have (*u*).

Comptroller's discretion as to registration.

But the present section gives the comptroller a discretion, and while the Act prohibits the registration of a trade mark in certain specified cases there is no duty cast upon the comptroller of registering every

(*q*) *Hargreave* v. *Freeman*, [1891] 3 Ch. 39. See also *Wills' Trade Mark*, [1893] 2 Ch. 262.

(*r*) *Jay* v. *Ladler*, 40 Ch. D. 649; 60 L. T. (N.S.) 27. See also *Hart* v. *Colley*, 44 Ch. D. 193; *Bodega Co.* v. *Owens*, 7. R. P. C. 31.

(*s*) See *per* PEARSON, J., *Lyndon's Trade Mark*, 32 Ch. D. 109, 113.

(*t*) These words are not in the present Act.

(*u*) *Orr Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 497, judgment of Lord BLACKBURN.

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NOTE.

other mark that may be applied for. On the contrary, a discretion whether to register or not is in all cases plainly conferred (*x*).

And the comptroller is bound to look into all the facts of the case, and to see whether it is proper under all the circumstances to register the mark (*y*).

It is a reasonable exercise of the comptroller's discretion to refuse to register the mark when it is not clear that deception would not result(*z*).

In an application to register a trade mark the applicant is *in petitorio*, and must justify the registration by showing affirmatively that it is not calculated to deceive. And if *in dubio* the application ought to be refused (*a*).

On these grounds words involving a misleading allusion or a suggestion of what is not strictly true (*b*), a mark for goods practically though not actually of the same description as those for which a similar mark has been registered (*c*), and a description in words of a registered device (*d*), whether the description be or be not in a foreign language (*e*), have been refused registration, or expunged from the register, though not strictly within the prohibitory clauses of the Act. (And see under ss. 72, 73, *post*.)

Where the comptroller objects to register on the ground of similarity of the proposed mark to marks already on the register, the consent of the owners of those marks is immaterial except so far as it may be evidence of there not being a probability of persons being deceived (*f*).

The comptroller, before refusing, must give the applicant an opportunity of being heard. T. M. R., r. 17.

The books of the office showing that registration of a trade mark has been refused are no evidence that it has become *publici juris* (*g*).

"**Appeal to the Board of Trade.**"—If the comptroller refuses to register, the only course open to the applicant is to appeal to the Board of Trade, and the court has no jurisdiction in such a case to rectify the register under s. 90 (*h*).

(*x*) *Australian Wine Importers, Ltd.*, 41 Ch. D. 278, 285; and *per* Lord HERSCHELL, *Eno* v. *Dunn*, 15 App. Cas. 261.

(*y*) See *per* KAY, J., *Grossmith's Trade Mark*, 6 R. P. C. 180, 182.

(*z*) *Per* Lord HERSCHELL, *Eno* v. *Dunn*, *ubi supra*.

(*a*) *Per* Lord WATSON, *Eno* v. *Dunn*, *ubi supra*.

(*b*) *Eno* v. *Dunn*, 15 App. Cas. 252, 263.

(*c*) *Australian Wine Importers, Ltd.*, 41 Ch. D. 278, 286.

(*d*) *Re La Societé Anonyme des Verreries de l'Etoile*, [1894] 1 Ch. 61, 64, [1894] 2 Ch. 26.

(*e*) *John Dewhurst and Son's Trade Mark*, [1896] 2 Ch. 137.

(*f*) *John Dewhurst and Son's Trade Mark*, [1896] 2 Ch. 137.

(*g*) *Orr Ewing* v. *Johnston*, 13 Ch. D. 434.

(*h*) *Re "Normal" Trade Mark*, 35 Ch. D. 231.

Proceedings before the Board of Trade are now regulated by s. 102A, added by the Act of 1888, s. 25, *post*. **Sect. 62 (4).**

NOTE.

"**Conditions.**"—Registration has been granted subject to an undertaking to use or not to use a mark in a particular way (*i*), or in a particular place (*k*), or on particular goods (*l*), and a notice of the undertaking has been placed on the register (*m*). And such an undertaking may be added to the register on the *ex parte* application of the applicant, the consent in writing of the comptroller being produced (*n*). But in *Re John Dewhurst Co.'s Trade Mark* (*o*), it was held that the court ought not to direct registration subject to a condition that the mark shall only be used in a particular country, there being no authority in the Act enabling the court to impose such a condition, and no means of enforcing it if imposed.

In cases of applications under the Act of 1875, a disclaimer of words common to the trade cannot be enforced, that Act having no provision analogous to s. 74 of the present Act (*p*).

SUB-SECTION 5.

By s. 117, *post*, p. 502, "the court" means, subject to the provisions for Scotland, Ireland, and the Isle of Man, Her Majesty's High Court of Justice in England. By r. 42 of the Rules of 1875, applications as to registration of trade marks were assigned to the Chancery Division, and this is still the practice (*q*).

If the appeal is referred to the court by the Board of Trade, the court may entertain any objections to the registration, whether they were or were not taken by the comptroller (*r*).

The order of reference directs the appellants to apply to the court to hear and determine the appeal. See *H. J. Neill's Trade Mark* (*No.* 1), Appendix, *post*.

No provisions are made by this Act, or the Act of 1888, as to the costs of these proceedings before the comptroller or the Board of Trade.

Under the Trade Marks Act, 1875, it was held that an applicant who, on the registrar objecting to register a particular mark, succeeded Costs of comptroller

(*i*) *Re Whiteley's Trade Mark*, 29 W. R. 235; *Re Farina*, Seb. Dig. p. 405; *Re Sykes & Co.'s Trade Mark*, 29 W. R. 235; *Re Mitchell & Co., and Houghton and Hallmark's Trade Marks*, 32 W. R. 90; varied 28 Ch. D. 666; *Ex parte Hemming and Son*, 29 S. J. 570.

(*k*) *Re Rabone, Brothers & Co.*, Seb. Dig. p. 395; *Re Keep's Trade Mark*, 26 Ch. D. 187.

(*l*) *Re Otaduy's Trade Mark*, W. N. (1885), p. 177.

(*m*) See cases cited in the three previous notes.

(*n*) *Keep's Trade Mark*, 26 Ch. D. 187.

(*o*) [1896] 2 Ch. 137.

(*p*) *Hudson's Trade Marks*, 32 Ch. D. 311.

(*q*) *King & Co.'s Trade Marks*, [1892] 2 Ch. 462, 480.

(*r*) *Sanitas Co.'s Trade Mark*, 58 L. T. (N.S.) 166; 4 R. P. C. 533.

Sect. 62 (5). against the registrar on the matter being referred to the court, must nevertheless pay the registrar's costs, there being no fund out of which the registrar could be paid (*s*). And this is the general rule under the present Act (*t*). But the practice is not invariable (*u*).

NOTE.

Under the Trade Marks Act, 1875, it was held that there was no jurisdiction to order the registrar to pay costs (*x*); but in *Leaf's Trade Mark* (*y*), where the applicant succeeded, BACON, V.-C., refused to give the comptroller his costs. The case was, however, reversed on appeal on the question whether the mark was one capable of registration, and the court, considering the case as a test case brought forward by the Patent Office, gave no costs on either side (*z*).

The rule as to the payment of the costs of the registrar was the same where the registrar appeared and did not oppose (*a*). But the costs thus to be paid were confined to the costs of proceedings in court, and the applicant could not be ordered to pay the costs in the registrar's office(*b*). This distinction proceeded on the words of the Judicature Rules, 1875, Order LV., which provided that the costs of proceedings in the High Court should be in the discretion of the court.

Limit of time for proceeding with application.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned.*

By the Act of 1888 (*c*), this section is amended by substituting for the words "the application shall be deemed to be abandoned," the words—

"the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such

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(*s*) *Re Maignen*, 28 W. R. 759; *Rotherham's Trade Mark*, 14 Ch. D. 535.

(*t*) *Re White Rose Trade Mark*, 30 Ch. D. 507; *Re Trade Mark Alpine*, 29 Ch. D. 877; and see *Van Duzer's Trade Mark*, 34 Ch. D. 645; and *Colman's Trade Marks*, [1891] 2 Ch. 402, 408.

(*u*) *Colman's Trade Mark Application*, [1894] 2 Ch. 115, 132.

(*x*) *Re Rotherham's Trade Marks* 14 Ch. D. 587.

(*y*) 33 Ch. D. 481.

(*z*) 34 Ch. D. 645.

(*a*) *Re Orr Ewing*, W. N. (1880), 24.

(*b*) *Brandreth's Trade Mark*, 9 Ch. D. 619; *Re Hargreaves*, 11 Ch. D. 675.

(*c*) Section 9, *post*, p. 515.

further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned." Sect. 63.

The original section was held to be retrospective, and applied to applications pending at the commencement of the Act (*d*).

But where the mark had been registered, it was held that, instead of directing the mark to be expunged, the court, in its discretion, given under s. 90, might rectify the register by making an entry that the five years mentioned in s. 76 should run from the date of the entry, and not from the date of the original registration (*e*).

Where an application by a foreigner was deemed to be abandoned under this section, by reason of the default of the applicant's agents, and without the applicant's knowledge, he believing that his mark had been registered, it was held that there was nothing to prevent his making a fresh application (*f*).

64.—(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:* Conditions of registration of trade mark.

(a.) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

(b.) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or*

(c.) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2.) *There may be added to any one or more of these particulars any letters words or figures, or combination of letters words or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five (g), may be registered as a trade mark under this part of this Act.*

(*d*) *Jackson* v. *Napper*, 35 Ch. D. 162; *Re Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(*e*) *Re Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(*f*) *Jackson* v. *Napper*, *ubi supra*; *Loftus' Trade Mark*, [1894] 1 Ch. 193.

(*g*) The day of the passing of the Act of 1875.

Sect. 64 (1). By the Act of 1888, s. 10, the following is substituted for this section :—

64.—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars :

(a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or

(b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or

(c.) A distinctive device, mark, brand, heading, label, or ticket ; or

(d.) An invented word or invented words ; or

(e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3.) Provided as follows :

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof :

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight

hundred and seventy-five (*h*), may be registered as a trade mark under this part of this Act. Sect. 64 (3).

The original section was a re-enactment, with considerable alterations, of s. 10 of the Act of 1875. The new section is not retrospective with reference to marks applied before January 1st, 1889, the date of the commencement of the Act of 1888 (*i*).

The section must be read in connection with s. 73, *post*.

Old marks.—In reference to s. 10 of the Act of 1875, it was said by MALINS, V.-C., that "wherever there is a trade mark which has been lawfully used, whether it consists of a single device, as the crown with the initials, or of a foreign word, such as 'Anatolia,' or the Turkish word for 'warranted' simply, or of a name with a device, or also of a description of quality, if the whole combination is such as would, before the passing of the Act, have been the proper subject of a trade mark, and could have been protected as a trade mark, that should be registered, and could properly be registered" (*j*). But a trade mark in use before the Act cannot be registered unless it is within one of the definitions comprised in the above sub-sections (*k*). And it must be shown that the whole combination as proposed to be registered has been used as a trade mark before the statutory date (*l*).

Thus, where an application was made to register as an old mark a winged cross within two circles, the circles being disclaimed as common to the trade, and it appeared that the mark had only been used in this form in connection with the names of the owners of the mark, the application was refused (*m*).

Where, under the Act of 1875, a mark consisting of a lighthouse surrounded by two circles had been registered, and it appeared that the circles were common to the trade, the mark was not expunged, but a note was added that so much of the device as consisted of the two circles was common to the trade (*n*). Such a mark would now be registered under s. 74, *post*, with the disclaimer then required.

A mark used before August 13th, 1875, is an old mark only in respect of the goods on which it has been used, and as regards other goods it is to be treated as a new mark (*o*).

As to registration of identical, or nearly identical, old marks, see *post*, under s. 72, *post*, p. 426.

(*h*) The day of the passing of the Act of 1875.

(*i*) *Re Burgoyne's Trade Mark*, 6 R. P. C. 227, 231.

(*j*) *Re Barrow's Trade Marks*, 5 Ch. D. 364.

(*k*) *Re Mitchell's Trade Mark*, 7 Ch. D. 36.

(*l*) *Meens' Application*, [1891] 1 Ch. 41.

(*m*) *Baker* v. *Rawson*, 45 Ch. D. 519.

(*n*) *Baker* v. *Rawson*, 45 Ch.D. 519.

(*o*) *Re Jelley, Son & Jones*, 51 L. J. Ch. (N.S.) 639, n.; *Re Lyndon's Trade Mark*, 32 Ch. D. 109.

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NOTE. Comptroller may require proof of time of user of old mark.

On applications to register an old mark as having been in use before August 13th, 1875, the comptroller, in cases where from any cause he thinks it desirable, will require the applicant, before the application is advertised, to furnish a statutory declaration, made by some person acquainted with the facts, stating that the mark has been used as an old mark. To this declaration it is convenient to append an exhibit showing the mark as used. The comptroller, as a rule, requires that the declaration shall state continuous user of the mark as a trade mark in the United Kingdom from the date before 1875 as to which the declarant can speak, and, further, that on the goods (save the mark shown on the exhibit) there did not appear any device, words, numerals, letters, or any other particulars whatsoever.

A specimen of such a declaration will be found in the Appendix, *post*.

"**Essential particulars.**"—In *Orr Ewing* v. *Registrar of Trade Marks* (*p*), a case under the Act of 1875, HALL, V.-C., said that the device or label, the registration of which is applied for, must be looked at as a whole, and that if it appears to be such as in the ordinary course of business would be distinguished from other devices or labels, it should be registered. Commenting on these words when the case was under appeal to the House of Lords (*q*), Earl CAIRNS, C., said: "To some extent, no doubt, this is true, but I apprehend the first duty cast upon the court is to ascertain whether some one or more than one of the essential particulars of a trade mark as defined by the Act is found to exist, so that the mark may be described with one or more than one essential particular or particulars which distinguish it."

1 (a.) The words "individual or firm" in this and the next sub-section indicate the same thing, viz., the name or written signature of a real human being or a real firm (*r*). Such names as "Hamlet," "Sam Weller," "Jupiter," "Venus," etc., are not names of "individuals" within the sub-section (*s*).

The word "Pirie's" (part of the expression Pirie's Parchment Bank, a name for paper) is not the name of an individual or firm within this sub-section (*t*).

The words "Gianaclis cigarettes," Gianaclis being the name of the maker, and there being nothing particular or distinctive in the manner of printing, were held not to constitute a good trade mark, and was removed from the register (*u*).

The name under this sub-section need not be the name of a living person, nor the name of the applicant for registration (*x*).

(*p*) 8 Ch. D. 799.
(*q*) 4 App. Cas. 484.
(*r*) *Per* A. L. SMITH, L.J., *Holt's Trade Mark*, [1896] 1 Ch. 711, 724.
(*s*) *Holt's Trade Mark*, *ubi supra*, p. 720, LINDLEY, L.J.
(*t*) *Pirie* v. *Goodall*, [1892] 1 Ch. 35, 43.
(*u*) *Gianaclis' Trade Marks*, 6 R. P. C. 467.
(*x*) *Per* LINDLEY, L.J., *Holt's Trade Mark*, [1896] 1 Ch. 719.

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NOTE.

1 (b.) The words "applying for registration thereof as a trade-mark" were introduced by the Act of 1883. It would appear that the written signature of the predecessors of the firm applying for registration would not be within the Act (*y*). See also under sub-s. 1 (a).

1 (c.) "**Distinctive.**"—This word must be construed as running through the whole of the sub-section (*z*).

The word "distinctive" imports a distinction in the product of one particular maker from that of others (*a*). And therefore, where a name was originally, or has come to be, descriptive of the article to which it is applied, so that while indicating what the article is, it does not connect it with any particular manufacturer, it cannot be registered as a trade mark (*b*). And see under s. 73, *post*.

If the mark is by the owner placed on boxes not containing his own goods, but marked with and containing the name of another manufacturer, it is not distinctive of the owner's manufacture and ought not to be registered (*c*).

But where a mark used generally for tobacco in packets was used by the proprietors on a few boxes of foreign cigars in such a way as merely to denote that they sold the cigars, and not to imply that they manufactured them, it was held that the mark had not lost its *distinctive character* (*d*).

The words "Old Innishowen" as applied to whisky, were held descriptive, and as such incapable of being registered as a trade mark (*e*).

And the mark of a manufacturer pure and simple cannot rightly be assumed by an importer from that manufacturer, or by a person who buys from that manufacturer, unless indeed when all the goods of the manufacturer go to that importer or that dealer (*f*).

Thus where the foreign owner of a mineral spring placed on the bottles containing water from the spring a label in which his own name appeared, it was held that purchasers from him who had not previously used the mark in this country, and had not the right to the whole produce of the spring, could not register the mark in this country even with the consent of the foreign owner (*g*).

(*y*) *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195, 197.

(*z*) *Burland* v. *Broxbourne Oil Co.*, 42 Ch. D. 274.

(*a*) *Apollinaris Co.'s Marks*, [1891] 2 Ch. 186, 226; see also *Re Anderson's Trade Mark*, 54 L. J. Ch. 1084.

(*b*) *Re Arbenz's Application*, 35 Ch. D. 248; *Magnolia Metal Co.'s Trade Mark*, [1897] 2 Ch. 371; 14 R. P. C. 621.

(*c*) *Wood* v. *Lambert*, 32 Ch. D. 247.

(*d*) *Wills's Trade Marks*, [1893] 2 Ch. 262.

(*e*) *Watt* v. *O'Hanlon*, 4 R. P. C. 1.

(*f*) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 186, 226, 230.

(*g*) *Apollinaris Co.'s Trade Marks*, *ubi supra*. See also pp. 229, 230.

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And where a foreign maker of photographic cameras had been in the practice of sending his cameras to a firm in this country marked with his trade mark, and under circumstances which amounted to a user of the mark in this country by the foreigner, and the consignees had registered the mark in their own names, the entry was, in the absence of satisfactory evidence of the foreigner's consent to the registration, expunged on the application of subsequent purchasers of the foreigner's business and trade mark (*h*).

"**Device.**"—In the case of *Orr Ewing* v. *Registrar of Trade Marks*, cited above, it was held that certain devices of lions, demi-lions, and elephants, with the name and address of the firm added, which had been put into the second class by the Manchester Committee of Experts as not being trade marks as defined by the Act (*i*), were "distinctive devices" within the Act of 1875, and that the registrar ought to proceed with the application to register them as cotton marks, although elephants, lions, and demi-lions had been, in fact, in common use in the trade as marks for cotton goods (*k*).

A name in foreign characters may be a distinctive device and entitled to registration (*l*). In such case, however, a transliteration and translation must be furnished to the comptroller, who may also require a translation if the trade mark contains a word or words in a language other than English (*m*).

A portrait of the inventor of the article, taken from a photograph, is not a sufficiently distinctive device to be entitled to registration *per se*, where the name of the inventor has become common to the trade as descriptive of the article (*n*). But where this is not the case there is no reason why the photograph of the person who invented a trade mark should not be in itself distinctive and capable of registration (*o*).

A pictorial representation of the article may be distinctive, and if the evidence shows that it is so in fact, it may be registered (*p*).

A device is not for the purposes of the Act the same as a word, and therefore it was held that there was no objection to the registration as a trade mark of a drawing of a magnolia, though it had been held that the word "Magnolia" was not under the circumstances a word which could be registered (*q*).

(*h*) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

(*i*) T. M. R. Aug. 1876, r. 59.

(*k*) See also *Re Dugdale's Application*, 49 L. J. (N.S.) Ch. 303.

(*l*) *Rotherham's Trade Mark*, 14 Ch. D. 585.

(*m*) T. M. R., [1897] r. 15.

(*n*) *Re Anderson's Trade Mark*, 26 Ch. D. 409, affirmed 54 L. J. Ch. 1094.

(*o*) *Rowland* v. *Michell*, [1897] 1 Ch. 71.

(*p*) *Re James's Trade Mark*, 33 Ch. D. 392.

(*q*) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371.

"**Brand.**"—A brand appears to be only a particular kind of mark, and a mark consisting only of words not capable of registration as fancy words cannot be registered as a brand (*r*). Further, it would seem to be necessary to the registration of a "brand," that it should be used as a brand only by being impressed on the goods, and should not be used in the way a trade mark is ordinarily used, and that it may include a water mark (*s*). Sect. 64 (1). NOTE.

"**Heading.**"—A single word used alone is not a "heading" within the clause (*t*).

"**Label.**"—When there was nothing distinctive in the form of a label, and it contained only the name of a firm in common letters and words which were not "fancy words not in common use," it was held that the label as a whole did not contain any of the essential particulars required by the Act, and it was refused registration (*u*).

An oblong label in three parallel stripes of equal width, the two outer stripes shaded and the middle stripe being plain, and having on it the words "French Coffee," and under them the words "red, white, and blue," and below this letter-press in French and English, is not distinctive, and cannot be registered in colours under s. 67 (*v*).

And when a label consisted only of the name of the proprietor in ordinary type, and certain common flourishes and representations of certain gold medals, and it was shown that representations of such gold medals were in common use, it was held that the label did not contain any of the essential particulars required by the Act, and registration was refused (*w*).

The label does not consist of each particular part of it, but consists of the combination of them all (*x*). And the whole label may be an essential particular within the Act (*y*).

But when the label consisted of certain letters and words, with the name of the article, all in block type, with a device of St. George and the Dragon, and the comptroller refused to register unless the device was claimed as the essential particular, and the added matter disclaimed, which condition was declined by the applicant, it was held that the comptroller's decision was right, and that the label did

(*r*) *Piric* v. *Goodall*, [1892] 1 Ch. 35.

(*s*) See *per* VAUGHAN WILLIAMS, J., *Piric* v. *Goodall*, [1892] 1 Ch. 41.

(*t*) *Leonard* v. *Wells*, 26 Ch. D. 289.

(*u*) *Re Price's Patent Candle Co.*, 27 Ch. D. 681; *Bradley's Trade Mark*, 9 R. P. C. 205.

(*v*) *Hanson's Trade Mark*, 37 Ch. D. 112.

(*w*) *Bryant and May's Trade Mark*, 8 R. P. C. 69.

(*x*) *Per* Lord ESHER, M.R., *Pinto* v. *Badman*, 8 R. P. C. 191.

(*y*) *Per* KEKEWICH, J., *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195.

Sect. 64 (1). not contain any "essential particulars," and was incapable of registration (*z*).

NOTE. Where the whole label is registered as a trade mark the words "trade mark" ought not to appear on it in such a way as to point to a particular device on the label as being the trade mark (*a*). And the registration of a label liable to this objection will be expunged except as to so much as is the real trade mark (*b*).

But the mere use of the words "trade mark" on the registered label will not disentitle the proprietor to sue. It is a question of fact in every case whether the words are so placed as to indicate that a claim is made to a particular part of the label only (*c*).

1 (d.) **"An invented word or invented words."**—This and the following essential particulars are by the Act of 1888 (*d*) substituted for the words "fancy word or words not in common use," which were an addition to the corresponding section of the Act of 1875. Under that Act it was held that the word "AEILYTON" could not be registered as a new mark (*e*).

As to invented words, the law before the Acts for the registration of trade marks, which law, it will be remembered, has not been altered by those Acts (*f*), was thus stated by Lord HATHERLEY, then Sir W. P. WOOD, V.-C. :—

"I have not the least doubt that if the plaintiff (if I doubted I should be going quite contrary to the *Mexican Balm case* (*g*), and other cases in which ridiculous names have been used) has invented a fanciful and ridiculous name—and the more ridiculous the better it is for his purpose—and has used it for eight or ten years in his trade, that then the court would take care that nobody else should use that absurd name; for such user could only be a user for the express purpose of imitating the plaintiff's, and so defrauding the plaintiff, by representing the goods manufactured by one person to be the goods manufactured by another" (*h*).

An "invented word" to be within the sub-section must be a word invented in fact and not merely in the belief of the person claiming to register it (*i*); it must be a word "coined for the first time" (*j*), and

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(*z*) *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195.

(*a*) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 186, 233.

(*b*) *Wills' Trade Marks*, [1893] 2 Ch. 262.

(*c*) *Hammond* v. *Brunker*, 9 R. P. C. 301.

(*d*) See *post*, p. 516.

(*e*) *Ex parte Stephens*, 3 Ch. D. 659.

(*f*) See *post*, p. 442.

(*g*) *Perry* v. *Truefitt*, 6 Bea. 66.

(*h*) *Young* v. *Macrae*, 9 Jur. (N.S.) 323.

(*i*) *Sir Titus Salt's Application*, [1894] 3 Ch. 166, 168.

(*j*) *Per* A. L. SMITH, L.J., *Farbenfabriken Application*, [1894] 1 Ch. 658.

apparently it must have been invented or first used by the person seeking to register it (*k*). Sect. 64 (1).

NOTE.

The *quantum* of invention is not material, but a mere variation of the orthography or termination of a word is not sufficient if to the eye or ear the same idea would be conveyed as by the word in its ordinary form (*l*).

It was also held that an "invented word" must have no reference to the character or quality of the goods, and must have no meaning (*m*); and the Court refused to register the word "Satinine" for preparations for laundry purposes and perfumery (*n*); and "Somatose" for a pharmaceutical product applicable to the human body (*o*).

But in *Re Densham's Trade Mark* (*p*), where a tea dealer had registered the word "Mazawattee" as a trade mark for tea, and it was shown that it was compounded by joining the first syllables of a Hindustani word to the last syllables of a Cingalese word, and that the word thus made up did not exist in any language, it was held to have been invented within the Act, and a motion to expunge it was refused. And in this case the court intimated an opinion that the cases had gone quite far enough, and that if they went further the effect would be to nullify the Act.

And the word "Kynite" which was formed by taking the first syllable of the name of the applicants and adding the termination "ite" which is a common termination for explosives, was held to be an invented word, and to have no reference to the character or quality of the goods, and was admitted to registration (*q*).

And now in *Eastman Photographic, etc. Co.'s Trade Mark* (*r*), it has been held by the House of Lords that sub-ss. (d) and (e) of this section are separate and distinct, and that if the word be really an "invented word" it may be registered, whether meaningless or not, and whether it has or has not reference to the character or quality of the goods.

The court will have regard to the sound of the word proposed to be registered as an invented word, and where the word "Pearl" had been refused registration it was held that the word "Pirle," being a

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(*k*) See *per* KAY, L.J., *Holt & Co.'s Trade Mark*, [1896] 1 Ch. 711, 722.

(*l*) See *per* Lord HERSCHELL, *Eastman Photographic, etc. Co.'s Trade Mark*, 15 R. P. C. 485; and see *Sir Titus Salt's Application*, [1894] 3 Ch. 166; *British Electrozone Co.'s Trade Mark*, 13 R. P. C. 447.

(*m*) *Meyerstein's Trade Mark*, 43 Ch. D. 604; *Farbenfabriken Application*, [1894] 1 Ch. 645, 647, 656.

(*n*) *Meyerstein's Trade Mark*, 43 Ch. D. 604.

(*o*) *Farbenfabriken Application*, [1894] 1 Ch. 645, LINDLEY, L.J., *diss.*

(*p*) [1895] 2 Ch. 176.

(*q*) *Kynoch & Co.'s Trade Mark*, 14 R. P. C. 905.

(*r*) 15 R. P. C. 476.

Sect. 64 (1). mere misspelling of the word "Pearl," and the same in sound, could not be registered (*s*).

NOTE.

1 (e.) "A word or words having no reference to the character or quality of the goods."—The limitation here mentioned was always enforced when it was sought to register words as "fancy words" under the repealed sub-section. See *post*, p. 394, and see also under s. 73, *post*, p. 432.

A fictitious name such as the name of a character in a novel is a "word" within this sub-section, and can be registered alone (*t*). And where the word "Osman" was proved to denote a particular towel of the plaintiff's manufacture, and not the name of the towel by whomsoever made, a motion to expunge the word from the register was refused (*u*).

And if a word applied to a particular article had originally no reference to "the character and quality of the goods" it does not by subsequently becoming the name of the article come within the sub-section (*a*).

In considering whether the particular word has reference to the character or quality of the goods, the word must be regarded not from an etymological point of view, but from the ordinary point of view which would be taken by the ordinary British subject dealing with the particular goods (*b*). And on this ground the word "Typograph" was refused registration as a trade mark for the metal used in the business of the applicants, who were manufacturers of machines and articles adapted for and capable of being used by printers and type founders (*c*).

And the word "Compactum," which was the name given by a patentee to certain umbrellas made under his patent, and which had been registered by him as a trade mark, was after the expiry of the patent removed from the register (*d*).

"Not being a geographical name."—In *Re Van Duzer's Trade Mark* (*e*) it was held that "Melrose" could not be used as a trade mark for a hair restorer (*f*); but the court expressly refrained from deciding that no geographical term could be a "fancy word." This question cannot now arise.

(*s*) *Ripley's Trade Mark*, 15 R. P. C. 151; 77 L. T. (N.S.) 495.

(*t*) *Holt's Trade Mark*, [1896] 1 Ch. 711.

(*u*) *Barlow* v. *Johnson*, 7 R. P. C. 395.

(*a*) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371, 392.

(*b*) *Per* KEKEWICH, J., *Linotype Co.'s Application*, 14 R. P. C. 900; see also *Kynoch & Co.'s Trade Mark*, 14 R. P. C. 905.

(*c*) *Linotype Co.'s Application*, *ubi supra*.

(*d*) *Davis's Trade Marks*, 14 R.P.C. 903.

(*e*) 34 Ch. D. 623.

(*f*) See also *Re Ainslie's Trade Mark*, 4 R. P. C. 212; *Batt's Trade Mark*, 6 R. P. C. 493.

Sect. 64 (1). NOTE.

The phrase "geographical name" is not to be so widely interpreted as to be simply equivalent to the name of any place. "It must, in the absence of special circumstances, be interpreted so as to be in accordance in some degree with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning the word has reference to a locality, as the word 'Melrose' in *Van Duzer's Case*, or the word 'Eboli' in *Sir Titus Salt & Co.'s Case*, it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real, or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section" (*g*).

And therefore where the word "Magnolia," the name of a flower, had been registered as a trade mark for anti-friction metal, it was held that the fact that there were places in America of that name was no objection to the registration, though it might have been a good objection if the metal had been manufactured there (*h*).

But the names of certain water springs known as "Apollinaris," "Friedrichshall," and "Hunyadi Janos" were held to be geographical names, and incapable of registration in respect of the waters of the springs, or of the products of these waters (*i*).

And the prohibition is not confined to the use of the noun substantive; it extends to the adjective, and to the name of a place to which an ordinary English suffix has been added, so as to impart to it an adjectival form: and therefore the word "Eboline" derived from "Eboli" was refused registration (*k*).

But though geographical names cannot be registered as trade marks, they must, if they have come to designate a particular manufacturer's goods in the market, only be used by a rival trader in such a way as not to mislead the public into buying goods of the latter as those of the original maker (*l*). And see *post*, p. 442.

(*g*) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371, 393.

(*h*) *Magnolia Metal Co.'s Trade Marks*, *ubi supra*. See *Batt's Trade Mark*, *ubi supra*.

(*i*) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 187.

(*k*) *Sir Titus Salt's Application*, [1894] 3 Ch. 166.

(*l*) *Thompson* v. *Montgomery*, 41 Ch. D. 35; affirmed, [1891] A. C. 217; *Compania General de Tabacos* v. *Rehder*, 5 R.P.C. 61; *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508.

Sect. 64 (1). The words "El Destino," the name of a cigar factory in Mexico, were held not open to objection under either branch of this sub-section (*m*).

NOTE. Nor was the word "Mazawattee" as a name for tea, though the last two syllables of the word, which are Cingalese, meant a garden and might be understood to refer more or less to Ceylon, and the first two syllables were a Hindustani word meaning "taste" (*n*).

Fancy words. There was considerable difference of opinion as to the meaning of the words "fancy words not in common use" in the repealed sub-sections.

It was at first held that it would allow the registration as trade marks of words which, though not strictly "fancy words," were fanciful words when applied to the goods in respect of which they were registered, as "Alpine" as a trade mark for cotton embroidery (*o*), and this view was also taken in other cases (*p*). But in *Van Duzer's Trade Mark* (*q*) it was held by the Court of Appeal that a word may not be registered as a trade mark if it is fancifully used, but only if it is a fancy word; that a "fancy word" must be a word "which obviously could not have reference to any description or designation of where the article is made or of what its description is." "It must be obviously non-descriptive when used as a trade mark." "It must be a word fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as neither to be deceptive, nor descriptive, nor calculated to suggest deception or description"; and further, it "must have an innate and inherent character of fancifulness, which must not depend on evidence . . . it must be a fancy word of its own inherent strength."

On the above grounds the words "Melrose" as a trade mark for a hair restorer (*r*), "Glengowrie" as a name for whiskey (*s*), "Electric" as a trade mark for velveteen (*t*), were refused registration; since, in the one case, it was not obvious that the names were not intended to designate the places where the articles were produced, and in the other the word suggested a meaning, and might, rightly or wrongly, be associated with electricity. So also, the word "Reversi," which was the name of a game where the player reversed his adversary's counters, was expunged from the register (*u*).

(*m*) *Pinto* v. *Badman*, 8 R. P. C. 181; *Pinto* v. *Trott*, 8 R. P. C. 173.

(*n*) *Densham's Trade Mark*, [1895] 2 Ch. 176.

(*o*) *Re Trade Mark Alpine*, 29 Ch. D. 877.

(*p*) *Re Leaf, Son & Co.'s Trade Mark*, 33 Ch. D. 477; *Arbenz's Application*, 35 Ch. D. 248.

(*q*) 34 Ch. D. 623, 640, 642, 645.

(*r*) *Van Duzer's Trade Mark*, *ubi supra*.

(*s*) *Re Laing's Trade Mark*, 3 Times R. 728.

(*t*) *Leaf, Son & Co.'s Trade Mark*, 34 Ch. D. 623. See also *Great Tower Street Tea Co.* v. *Smith*, 5 Times R. 232; 6 R. P. C. 165.

(*u*) *Waterman* v. *Ayres*, 39 Ch. D. 29.

Sect. 64 (1). NOTE.

And where the word "Gem," as applied to air-guns, had become descriptive or indicative of the quality of a particular make of gun, it was held not to be a fancy word, and was not admitted to registration (*x*).

But it did not follow that geographical names were necessarily to be excluded from registration, nor that any word found in a dictionary was *ipso facto* to be disqualified (*y*). Geographical names are now excluded by the modifications in the section introduced by the Act of 1888, see *ante*, p. 384.

The words "Zephyr Asiatic Walnut Pipe" (*z*), "Hand Grenade Fire Extinguisher" (*a*), "Jubilee" as a name for paper (*b*), "Self-Washer" as a name for soap (*c*), "Sanitas" as a name for medicine (*d*), "Washerine" as a name for a preparation for laundry purposes (*e*), have also been held incapable of registration as fancy words. So, also, the word "Bokol," the Norwegian name for a particular kind of ale, which had been registered as a trade mark of importers of the ale, was expunged from the register on the application of rival importers of Norwegian beer (*f*). And the word "Kokoko," the name for an owl in the language of the Chippeway Indians, was refused registration, the device of an owl being common to the trade (*g*). And, speaking generally, that which is the only name of a thing cannot be a fancy word with regard to it (*h*).

Other words which have been held incapable of registration as fancy words are "Manor" (*i*), "Britannia" (*k*), "Parchment Bank," as a name for paper (*l*), "Carnival" for cigarettes (*m*).

The following words have been refused registration or expunged as not being obviously non-descriptive: "John Bull Brand" for fermented liquors (*n*), "Emolliolorum" for a preparation for softening harness (*o*),

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(*x*) *Re Arbenz's Application*, 35 Ch. D. 248.

(*y*) *Per* LOPES, L.J., *Van Duzer's Trade Mark*, 34 Ch. D. 645. See also p. 632.

(*z*) *Re Friedlander's Trade Mark*, W. N. (1885), 85.

(*a*) *Re Harden Star Hand Grenade Co.*, 3 R. P. C. 133.

(*b*) *Towgood* v. *Pirie*, 4 R. P. C. 67.

(*c*) *Lever* v. *Goodwin*, 4 R. P. C. 492.

(*d*) *Sanitas Co.'s Trade Mark*, 4 R. P. C. 534.

(*e*) *Burland* v. *Broxbourne Oil Co.*, 6 R. P. C. 482.

(*f*) *Re Davis, Bergendael & Co.'s, Trade Mark*, 59 L. T. (N.S.) 854; 6 R. P. C. 207 (reported as *Davis* v. *Stribolt*).

(*g*) *Jackson Co.'s Trade Mark*, 60 L. T. (N.S.) 93; 6 R. P. C. 80.

(*h*) *Waterman* v. *Ayres*, 39 Ch. D. 30. See judgment of Fry, L.J.

(*i*) *Thompson's Trade Mark*, 6 R. P. C. 213.

(*k*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22.

(*l*) *Pirie* v. *Goodall*, 9 R. P. C. 17.

(*m*) *Lloyd & Sons Trade Mark*, 10 R. P. C. 281.

(*n*) *Paine's Trade Mark*, 9 R. P. C. 130.

(*o*) *Talbot's Trade Mark*, 11 R. P. C. 77.

Sect. 64 (1). NOTE.

"The Beatrice" for ladies' shoes (*p*), "Hannay's electroid anti-fouling composition" (*q*), "Apollinaris" and other names of mineral-water springs for mineral waters (*r*), "Triticumina" as a name for preparations from wheat (*s*).

Names of living persons.

In *Slazenger* v. *Malings* (*t*), the words "The Lawford" were allowed registration in connection with tennis bats, Lawford being the name of a celebrated tennis player. But in *Banks and James' Trade Marks* (*u*), it was held that a name in use at the present day cannot be taken as a fancy word within the Act, although it has been borne by a celebrated man in past times, and on this ground the word "Shakespere" was expunged from the register.

The addition of the definite article to a word not of itself a fancy word, was held not to make it a fancy word within the Act (*v*).

The word "Oomoo," a word in the aboriginal language of Australia signifying choice, was held to be a "fancy word," and was registered in respect of Australian wines and spirits (*x*). So also the word "Bovril" has been held a good fancy word (*y*). And the word "Mazawattee" as a word for tea (*z*).

The question is whether the fancy word is non-descriptive at the time it is placed on the register; and if it is, the fact that it has since become descriptive is no ground for removal from the register (*a*).

SUB-SECTION (2).

"There may be added to any one or more of the essential particulars," etc.—Descriptive words, though incapable of registration alone, might, under the Act of 1875, and may, under the present Act, be registered as "added" to one of the "essential particulars" of a trade mark capable of registration. Thus the words "Filtre Rapide" were allowed to be registered in combination with a written signature, and this although the words "Rapid Water Filter" were already on the register (*b*).

(*p*) *Harris's Trade Marks*, 9 R. P. C. 492.

(*q*) *Hannay's Trade Mark*, 7 R. P. C. 46.

(*r*) *Apollinaris Co.'s Trade Mark*, [1891] 2 Ch. 186.

(*s*) *Meaby* v. *Triticine, Ltd.*, 15 R. P. C. 1.

(*t*) W. N. (1885), 124.

(*u*) 12 R. P. C. 333.

(*v*) *Re The Trade Mark Alpine*, 29 Ch. D. 877, 879.

(*x*) *Re Burgoyne's Trade Mark*, W. N. (1889), 52; 6 R. P. C. 227.

(*y*) *Re Bovril Trade Mark*, [1896] 2 Ch. 600.

(*z*) *Densham's Trade Mark*, [1895] 2 Ch. 176, cited *ante*, p. 391.

(*a*) *Re Bovril Trade Mark*, [1896] 2 Ch. 600.

(*b*) *Re Maignen*, 28 W. R. 759.

Sect. 64 (2).

NOTE.

So, also, a figure of Neptune with a trident, and with the word "Neptune," that being the name by which the goods were known in the market, was held to have been properly registered (*c*). And the words "Carbolic Acid Soap Powder" (*d*), "Sanitary Filter, easily cleaned" (*e*), each in combination with a distinctive device, were allowed registration.

But in such cases it is only the label as a whole which is protected. No right to the exclusive use of these common words is gained by the registration (*f*). In one case the order allowing registration was prefaced by a declaration of the opinion of the court to this effect (*g*). Now, however, under the amended sub-section, the applicant must state the essential particulars of his trade mark, and disclaim the exclusive use of the added matter.

Where Baron Liebig was the inventor of an extract of meat, and the name Liebig had become common to the trade as designating the particular extract, a proposed trade mark, consisting of the words "Brand Baron Liebig," with a portrait copied from a photograph of the Baron, was refused registration, the latter not being a "distinctive device" capable of registration *per se* (*h*).

And the words "John Bull Brand" were held, in the Court of Appeal, to have been rightly registered as addition to a trade mark consisting of a figure of John Bull (*i*).

Marks for cotton goods, consisting of a shield or frame in the shape of a shield, with (1) letters indicative of the firm itself, (2) representation of a swan, and also letters indicative of the firm, varying letters being used on each mark, indicating the date and packer of each parcel of calico, were considered sufficiently distinctive to be registered as old marks, on an undertaking not to use them except in the manner in which they had been previously used (*j*)

"The . . . applicant must state . . . the essential particulars . . . and must disclaim," etc.—This requirement was introduced by the Act of 1888, and extends the provisions of s. 74 (2) to added matter *not common to the trade. Under the Act of 1875 there was no power*

(*c*) *Edwards* v. *Dennis*, 30 Ch. D. 457.

(*d*) *Hudson's Trade Marks*, 32 Ch. D. 311.

(*e*) *Re Atkins' Trade Mark*, 3 R. P. C. 164.

(*f*) *Re Hudson's Trade Marks*, *ubi supra*; *Atkins' Trade Mark*, *ubi supra*. See also *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(*g*) *Re Hudson's Trade Marks*, 3 R. P. C. 155, 164. This Order is printed W. N. (1886), p. 71.

(*h*) *Anderson's Trade Mark*, 26 Ch. D. 409, affirmed 54 L. J. Ch. (N.S.) 1084.

(*i*) *Paine* v. *Daniell*, [1893] 2 Ch. 567.

(*j*) *Re Sykes & Co.'s Trade Mark*, 29 W. R. 235.

Sect. 64 (2.) to require the applicant to disclaim the right to the exclusive use of any of the words in the trade mark presented for registration (*k*).

NOTE. For the proper mode of complying with this provision, see T. M. R., Form F.

Where the application is to register a label, the label itself may be an essential particular. But a red label, containing the name of the goods with a device in a shield, and certain capital letters nearly as large as the label, and printed in white upon it, and with a *facsimile* signature and flourishes, is not such a label (*l*).

SUB-SECTION (3).

"**(i) A person need not . . . disclaim his own name.**"—This applies to a firm as well as to an individual, and whether the name is the name of a firm or an individual, it need not be disclaimed, nor need the whole name appear on the trade mark if it is used fairly and *bonâ fide* on the face of the trade mark, so that it cannot be mistaken for anything else than the name of the owner of the mark and the manufacturer of the goods. And therefore, when the name of a firm was J. Colman (*m*), and all the partners bore that name, it was held that a label containing the words "Colman's mustard" might be registered without disclaiming the word "Colman."

And it would seem that the above rule applies whether the name is the actual name of the applicant or a name assumed for trading purposes (*n*).

General rule as to rival traders of same name.

"**But no entry of any such name shall affect the right of any owner of the same name,**" etc.—The law as affecting rival traders of the same name dealing in the same article was thus stated by BRAMWELL, L.J., in *Massam* v. *Thorley's Cattle Food Co.* (*o*): "It is said that it is hard if a man has the name of Thorley that he cannot make food and sell it as Thorley's food. So he may, but if, unfortunately for him, some preceding Thorley has carried on the business of making cattle food in such a way that by the name 'Thorley's cattle food' is understood the manufacture of that man, then the second Thorley, or the man who assumes his name, must take care so to

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(*k*) *Hudson's Trade Marks*, 32 Ch. D. 311; *Thompson* v. *Montgomery*, 58 L. J. Ch. 94; 41 Ch. D. 35, [1891] A. C. 217.

(*l*) *Per* KEKEWICH, J., *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195, 196.

(*m*) *Colman's Trade Mark Application*, [1894] 2 Ch. 115.

(*n*) *Colman's Trade Mark Application*, *ubi supra*.

(*o*) 14 Ch. D. 760.

conduct his business as not to be mistaken for the original Thorley, and if he carries on his business so as to be mistaken, he must be restrained from doing it."

Sect. 64 (3). NOTE.

And again, in *Melachrino* v. *The Melachrino Egyptian Cigarette Co.* (*p*), CHITTY, J., said: "It is said that a man has a right to carry on business under his own name, and that is unquestionably so; but where there is already an established business carried on under the same name, it is important to see that the man who happens to have the same name and starts in the same business, carries on that business fairly and honestly, and not in such a manner as to deceive the public into the belief that the two businesses are one and the same. Honestly he may trade under his own name, but he must be careful not to trade under his own name in such a manner as to take away that which lawfully belongs to another man."

Thus, where the plaintiff and defendant were brothers, each entitled to make a particular article from a receipt which had descended to them from their father, and the defendant, who had a partner, traded in his own name with the addition "& Co.," whereby his firm name became the same as that of the plaintiff firm except the initials, and the defendants were proved to have attempted to represent that the business which they carried on was the business of which the plaintiff was the proprietor, an injunction was granted (*q*).

So, also, where one Thomas Holloway had for some time sold a medicine as "Holloway's Pills," an injunction was granted to prevent the sale by a person whose name was Henry Holloway of pills under the name of "H. Holloway's Pills" in such a way as to induce the public to believe they were buying the medicine of the original maker (*r*).

And where the plaintiff had for many years sold certain medical preparations under his own name as "A——'s Safe Cures," and they had become known in the market as "A——'s Cures," the defendant, whose name was the same as that of the plaintiff, and who sold a preparation which he called "A——'s Gout and Rheumatic Cure," was restrained from selling any preparation not of the plaintiff's manufacture so as to lead to the belief that such preparations were the goods of the plaintiff (*s*).

In cases between persons of the same name the proper form of injunction now is to restrain the defendant from carrying on his business under any name of which the name complained of forms

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(*p*) 4 R. P. C. 220.
(*q*) *Fullwood* v. *Fullwood*, 9 Ch.D. 176.
(*r*) *Holloway* v. *Holloway*, 13 Bea. 209.
(*s*) *Warner* v. *Warner*, 5 Times R. 327, 359.

Sect. 64 (3). part without clearly distinguishing his goods from those made or sold by the plaintiff (*t*).

NOTE. So also an injunction has been granted restraining the omission by the defendant of his second Christian name, whereby his name appeared to be the same as that of the plaintiff (*u*).

And a man cannot sell his own name to another for the purpose of enabling him to carry on a rival trade, particularly when it is for the purpose of carrying on a rival trade fraudulently (*v*).

Thus, in the well-known case of *Croft* v. *Day* (*x*), where the defendant, whose name was Day, obtained the authority of a man named Martin to use his name, and began to sell goods under the firm of Day and Martin, he was restrained, at the suit of the executors of the survivor of the original firm of that name, from selling his manufactures as being that of the plaintiffs.

And where a servant who had been in plaintiff's employment entered into partnership with another person of the same surname as plaintiff, and the two began to sell an article the same as that sold by plaintiff, under a name only colourably different from that used by him and with their firm name attached, the new partner's name being placed first, an injunction was granted (*y*).

So, also, where the plaintiffs were executors of a needle manufacturer with a large business, and the defendants, who were rival manufacturers, purchased a patent for making needles belonging to a nephew bearing the same name as the plaintiff's testator, and also the goodwill of a small trade in needles, carried on by the nephew, and the defendants conducted their business so as to deceive the public, an injunction was granted (*z*).

And where the defendants traded as a company, with a name in which the name of the original maker of the article sold by the company appeared, and the only connection of the company with that name was that a member of the family of the original makers, who was employed by the company to make the article, took a 1*s.* share in the company, it was held that the company were not at liberty to use the name for their article unless they took such precautions as would prevent purchasers from supposing that the article sold by them was manufactured at the establishment of the original maker (*a*) So, also, where

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(*t*) *Pinet* v. *Maison Pinet*, 14 R. P. C. 933.

(*u*) *James* v. *James*, L. R. 13 Eq. 421.

(*v*) See *per* CHITTY, J., *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215; *Tussaud* v. *Tussaud*, 44 Ch. D. 678.

(*x*) 7 Beav. 84.

(*y*) *Schweizer* v. *Atkins*, 37 L. J. Ch. 847.

(*z*) *Perks* v. *Hall*, W. N. (1881), 111.

(*a*) *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748.

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the plaintiff was the proprietor of an old established library business known as the "Grosvenor Library" he was held entitled to restrain a newly established company from carrying on a like business under the same name (*b*).

And where the brother of the plaintiff had entered into an agreement with the defendant to act as his manager of a business, to be carried on under the brother's name, it was held, under the circumstances, that the business was really the defendant's, and that there was an obvious intention to take away the plaintiff's trade, and an injunction was granted (*c*).

So, also, a firm of needle makers, named Shrimpton and Hooper, who were in the habit of selling their goods in packets stamped with their name, were held entitled to prevent the defendant from selling needles in packets marked "Shrimpton Turvey," the latter not being the defendant's name, but the name of a person not a needle maker, and who had authorised the defendant to use his name (*d*).

Where use of own name not restrained.

If, however, the defendant uses his own name in his business in such a way as not to represent his goods as the goods of the plaintiff, the injunction will be refused. "In applications of this kind it must be made out that the defendant is selling his own goods as the goods of another. Where a person is selling goods under a particular name, and another person, not having that name, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not" (*e*).

And therefore, where the father of the plaintiff and the plaintiff had carried on business in partnership at 107, Strand, which business the plaintiff continued after the father's death as executor and sole residuary legatee of the father, and another son commenced a similar business, describing himself by his own name and adding "late of 107, Strand," an injunction was granted restraining the use of the latter words; but an injunction against the use of the defendant's name in connection with the articles sold by him was refused, there being no

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(*b*) *Hoby* v. *Grosvenor Library Co.*, 28 W.R. 386. See also *Hendriks* v. *Montagu*, 17 Ch. D. 638; *Manchester Brewery Co.* v. *North Cheshire and Manchester Brewery Co.*, 14 Times R. 350.

(*c*) *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, 4 R.P.C. 215.

(*d*) *Shrimpton* v. *Laight*, 18 Beav. 164; *Southorn* v. *Reynolds*, 12 L.T. (N.S.) 75; *Barber* v. *Manico*, 10 10 R.P.C. 93.

(*e*) *Per* TURNER, L.J., *Burgess* v. *Burgess*, 3 D.M. & G. 896. See also *Jamieson* v. *Jamieson*, 14 Times R. 160; 15 R.P.C. 169.

Sect. 64 (3). representation made by the defendant that his goods were the goods manufactured by the plaintiff (*f*).

NOTE. And two persons or firms may each be entitled to use a name which both have derived from a common predecessor (*g*).

And when plaintiff had for many years carried on business as T. T. and Sons, and the defendant J. T. had carried on business in the same town as J. T., and then as J. T. & Co., and on taking his sons into partnership changed the name of his firm to J. T. and Sons, an injunction was refused, there being no evidence of imitation of trade marks or labels or of any attempt to deceive (*h*).

So, also, where a Canadian Insurance Company had for several years carried on business as the "Sun Life Assurance Company of Canada," it was held that an old established English Company called the Sun Life Assurance Company could not restrain the use of the name "Sun" or the "Sun Life" by the Canadian Company, provided it was always used in connection with the words "of Canada." (*i*)

But where a company was trading under a name derived from one of its directors who had only recently adopted the name, having changed his original name, it was held that the company had no rights against a plaintiff who had long previously traded under the same name, and an injunction was granted (*k*).

(ii.) "**Special and distinctive word or words . . . used as a trade mark before the 13th day of August, 1875,**" etc.—Two things are here made requisite in order to registration—

1. The word or words must be "special and distinctive";
2. They must have been "used as a trade mark" before August 13th, 1875, the date of the passing of the Act of 1875 (*l*).

We will consider these in order.

"**Special and distinctive.**"—"The word or words must be distinctive in this sense, that they distinguish the manufacture of the person who registers the trade mark from the manufacture of all others. . . . . There may be cases in which they distinguish not the manufacture but the selection or some other operation upon the goods, but in all cases the word or words must distinguish the product of the person claiming the trade mark from the product of all other persons" (*m*).

(*f*) *Burgess* v. *Burgess*, *ubi supra*.

(*g*) *Dent* v. *Turpin*, 2 J. & H. 139, 147. But see *Daniel* v. *Whitehouse*, 67 L. J. Ch. 262.

(*h*) *Turton* v. *Turton*, 42 Ch. D. 128.

(*i*) *Saunders* v. *Sun Life Assurance Co. of Canada*, [1894] 1 Ch. 537.

(*k*) *Pinet* v. *Maison Louis Pinet*, [1898] 1 Ch. 179.

(*l*) *Wood* v. *Lambert*, 32 Ch. D. 247, 259, 262.

(*m*) *Per* FRY, L.J., *Wood* v. *Lambert*, 32 Ch. D. 262; *Leonard* v. *Wells*, 26 Ch. D. 304; *Re Perry Davis' Trade Mark*, 5 R. P. C. 333,

The name of an individual or firm printed in ordinary type may, if it has been used as a trade mark before the Act of 1875, be registered as an old mark under this sub-section (*n*).

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NOTE.

The question whether words merely descriptive of a new article, and applied to it by the person who first invents the article or introduces it into the market, can in any case be registered as old marks has not been expressly decided. In the decided cases, where such words have been removed from the register, the ground of removal has been either that the words had not been "used as a trade mark" within the Act (*o*), or had been specially so used as not to be "distinctive" of the plaintiff's goods (*p*).

Descriptive words as old marks.

But in *Re Palmer's Trade Mark*, where the words in question had been used to designate a particular description of cigar lights, the subject of a patent since expired, BAGGALLAY, L.J., said, that if, by reason of the patentee using a word descriptive of the nature of his patent for the purpose of describing his article, he could acquire a title to the exclusive use of that name afterwards, it would simply be enabling him by a perversion of the Registration of Trade Marks Act to give an indefinite extension to the monopoly acquired by him under the patent; and that the alleged trade mark was not a trade mark such that an exclusive right to its use could have been enforced before the Act came into operation, and was not, therefore, a trade mark entitled to registration under the Act (*q*). And see also, *post*, p. 405.

And in *Leonard* v. *Wells*, FRY, L.J., said: "When a new material is invented and at the same time a new single word is invented which is applied to that material alone, I am by no means satisfied at present that that single word can be treated as a special and distinctive word within the meaning of the section" (*r*).

And in *Re Ralph's Trade Mark* (*s*), where a washing machine, which had been exclusively manufactured by a licensee under a patent, had been sold under the name "The Home Washer," PEARSON, J., while directing the mark to be expunged from the register on a special

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341, reported as *Re Harbord*, 58 L. T. (N.S.) 695. And see judgment of Lord HALSBURY, C., in the case when in the House of Lords, 15 App. Cas. 320.

(*n*) *Hopkinson's Trade Marks*, [1892] 2 Ch. 116.

(*o*) *Re Palmer's Trade Mark*, 24 Ch. D. 504; *Leonard* v. *Wells*, 26 Ch. D. 288.

(*p*) *Wood* v. *Lambert*, 32 Ch. D. 259.

(*q*) 24 Ch. D. 517; and see remarks of FRY, J., in *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch.D. 837.

(*r*) 26 Ch. D. 304. See also remarks of the same learned judge in *Wood* v. *Lambert*, 32 Ch. D. 262; *Linoleum Co.* v. *Nairn*, 7 Ch. D. 837; and see *per* COTTON, L.J., 26 Ch. D. 301; *per* KAY, J., *Re Grossmith's Trade Mark*, 6 R. P. C. 183; and *per* LINDLEY, L.J., *Palmer's Trade Mark*, 24 Ch. D. 521.

(*s*) 25 Ch. D. 194.

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ground peculiar to the Act of 1875, said, that he was very much disposed to think that if he had to decide the case on a point which had been raised that the name ought not, under the circumstances, to have been registered as a trade mark at all, he should decide that the case came within *The Linoleum Co.* v. *Nairn* (*t*), and that the trade mark ought to be removed on that ground also.

But in *Leonard* v. *Wells*, Lord SELBORNE, C., said, in reference to the word "Valvoline," which was a name given by the plaintiffs to a lubricating oil invented by them, that he was not disposed to doubt that if that word had been used in the United Kingdom as a trade mark before the passing of the Act of 1875, it might have been registered under that Act (*u*).

And in *Edgington* v. *Edgington* (*v*), it was held that the mere use of a word as the name of the article on letters, testimonials, and the like, dated before 1875, was not a fatal objection to its registration as an "old mark."

Where the word "Bodega," which is a Spanish word descriptive of a wine shop, had been used as a trade mark before 1875, it was held capable of registration as a trade mark for "wines, etc. and tobacco" (*w*).

It is doubtful whether the scientific name of a tree is a "distinctive word" capable of being registered as an old trade mark for a product of the tree (*x*).

The word "royal" in connection with the name of a company was held not sufficiently "special and distinctive," and was refused registration (*y*). So, also, the word "registered" will not be put on the register, either alone or as part of a mark (*z*). See also p. 458, *post*.

On a motion to expunge an old mark on the ground that it has not been used as a trade mark within this sub-section the burden of proof is on the applicants, and the court will, as against them, take into consideration the lapse of time since the registration and the circumstances under which the application is made (*a*).

The words "Family Salve" (*b*), "Kitchen Crystal Soap" (*c*), "Baffle," (as a mark for safes) (*d*), have been held entitled to registration as old marks.

(*t*) *Ubi supra.*
(*u*) 26 Ch. D. 295.
(*v*) 6 R. P. C. 513.
(*w*) *Bodega Co.* v. *Owens*, 6 R.P.C. 236; 7 R. P. C. 31.
(*x*) *Rose* v. *Evans*, 48 L. J. Ch. 618.
(*y*) *Re Royal Baking Powder Co.*, W. N. (1879), 108; affirmed on appeal, W. N. (1880), 49.
(*z*) *Re Meikle's Trade Mark*, W.N. (1876), 248.
(*a*) *Edgington* v. *Edgington*, 6 R. P. C. 513, 518.
(*b*) *Reinhardt* v. *Spalding*, 49 L.J. Ch. 57.
(*c*) *Eastman's Trade Mark*, W. N. (1880), 128.
(*d*) *Talbot* v. *Webley*, 3 R. P. C. 276.

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And words such as "Melrose," "Electric," though not "fancy words not in common use," and therefore incapable of registration as new marks, might, if they had been used for a considerable time, and the trade had recognized goods to which these words were affixed as being the goods of the applicants for registration, be registered as old marks (*e*).

And it is not impossible that a word which is used to describe an article may also, if the proper means are taken at the proper time, be used as a trade mark (*f*).

Name given by first producer.

And where the first producer of an article of manufacture has identified it with a particular name or word, such name or word may become a trade mark (*g*); as, for instance, "Singer" (the name of the original maker), as applied to sewing-machines (*h*); "Harvey," as a name for a sauce (*i*); "Turin," "Sefton," "Leopold," or "Liverpool," as names for cloth (*k*); "Eureka" for shirts (*l*); "United Service" for soap (*m*); "Eton" for cigarettes (*n*); "La Flor de Margaretta" for cigars (*o*); and "Chartreuse" for a liqueur (*p*).

Name of article made under secret process or patent.

But it is established as a general rule, that where an article is made under a secret process, or where the manufacture of it is protected by a patent, the manufacturer or patentee cannot by any means entitle himself to a monopoly in the use, after the secret process has been discovered or the term of the patent has expired, of the name by which the manufactured article is exclusively known whilst the secret is undiscovered, or the term of the patent is unexpired (*q*).

Name of a place.

The name of a place may become a trade mark, thus: "Anatolia" (*r*), as applied to liquorice; "Glenfield," as applied to starch (*s*); "Cormac

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(*e*) See *per* COTTON, L.J., *Van Duzer's Trade Mark*, 34 Ch. D. 623, 635. See also remarks of KAY, J., *Compania General de Tabacos* v. *Rehder*, 5 R. P. C. 61, 65.

(*f*) *Per* Lord SELBORNE, C., *Leonard* v. *Wells*, 26 Ch. D. 296. See also *per* FRY, L.J., *Wood* v. *Lambert*, 32 Ch. D. 262: but see remarks of KAY, J., *Re Grossmith's Trade Mark*, 6 R. P. C. 183.

(*g*) *Singer Co.* v. *Wilson*, 3 App. Cas. 376; *Singer Co.* v. *Loog*, 8 App. Cas. 15, 17, 35.

(*h*) *Singer Co.* v. *Wilson*, *ubi supra*.

(*i*) *Lazenby* v. *White*, 41 L. J. Ch. 354.

(*k*) *Hirst* v. *Denham*, L. R. 14 Eq. 543.

(*l*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*m*) *Field* v. *Lewis*, Seton, p. 537.

(*n*) *Wood* v. *Lambert*, 32 Ch. D. 247, PEARSON, J.

(*o*) *Benedictus* v. *Sullivan*, 12 R. P. C. 25.

(*p*) *Grezier* v. *Autran*, 13 R. P. C. 1; *Grezier* v. *Ziemer*, Seton, 536.

(*q*) *Magnolia Metal Co.'s Trade Mark*, [1897] 2 Ch. 371, 391; *Meaby* v. *Triticine, Ltd.*, 15 R. P. C. 1. See also *per* FRY, J., *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 837. And see CHITTY, J., *Palmer's Trade Mark*, 24 Ch. D. 509, and *Native Guano Co.* v. *Sewage, etc., Co.*, 8 R. P. C. 125, 132, 134 (a case of an old mark).

(*r*) *McAndrew* v. *Bassett*, 4 D. J. & S. 380.

(*s*) *Witherspoon* v. *Currie*, L. R. 5 H. L. 508.

Sect. 64 (3). Springs" (*t*); "Radstock," as applied to collieries within the parish of that name (*u*); "Apollinaris," as applied to mineral waters (*x*). Geographical words cannot now, however, be registered as essential particulars of a trade mark (*y*).

NOTE.

Words must be distinctive at date of registration.

In order to be capable of registration the words must be "special and distinctive" at the time of registration (*z*). And therefore, where the word "Eton" was registered by a manufacturer as an old mark for cigarettes, and it was proved that he had before registration been in the habit of selling and supplying for the purposes of sale "Eton" cigarettes in boxes so labelled (in conformity with an alleged trade custom) as to imply that the cigarettes were made by a Russian firm at St. Petersburg, the mark was removed from the register (*a*).

Must not have been used as descriptive.

(iii.) "**Used as a trade mark.**"—Some use of the term, not as a descriptive term, but as a trade mark, must be shown in order to bring the case within this provision (*b*). And where the words "braided fixed stars" had been used merely to describe an article made under a patent which had expired, they were held not to have been "used as a trade mark" (*c*). So, also, where the word "Valvoline" had been used to describe a particular lubricating oil invented by the plaintiffs (*d*), and where the word "Albion" had been used simply to indicate the design and pattern of the goods (*e*).

Must have been used alone.

And the words must have been used by themselves as a trade mark, not in combination with any device or any other words (*f*). And where the words had only been used as part of a label (*g*), or in combination with a device and a name (*h*), or with a name only (*i*), it was held that they had not been "used as a trade mark" within the Act.

And where brewers at Stone had used, before 1875, the words "Stone ale" in combination with some device or the name of the firm, and had not used the words "Stone ale" alone, the registration of these words as

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(*t*) *Wheeler* v. *Johnston*, L. R. 3 Ir. 284.

(*u*) *Braham* v. *Beachim*, 7 Ch. D. 848.

(*x*) *Apollinaris Co.* v. *Edwards*, Seton, p. 537; *Apollinaris Co.* v. *Norrish*, 33 L. T. (N.S.) 242.

(*y*) *Ante*, pp. 384, 392.

(*z*) *Wood* v. *Lambert*, 32 Ch. D. 258. See *Edwards* v. *Dennis*, 30 Ch. D. 454, 479.

(*a*) *Wood* v. *Lambert*, *ubi supra*.

(*b*) *Per* Lord SELBORNE, C., *Leonard* v. *Wells*, 26 Ch. D. 298.

(*c*) *Re Palmer's Trade Mark*, 24 Ch. D. 504, 519.

(*d*) *Leonard* v. *Wells*, *ubi supra*.

(*e*) *Harrison McGregor & Co.'s Trade Marks*, 42 Ch. D. 691.

(*f*) *Re Palmer's Trade Mark*, 24 Ch. D. 504, 518; *Leonard* v. *Wells*, *ubi supra*; *Perry Davis* v. *Harbord*, 15 App. Cas. 316.

(*g*) *Re Palmer's Trade Mark*, *ubi supra*.

(*h*) *Spencer's Trade Marks*, 3 R. P. C. 73.

(*i*) *King & Co.'s Trade Mark*, 9 R. P. C. 350, 353.

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an old mark was expunged (*k*). So, also, the words "Pain Killer," which had only been used before the Act as part of the expression P's Vegetable Pain Killer, were held incapable of registration as an old mark (*l*). And where the words "Yorkshire Relish" had only been used as part of a label containing a willow pattern plate and other things, and the name of the maker, the registration of the words was expunged (*n*).

Must have been used on the goods.

User of the words "as a trade mark" means the impressing of those words either upon the goods, or upon some wrapper or case containing the goods, in such a way that the public would necessarily understand those words to be, and alone to be, the trade mark of the person who uses them (*o*).

Thus, where the words "Excelsior Spring Mattress" had been stamped on the mattresses, and on billheads and notices, and photographs of the mattress had been published showing the stamp, it was held that the words had been used as a trade mark (*p*).

But where the words "Monopole" and "Dry Monopole," registered as old marks for champagne, had only been used before the Act (1) on bottle labels or wrappers, in connection with the grower's name and other words, (2) on the side of corks, the bottom of which was branded with a registered mark consisting of the grower's name and a device, (3) on cases containing bottles labelled and wrapped as above, each case having on one side the words in question, and on one end another registered mark of the grower which contained his name, it was held that the words had not been used as a trade mark within the Act, and the registration was expunged (*q*).

So, also, where the words "Diamond Cast Steel" had been used on files, but only in conjunction with the maker's name, though the latter was only on the other side of the file, it was held that there had been no sufficient user (*r*).

And the use of the words "Yorkshire Relish" stencilled on packing cases containing bottles of sauce having thereon labels of which the above words formed part, was held not to be such a user of the words as to entitle them to registration as an old mark (*s*).

(*k*) *Thompson* v. *Montgomery*, 41 Ch. D. 35.

(*l*) *Perry Davis* v. *Harbord*, 15 App. Cas. 316.

(*n*) *Re Powell's Trade Mark*, [1893] 2 Ch. 388; [1894] A. C. 8.

(*o*) *Per* KAY, J., *Richards* v. *Butcher*, [1891] 2 Ch. 522, 532; and see also judgment of Lord ESHER, M.R., *ibid.* p. 543, and in *Re Spencer's Trade Marks*, 3 R. P. C. 74.

(*p*) *Re Charlton and Dugdale's Trade Mark*, 34 W. R. 60.

(*q*) *Richards* v. *Butcher*, [1891] 2 Ch. 522. See also *Kinahan's Application*, 10 R. P. C. 393.

(*r*) *Spencer's Trade Marks*, 3 R. P. C. 73.

(*s*) *Powell's Trade Mark*, [1893] 2 Ch. 388; [1894] A. C. 8.

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And it is doubtful whether user on packing cases which are returned by the customer is a use in connection with the goods in the packing case (*t*).

Where the words "H.'s Coker Canvas" were never stamped on the goods of the firm, and had never been advertised as a trade mark, but customers had inquired for "Coker Canvas" or "H.'s Coker Canvas," it was held that the words had not been used as a trade mark (*u*).

A trade mark is not used within the Act by being put up in a warehouse or by advertising it in a newspaper (*x*).

"**Before the 13th day of August, 1875.**"—If the statement made to the comptroller on this point be untrue in fact, although it may have been made without fraud, the trade mark will be removed from the register (*y*).

"**Letter, figure, ... combination of letters and figures.**"—These words are additions to the Act of 1875, under which it was held that a single letter could not be registered as an old mark (*z*).

A word in foreign characters may be registered (*a*), but a transliteration and translation must be supplied to the comptroller (*b*).

Although words or devices indicating merely quality cannot be registered, combinations of letters, indicating to purchasers (1) that the goods are made by a particular firm, and (2) the quality and pattern of the goods, are valid trade marks, and may be registered (*c*).

Price is no part of a trade mark, and therefore registration was refused for a mark containing words of price; but registration of two old marks was allowed, with a note that the marks might be varied in respect of price (*d*).

Representative registration.

Where a firm had been in the habit of using as trade marks for iron the letters "B B H" which were the initials of the firm, and also the same marks coupled with symbols or words common to the trade, denoting the quality of the iron, and the registrar objected to separate registration of each mark, it was suggested by the Court of Appeal,

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(*t*) See *per* Lord ESHER, M.R., *Richards* v. *Butcher*, [1891] 2 Ch. 522, 545.

(*u*) *Re Hayward's Trade Mark*, 54 L. J. Ch. 1003.

(*x*) See *per* Lord ESHER, M.R., *Re Spencer's Trade Marks*, 3 R. P. C. 74.

(*y*) *Baker* v. *Rawson*, 45 Ch. D. 519.

(*z*) *Re Mitchell's Trade Mark*, 7 Ch. D. 36.

(*a*) *In re Rotherham's Trade Mark*, 11 Ch. D. 250; 14 Ch. D. 585. See also judgment of MALINS, V.-C., *Re Barrow's Trade Marks*, 5 Ch. D. 364.

(*b*) T. M. R., 1897, r. 15, *post*. So also if the trade mark contains a word in a foreign language, *ibid.*

(*c*) *Ransome* v. *Graham*, 47 L. T. (N.S.) 218; 51 L. J. (N.S.) Ch. 897. See also *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518.

(*d*) *Re Steedman's Trade Mark*, L. J. No. Ca. (1883), 83.

and accepted by the parties, on an appeal from a decision of MALINS, V.-C., ordering separate registration, that the proper mode of registering was to register "B B H" "either used alone or in common with a crown, or with a horse-shoe, or with a crown and horse-shoe" (the symbols objected to as common to the trade), "or with any other mark, device, or words, signifying the quality of the iron" (*e*). And in a subsequent case of *Re Brooks' Trade Mark* (*f*), it was held by HALL, V.-C., that this method of registration (which was known as representative registration) ought to be adopted in like cases, and that such a series of marks was not entitled to separate registration. As to registering such marks now, see *post*, s. 66.

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In the words of this sub-section there is only a permission to register the mark. The comptroller is not bound to register it. He must look at all the facts of the case and see whether it is proper, under all the circumstances, to register the word (*g*). See also under s. 73, *post*.

Sub-section 3 is permissive only.

65. A trade mark must be registered for particular goods or classes of goods (*h*).

Connexion of trade mark with goods.

See notes under s. 62 (3), *ante*, p. 378.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Registration of a series of marks.

See T. M. R. 1897, *post*, r. 14.

This section deals with what was known as representative registration (see *ante*, notes to s. 64 (3), p. 408), and the last clause secures to the

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(*e*) *Re Barrow's Trade Marks*, 5 Ch. D. 353.

(*f*) 26 W. R. 791.

(*g*) See *per* KAY, J., *Re Grossmith's Trade Mark*, 6 R. P. C. 182.

(*h*) T. M. R., r. 6, and Third Schedule thereto, *post*.

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NOTE.

proprietors of the marks the same rights as if there had been separate registration of each, and meets the objections to representative registration stated in the arguments to the cases of *Re Barrow's Trade Marks* and *Re Brooks*, cited above.

Trade marks may be registered in any colour.

67. A trade mark may be registered in any colour, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour (*i*).

By s. 11 of the Act of 1888, this section is amended as follows :—

In section sixty-seven of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

Under the Act of 1875 colours could not be registered, and therefore the court would not take similarity of colour into consideration on a question of piracy, but the plaintiff was bound to prove his case from a comparison of uncoloured diagrams (*k*). The fact that under that Act the mark might be printed in any colour was considered a reason for refusing registration of a mark which, though if printed in a different colour from the opponent's mark was sufficiently distinctive, would yet have been liable to deceive if printed in the same colour (*l*). And for the like reason, where a mark had been registered under the Act of 1875, a similar mark registered under the present Act was ordered to be expunged from the register (*m*).

But where a registered cotton-mark was a silver rupee, it was held that a gold mohur, which had been deposited under r. 8 of the rules under the Act of 1875 (now part of r. 13 of the Trade Marks Rules, 1890, *post*), and of which the representation could be seen, was not calculated to deceive, and could be registered for cotton goods (*n*).

Under this section, in its original form, it has been held that the mark, to be capable of registration, must be a distinctive device, independently of the colour; and a device of a label in three parallel stripes of equal width, two shaded and the middle unshaded, having on

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(*i*) See *post*, p. 605, as to ornamental or coloured groundwork, part of a mark.

(*k*) *Nuthall* v. *Vining*, 28 W. R. 330. See also judgment of Earl CAIRNS, C., *Orr Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 185.

(*l*) *Re Worthington & Co.'s Trade Mark*, 14 Ch. D. 8.

(*m*) *Re Biegel's Trade Mark*, 4 R. P. C. 527.

(*n*) *Re Robinson's Trade Mark*, 29 W. R. 31.

it the words "French Coffee," and below this the words "red, white and blue," and other words in French and English, was held not sufficiently distinctive, and was refused registration (*o*). Sect. 67. NOTE.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller. Advertisement of application.

By s. 12 of the Act of 1888, this section is amended as follows :—

In section sixty-eight of the principal Act after the word comptroller shall be added the words "unless the comptroller refuse to entertain the application."

See Trade Marks Rules, 1890, *post*, rr. 27—30.

69. (1.) Any person may within *two months* of the *first* advertisement of the application, give notice in duplicate at the patent office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant. Opposition to registration.

(2.) Within *two months* after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) *If the applicant sends such counter statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.*

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the*

(*o*) *Hanson's Trade Mark*, 37 Ch. D. 112.

Sect. 69 *applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*

The section in its original form was substantially an enactment of r. 16 of the Rules of August, 1876, as altered by r. 15 of the Rules of March, 1883, under the Act of 1875.

By s. 13 of the Act of 1888, sub-s. (1) is amended by substituting for the words "two months" the words "one month or such further time not exceeding three months as the comptroller may allow," and by omitting the word "first"; and sub-s. (2) is amended by substituting for the words "two months" the words "one month." And for sub-ss. (3) and (4) the following sub-sections are substituted :—

"(3.) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the court, and in that event the court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5.) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

"(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

SUB-SECTION (1).

There may be various grounds of opposition under this section. Registration may be successfully opposed by a person who has had a

concurrent use of the same mark though not registered (*p*). So, also, where a foreigner, having a business in America, sent goods to England marked with his trade mark, it was held that he had used the mark in England and would have a right to oppose the registration of the mark by his consignees in their own names (*q*).

Sect. 69 (1) NOTE.

If the opposition is confined to the grounds mentioned in s. 72, and the case comes within that section, the comptroller cannot register. But there may be other grounds on which the court may decide that a trade mark ought not be registered. The court has a discretion, and must see whether, if the case is not within s. 72, the registration is one which the court ought not to allow (*r*). And if the marks sought to be registered are new marks, and the comptroller thinks the registration would be calculated to deceive, he is not bound to register even though the consent of the owners of similar marks already on the register is obtained (*s*).

Comptroller's discretion.

So, also, if the court comes to the conclusion that the application to register is made in order to obtain an illegitimate advantage over other persons, the application will be refused (*t*). See *post*, under ss. 72 and 73.

The comptroller has power to allow amendments of notices of opposition (*u*), but not when the appeal has been referred to the court (*x*), nor after the three months has expired (*y*).

The comptroller may, on an opposition, go into a case of fraud, and allegations of fraud may be introduced by amendment (*z*).

SUB-SECTION (2).

For form of counter-statement, see Appendix, *post*, p. 606.

SUB-SECTIONS (3), (4), (5).

Under the section as it stood in the Act of 1883, all opposed applications for registration of trade marks were determined by the court, and r. 29 of the Trade Marks Rules, 1883, provided for a summons

(*p*) *Roger's Trade Mark*, 12 R. P. C. 149. See also *Thewlis and Blakey's Trade Mark*, 10 R. P. C. 369.

(*q*) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

(*r*) *Re Australian Wine Importers, Limited*, 41 Ch. D. 278.

(*s*) *Dewhurst's Trade Mark*, [1896] 2 Ch. 137. See also *Currie's Application*, 13 R. P. C. 681.

(*t*) *Thewlis and Blakey's Trade Mark*, 10 R. P. C. 369.

(*u*) *Henri Moët's Trade Mark*, 7 R. P. C. 226.

(*x*) *Robertson, Sanderson & Co.'s Application*, [1892] 2 Ch. 245.

(*y*) *Ibid.*

(*z*) *Henri Moët's Trade Mark*, *ubi supra*.

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in the chambers of a judge of the High Court of Justice being taken out by the applicant for the purpose of obtaining such determination.

By the section as amended a new practice is introduced.

NOTE.

In opposed, as well as in unopposed, applications the comptroller decides in the first instance, and his decision is subject to appeal to the Board of Trade, who may, however, refer the appeal to the court (see notes under s. 62 (4) (5), *ante*, pp. 380, 381).

As to the power of the Board of Trade in these matters, see s. 102A, *post*.

The comptroller has, under sub-s. 5, power to award costs to the opponent where an application is abandoned after notice of opposition; but except in that case no provisions are made by this Act or the Act of 1888 as to the costs of proceedings before the comptroller or the Board of Trade.

Appeal referred to the court.

When the appeal is referred to the court, the court has no power to amend the notice of opposition (*a*).

The practice when the appeal is referred to the court is to move that the comptroller be directed to register the mark (*b*).

When the Board of Trade on the reference to the court directed that the parties should be at liberty to adduce such evidence as they might be advised, it was held that the motion should be heard in the ordinary way on affidavit evidence, but that if the parties desired to use the statutory declarations used before the comptroller, they might do so on verifying them by affidavit (*c*).

If, however, there has been no such direction by the Board of Trade, the case must, it would seem, be heard on the declarations, but the court, if dissatisfied, would give further directions and see the matter tried out (*d*).

A later form adopted by the Board of Trade in orders of reference to the court has been to state that the parties should be "at liberty to adduce such evidence by affidavit examination or cross-examination of witnesses, and otherwise as the court may see fit to direct or permit, in addition to the statutory declarations used before the comptroller, which for this purpose are, if necessary, to be verified by affidavit" (*e*).

This form of reference necessitates an application to the court for directions, and on such an application the court has given leave to the parties to file affidavits, and directed the motion to be heard on the

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(*a*) *Robertson, Sanderson & Co.'s Application*, [1892] 2 Ch. 245.

(*b*) See statement of case, *Meyerstein's Application*, 7 R. P. C. 115.

(*c*) *Farrow's Trade Mark*, 7 R. P. C. 260.

(*d*) *Farrow's Trade Mark*, *ubi supra*.

(*e*) *Roger's Trade Mark*, 11 R. P. C. 637.

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evidence mentioned in the order of the Board of Trade, and the affidavits (*f*). And cross-examination being desired, the motion was ordered to be set down in the witness list.

Note.

Sub-s. (4) in its original form was held not to be confined to questions as between the applicant and opponent, but the court might, where a mark had been registered, determine the question whether it was properly admitted to registration (*g*).

The court has no power to judicially amend an application by directing the registration only of the parts of the proposed trade mark which are within the definition "essential particulars" in s. 64 (*h*). And, therefore, where a proposed trade mark contained a key and the words "Geneva Key Brand," the court refused to register the key alone (*i*).

In order that declarations used before the comptroller may be used before the court on the appeal, each declaration must be verified by an affidavit of the declarant himself (*j*).

Security for costs.

A foreign applicant resident out of the jurisdiction may be ordered to give security for the costs of the opponents; and where the order (*k*) provided that until the security should be given the applicant should not take any further proceedings in the matter against the opponents, and the security was not given, it was, upon the application of the opponents, ordered that the security should be given within seven days, and that in default the application should be dismissed with costs without further order. Such an order can and ought to be made on summons in chambers (*l*).

Time for appeal.

When an appeal from an order giving leave to register a mark was not brought within the twenty-one days prescribed by Order LVIII., r. 15, Supreme Court Rules, 1883, the Court of Appeal gave special leave to appeal upon the appellants undertaking not to take proceedings to rectify the register under s. 90 upon the ground of the mark being improperly upon the register (*m*).

Costs of Opposition.

Where on an opposition to registration of a trade mark in different classes the applicant succeeds as to some and fails as to others, no costs are given on either side (*n*). But an unsuccessful opponent must pay

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(*f*) *Roger's Trade Mark*, 11 R. P. C. 637.

(*g*) *Re Arbenz's Application*, 35 Ch. D. 248; 4 R. P. C. 144.

(*h*) *Meeus' Application*, [1891] 1 Ch. 41.

(*i*) *Meeus' Application*, *ubi supra*.

(*j*) *Kingsford and Sons' Application*, 15 R. P. C. 197.

(*k*) *Härter's Trade Mark*, W. N. (1887), 71.

(*l*) *Härter's Trade Mark*, *ubi supra*.

(*m*) *Arbenz's Application*, 35 Ch. D. 257.

(*n*) *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639; Seb. Dig., p. 377; *Re Rosing*, Seb. Dig., p. 379.

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NOTE.

the costs, even though the opposition is by a public body in the public interest (*o*). And an application to rectify the register which failed was dismissed with costs, including the costs of the registrar (*p*).

In *Re Anderson's Trade Mark* (*q*) the costs of a successful opposition were given to the opponent, except the costs of charges of fraud, which failed, and which costs were ordered to be paid by the opponent.

And where opposition to the registration of a mark, consisting of a distinctive device in combination with certain words which had been also used by the opponent, was continued after the applicant had, subsequently to the application, offered to disclaim any right to the exclusive use of the words, it was held that down to the time of the offer the opponent was right, but that afterwards he was wrong, and no order was made as to costs (*r*).

Under the repealed sub-sections the court had no jurisdiction to make any order as to costs incurred previously to the matter coming before it (*s*).

If an application is abandoned after notice of opposition, the costs of opposition may, under sub.-s (5) be ordered to be paid by the applicant.

Assignment and transmission of trade mark.

70. A trade mark, when registered, shall be assigned and transmitted (*t*) only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

This section is substantially a re-enactment of the corresponding part of s. 2 of the Act of 1875.

It is settled by a series of cases that both trade marks and trade names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm that originally established them, even though the names of that firm be changed so that they are no longer strictly correct (*u*). But, in order that the new firm may be registered as owners, the provisions of this section must be complied with (*x*). The right, however, to use a

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(*o*) *Re Roring, ubi supra.*

(*p*) *Re Riviere's Trade Mark*, 26 Ch. D. 48.

(*q*) 26 Ch. D. 409, 416, on appeal 54 L. J. Ch. (N.S.) 1084.

(*r*) *Swift Specific Co.'s Trade Mark*, 6 R. P. C. 352.

(*s*) *Re Australian Wine Importers, Limited*, 41 Ch. D. 278.

(*t*) See T. M. R. *post*, rr. 36—40.

(*u*) *Per* Lord BLACKBURN, *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 33, citing *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Millington* v. *Fox*, 3 My. & Cr. 338. See also *Bury* v. *Bedford*, 4 De G. J. & S. 352.

(*x*) See *Re Bryant and May, Ltd.*, 4 Times R. 675.

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NOTE.

name as property in itself and unconnected with any business cannot be validly assigned so as to confer rights against the public (*y*).

"**In connection with the good-will.**"—A trade-mark can only be assigned when it is transferred together with the manufactory of the goods to which the mark has been used to be affixed (*z*).

And when foreign manufacturers of cigars, which they sold under a particular name, sold the right to use the label to a firm in England, but sold no part of the business, it was held that the assignment was bad and that the English firm could not bring an action for infringement (*a*).

The words of the section, however, are very wide and ought not to be construed narrowly (*b*). And therefore, where an American firm, makers of anti-friction metal, registered a trade-mark for anti-friction metal bearings,—and it appeared that, though they sold no bearings in this country, but only the metal in ingots, a main object of their business here was the use of the metal for bearings, and that they dealt in bearings in America,—it was held that an assignment by them of the trade-mark with the good-will of their business was a sufficient assignment within the section, and that the assignee was entitled to be registered (*c*).

And the assignment of the trade marks need not be contemporaneous with the assignment of the goodwill (*d*); and when the goodwill of the business has always been vested in the person to whom the trade mark is assigned, the requirements of the section are satisfied. Thus, where the agents of a foreign firm registered in their own name, but for the benefit of their principals, the trade marks of the latter (which trade marks had only been used in connection with the business of the foreign firm carried on in England by the agents), and afterwards assigned the trade marks to the then members of the foreign firm, through whom the present members of the firm claimed, it was held that the trade marks had been transmitted in connection with the goodwill of the business of the foreign firm within the meaning of this section (*e*). See also form K, *post*, in the Second Schedule to the Trade Marks Rules, where the person desiring to register is only required to show that he is entitled to the trade mark and to the goodwill.

(*y*) *Thorneloe* v. *Hill*, [1894] 1 Ch. 569.

(*z*) *Per* BRETT, M.R., *Pinto* v. *Badman*, 8 R. P. C. 181, 194.

(*a*) *Pinto* v. *Badman*, *ubi supra*.

(*b*) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371.

(*c*) *Magnolia Metal Co.'s Trade Marks*, *ubi supra*.

(*d*) *Re Wellcome's Trade Mark*, 32 Ch. D. 213, 217.

(*e*) *Re Wellcome's Trade Mark*, 32 Ch. D. 213. See also *Re Farina*, 29 W. R. 391, 393; *Hammond* v. *Brunker*, 9 R. P. C. 301.

Sect. 70.

NOTE.

The assignee of a trade mark with goodwill was held, under the Act of 1875, to be only entitled to the exclusive user of the trade mark in respect of the goods for which it had been used, although it was registered for the whole class, and had been on the register five years (*f*).

A son who, while in his father's employment, learnt a trade secret for the manufacture of a particular article, and after the father's death made the article and sold it under the old name, was held to have acquired no title to the name as a trade mark (*g*).

"**Determinable with that goodwill.**"—See *Ralph's Trade Mark* (*h*).

Conflicting claims to registration.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court (*i*).

"**Proprietor of the same trade mark.**"—Where two persons had used the same mark independently and *bonâ fide* for several years, the mark was registered in both names (*j*). And an outgoing partner who was entitled to use the original mark was allowed, under the Act of 1875, to register this mark, although it was identical with the mark on the register used by the successors of the old firm (*k*)

Under the Act of 1875 three identical marks, with in each case the words "sparkling sherry," and the name of the particular firm, were registered in the same class on the joint application of the three firms (*l*).

But under the present Act in *Re Ehrmann's Trade Marks* (*m*) when on a dissolution of partnership the continuing partners and the outgoing partner agreed to form separate firms with liberty to each to use the trade marks of the old firm, it was held that the comptroller was justified in refusing in his discretion to register the marks (all of which were new marks) in the respective names of the two new firms.

Where a trade mark, which had been acquired by use by a trader but had not been registered, had been discontinued, though not abandoned,

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(*f*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*g*) *Horenden* v. *Lloyd*, 18 W. R. 1132.

(*h*) 25 Ch. D. 194.

(*i*) This is to be by special case. T. M. R., rr. 42—45.

(*j*) *In re Powell*, *In re Pratt*, Seb. Dig., p. 357.

(*k*) *Benbow* v. *Low*, 29 W. R. 837. See also *Dent* v. *Turpin*, 2 J. & H. 139.

(*l*) *Re Vergaras*, cited 30 Sol. J. 415.

(*m*) 14 R. P. C. 665.

and in the meantime another trader had adopted and registered the same mark, but without the knowledge or acquiescence of the first trader, and in ignorance of his mark, it was held that the latter was entitled to register his mark, and that the second trader was also entitled to retain his registration (*n*). Sect. 71 — Note.

But apparently the importation of goods with a distinctive label for the purpose of transhipment only would not be sufficient user to acquire a title (*o*).

Where a person had applied to be registered as proprietor of the same trade mark as one already on the register, a motion on behalf of the registered holder for an injunction restraining an alleged infringement of the registered mark by the applicant was ordered to stand over till after the result of the application to register was known (*p*).

The mere proof that a person has used, without interference, a trade mark which is claimed by another, does not of itself entitle to registration, since the original proprietor may not have known that it was being so used (*q*).

Cases of opposition founded on rival claims to the same trade mark will, it would appear, still be dealt with by the court under this and the following section, notwithstanding the provisions of the new sub-ss. 3 and 4 of s. 69 *ante*, p. 412.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods. Restrictions on registration.

(2.) The comptroller shall not register with respect to the same goods or description of goods a trade mark *so nearly resembling* a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

By s. 14 of the Act of 1888, sub-s. 2 of this section is amended as follows :—

In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of

(*n*) *Mouson* v. *Boehm*, 26 Ch. D. 398.

(*o*) *Meeus' Application*, [1891] 1 Ch. 41.

(*p*) *Edwards* v. *Elkan*, 5 R. P. C. 71.

(*q*) *Re Farina*, 27 W. R. 456; *Re Hudson & Co.*, cited 30 Sol. J. 415.

Sect. 72 (2). the sub-section, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

This section, both in its original and amended form, materially differs from the corresponding section of the Act of 1875, under which the registrar was forbidden to register, in respect of the same goods or *classes* of goods, marks identical with marks on the register, or so nearly resembling as to be calculated to deceive.

But the court has a discretion to determine whether, although the case is not within the words of this section, the registration is one which ought to be directed (*r*).

SUB-SECTION 1.

"Already on the register."—On the question of similarity, the court has regard only to marks which have been registered, and not to pending applications (*s*).

Sub-division of classes: "three mark" rule.

"Same goods or description of goods."—Under the Rules of August, 1876, sub-division of classes was allowed (*t*); but the registrar would not register the same mark in respect of more than three descriptions of goods of the same class, whether the mark were new or old (*u*); and this was enforced even where the articles on which the mark was to be used, though in the same class, were different in character from the goods for which the mark was already registered (*x*). Subject, however, to this rule, a new mark might be registered for some of the goods in a class, though a similar old mark had already been registered for other goods in the same class, provided that the goods and trades were sufficiently distinct for no confusion to take place (*y*), and old marks might be registered up to the number of three by different persons in respect of the same goods, even if identical (*z*); and this rule is still followed by the court (*a*).

Thus, a device of a pointer eating out of a porridge-pot was registered as a new mark for "fencing" in Class 5, and as an old mark for

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(*r*) *Re Australian Wine Importers and Mason*, 41 Ch. D. 278, 286.

(*s*) *Re Dugdale's Application*, 49 L. J. (N.S.) Ch. 303.

(*t*) *Ex parte Barrow & Co.*, W. N. (1877), 119; *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639, n.

(*u*) *Re Walkden Aerated Waters Co.*, 54 L. J. (N.S.) Ch. 395, n; *Re Hyde & Co.'s Trade Mark*, 54 L. J. (N.S.) 395, n; *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639, n.

(*x*) *Re Hargreaves*, 11 Ch. D. 669.

(*y*) *Re F. Braby & Co.*, 21 Ch. D. 223; *S.C.* 51 L. J. (N.S.) 637; *Ex parte Barrow & Co.*, W. N. (1877), 119.

(*z*) *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639, n.

(*a*) *Re Bancroft & Co.'s Trade Mark*, 5 R. P. C. 209.

"screw wrenches," etc., in Class 13 (metal goods not included in other classes), though a device of a pointer standing at a pail, with the word "Stanch" under, was on the register as an old mark in Class 5, for "unwrought metals used in manufacture," and in Class 13 *generally* (*b*).

And the mark "T. H. H." under a crown was held entitled to registration as an old mark for tin plates and iron plates, though another firm had a mark in the same class, "B. B. H." over a crown, for bar iron (*c*). So, also, a new mark, consisting of a device of a rising or half sun, was registered for galvanized iron, although there was an old mark on the register of a sun for bar iron in the same class (*d*).

But to entitle an old mark to registration under the "three mark rule," the user must have been in England (*e*).

A mark may be registered as an old mark even though so similar to a mark already on the register that if new it would have been refused registration (*f*).

Where the mark had been used by one or two persons as an old mark, it could not be registered by another person as a new mark for the same goods, except with the consent of the prior owner or owners (*g*).

In deciding whether two sets of goods are of the same "description," too much stress must not be laid on the classification in the schedule to the Trade Marks Rules. The question must be looked at from a business point of view (*h*).

"**Identical.**"—It has been said that the test of two marks being identical is that they so closely resemble one another that the use of one might be restrained in an action by the owner of the other (*i*).

Under this section, where there already is a trade mark on the register either the same as or nearly identical with one proposed to be registered, the comptroller is justified in refusing to register the latter without the leave of the court (*k*).

Although identical marks are not to be registered for the same goods, or description of goods, unless the court has first decided that two or

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(*b*) *Re Jelley, Son, and Jones, ubi supra.*

(*c*) *Ex parte Barrow & Co.*, W. N. (1877), 119.

(*d*) *Re F. Braby & Co.*, 21 Ch. D, 224; *S.C.* 51 L. J. (N.S.) 637.

(*e*) *In re Münch's Application*, 50 L.T. (N.S.) 12; *Jackson* v. *Napper*, 35 Ch. D. 162, 177; and *In re Meeus' Application*, [1891] 1 Ch. 41.

(*f*) *Re White Rose Trade Mark*, 30 Ch. D. 505.

(*g*) *Re Walkden's Aerated Waters Co.*, 54 L. J. (N.S.) Ch. 395, n. See now *Dewhurst's Trade Mark*, [1896] 2 Ch. 137.

(*h*) See *per* LINDLEY, L.J., *Re Australian Wine Importers, Ltd.*, 41 Ch. D. 284, 291; see also *Turney and Sons Trade Mark*, 11 R. P. C. 37.

(*i*) *Re Walkden's Aerated Waters Co.*, 54 L. J. (N.S.) Ch. 395, n.

(*k*) *Per* PEARSON, J., *Re Price's Patent Candle Co.*, 27 Ch. D. 681.

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more persons are entitled to the mark, there appears to be no reason why identical marks should not, subject to the provisions of s. 74 (3), *post*, still be registered in respect of different descriptions of goods in the same class, as was provided for by Rule 20 of the Rules of March, 1883, under the Act of 1875; and if the descriptions of goods in the same class be sufficiently dissimilar not to be within s. 74 (3), it would seem that more than three identical marks might be registered in the same class.

SUB-SECTION 2.

"**Having such resemblance to.**"—These words would appear to give a wider discretion to the comptroller than the words "so nearly resembling," which were contained in the section as it originally stood.

"**Calculated to deceive.**"—The words mean a mark calculated to deceive when that mark, fairly used, is so like a mark on the register also fairly used, as that one is likely to be mistaken for the other (*l*). The court looks to the nature of the goods, nature and size of mark, mode of fixing, and probable result in practice (*m*), and has regard to the mark, not merely as it is registered, but as it will probably be used in the course of trade (*n*), and will not consider what might be done by a fraudulent user (*o*).

Where there was on the register as a mark for beer a plain triangle coloured red, registration was refused to a triangle with a double outline inscribing within the name of the brewery, the inner triangle having a conspicuous figure of a church; the ground of decision being that, as the latter might be printed in a red colour, it would, if so printed, be too similar to the other mark (*p*). So, also, where a male hand pointing upwards was on the register as a trade mark, the registration of a female hand pointing horizontally with letters on it was not allowed (*q*).

And where there was on the register the device of a bull's head as a mark for mustard, the registration of a buffalo's head for the same goods was refused (*r*).

(*l*) *Per* FRY, L.J., *Lyndon's Trade Mark*, 32 Ch. D. 121 (see also judgment of BOWEN, L.J., in the same case); *Haines, Bachelor & Co.'s Trade Mark*, 5 R. P. C. 663; *Lambert's Trade Mark*, 6 R. P. C. 344, 351.

(*m*) *Re Rosing*, 54 L. J. Ch. 975.

(*n*) *Worthington's Trade Mark*, 14 Ch. D. 15; *Christiansen's Trade Mark*, 3 R. P. C. 55, 59.

(*o*) *Lambert's Trade Mark*, 6 R. P. C. 344, 351, (COTTON, L.J.); *Kutnow's Trade Mark*, 10 R. P. C. 401.

(*p*) *Re Worthington & Co.'s Trade Mark*, 14 Ch. D. 8.

(*q*) *Allsopp* v. *Walker*, Seb. Dig., p. 325.

(*r*) *Farrow's Trade Mark*, 7 R. P. C. 260.

Sect. 72 (2). NOTE.

And where a new mark for matches was very similar to an old mark subsequently registered, both marks having representations of lamp shades, which in the new mark as registered were blank, while in the old mark as registered they were filled up with representations of prize medals, and it was proved that in practice the new mark was never used with the lamp shades in blank, but always with medals in the blanks, the new mark was expunged from the register on the motion of the owners of the old mark (*s*).

And where there was a registered trade mark for cherry brandy consisting of a hunting scene with the word "Sportsman," under which the article had become known as "Huntsman Cherry Brandy," a trade mark of a rival trader with a different hunting scene, and the word "Huntsman" instead of "Sportsman," was ordered to be expunged from the register (*t*).

And where the word "Sanitas" as part of a sentence was already on the register in respect of two different marks for medicine, the registration of "Sanitas" by itself as a mark for medicine was not allowed (*u*).

And a mark consisting of a sheep suspended by a band with the words "Golden Fleece," was refused registration in connection with wines, there being on the register similar marks of another tradesman having after the above words the words "rum" and "whisky" (*x*).

Where the words "Pirie's Parchment Bank" were on the register as a trade mark for paper, an application by a rival trader to register the device of a heart in combination with a number of words which included the words "Parchment Bank," was refused (*y*).

But the combination of a signature with the words "Filtre Rapide" was registered, although the words "Rapid Water Filter" were already on the register (*z*). And where there was on the register a mark having in a prominent part the words "Unco Guid," which were disclaimed, it was held that a mark having the same words (also disclaimed), and a quite distinct device, was not calculated to deceive (*a*).

Where A. had registered a coat of arms and a medallion as part of his mark, and B. proposed to register the medallion and arms alone, the latter was considered sufficiently distinctive, and was registered, as

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(*s*) *Christiansen's Trade Mark*, 3 R. P. C. 55. See also *Biegel's Trade Mark*, 4 R. P. C. 525.

(*t*) *Barker's Trade Mark*, 53 L. T. (N.S.) 23.

(*u*) *Sanitas Co.'s Trade Mark*, 4 R. P. C. 533.

(*x*) *Re Australian Wine Importers and Mason*, 41 Ch. D. 278. See also *Turney and Son's Trade Mark*, 11 R. P. C. 37.

(*y*) *Goodall's Trade Mark*, 42 Ch. D. 566.

(*z*) *Re Maignen*, 28 W. R. 759.

(*a*) *Loftus's Trade Mark*, [1894] 1 Ch. 193.

Sect. 72 (2) the simple medallion and arms could not be taken to be the same as A.'s compound mark (*b*).

NOTE. And where there was on the register a mark consisting of a man's head with "way" beneath, which had become known as the "Headway" mark, another mark consisting of a helmeted head with the word "Athena" underneath, both marks being intended to be stamped on the goods, was allowed to be registered, it being considered that if both marks were fairly used the latter mark did not so resemble that on the register as to be calculated to deceive (*c*).

Concurrent user. So, also, where it was shown that a mark consisting of a pipe and dart had been used on cutlery for many years, and a mark of a pipe had also been used on cutlery of the same description for the same time and without any evidence to show that one had been mistaken for the other, a motion by the owner of the pipe mark to expunge the other from the register was refused, although it was possible that by unfair stamping the dart might be made not to appear on the goods of the owner of the pipe and dart mark, no fraud, however, being suggested (*d*).

And where there were on the register several marks for tobacco, registered by different manufacturers, of which the word "star," or the device of a star, formed part, it was held that the registered owner of a mark consisting of an eight-pointed star, whose goods were frequently ordered by the public as "star" goods, could not successfully oppose the registration of a new mark containing the words "Star of Hope" and a marine picture with a six-pointed star in the sky (*e*).

But the circumstance that the mark sought to be registered and the registered mark have for some years been used independently by rival traders, and no deception has occurred, will not be taken into account if the court is of opinion that the registration proposed is, in fact, calculated to deceive (*f*).

Words expressing a registered device. Words which express to the ear what a device already on the register expresses to the eye are "calculated to deceive," and will not be registered. Thus, where there was on the register the device of a star as a trade mark for window glass, a subsequent registration by rival traders of the words "Red Star Brand" for the same article was expunged (*g*).

(*b*) *Re Farina*, 26 W. R. 261.

(*c*) *Lyndon's Trade Mark*, 32 Ch. D. 109. See also *Haines, Bachelor & Co.'s Trade Mark*, 5 R. P. C. 669.

(*d*) *Lambert's Trade Mark*, 6 R. P. C. 344. See also *Talbot's Trade Mark*, 11 R. P. C. 77, 81.

(*e*) *Wills's Trade Marks*, [1893] 2 Ch. 262.

(*f*) *Currie & Co.'s Application*, 13 R. P. C. 681.

(*g*) *Re La Société Anonyme des Verreries de l'Etoile*, [1894] 2 Ch. 26.

So, also, where there was on the register the device of a golden fan, the registration of words in Burmese characters which meant "Golden Fan Brand" was refused (*h*). Sect. 72 (2). NOTE.

Resemblance of essential parts to be considered.

And where the essential part of a mark proposed to be registered so nearly resembled the essential part of a mark already registered as to be calculated to deceive, registration was refused, although the mark as a whole was different in appearance from the registered mark, and although the applicants offered to undertake to use it always in its present form (*i*).

In deciding questions under this sub-section, as between two marks, the comptroller may take into consideration the ordinary course of trade (*k*).

In *Re Farina* (*l*) it was said by HALL, V.-C., on an opposition under the Act of 1875 by the owner of a mark already on the register, that the question whether registration should be refused or not depended on whether the party opposing registration would, independently of the Trade Marks Registration Act, have been entitled to restrain the use of the proposed mark by the applicant.

Comptroller's discretion.

But there may be cases in which the similarity would not be such as to induce the court on that fact alone to grant an injunction, but in which the comptroller would still be entirely within his duty in saying that the marks so nearly resemble one another that he will not, by allowing the registration, encourage the use of a mark which may lead to litigation (*m*).

It is a reasonable exercise of the comptroller's discretion to refuse to register a trade mark when it is not clear that deception might not result (*n*).

The applicant must justify the registration by showing affirmatively that the proposed mark is not calculated to deceive. *In dubio*, the application ought to be disallowed (*o*).

The question whether the mark is calculated to deceive is purely one of fact. And if the English court thinks the mark objectionable on this ground, registration will be refused, although a foreign Court of Appeal, differing from the Court of First Instance, has allowed the mark to be registered, the foreign decisions being regarded merely as

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(*h*) *Dewhurst's Trade Mark*, [1896] 2 Ch. 137.

(*i*) *Murphy's Trade Mark*, 7 R. P. C. 163; *Currie & Co.'s Application*, 13 R. P. C. 681.

(*k*) *Speer's Trade Mark*, 4 R. P. C. 521.

(*l*) 26 W. R. 251.

(*m*) *Per* KAY, J., *Speer's Trade Mark*, 4 R. P. C. 521. See also *Heaton's Trade Mark*, 27 Ch. D. 570, 582; *Re Australian Wine Importers*, 41 Ch. D. 278.

(*n*) *Eno* v. *Dunn*, 15 App. Cas. 252, 262.

(*o*) See *per* Lord WATSON, *Eno* v. *Dunn*, 15 App. Cas. 257. See also *per* Lord HERSCHELL, *ibid.* 262.

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opposite verdicts of juries (*p*). And this question does not depend merely on evidence, but the court will look at the marks themselves and form its own opinion (*q*). Thus, where a Sheffield corporate mark for cutlery and metal goods consisted of a plain horn suspended by a looped cord, a mark being a sprig of two roses and a twisted horn was considered too similar, especially when stamped on the metal, to be admitted to registration in the same class (*r*).

Where certain marks are cited by the comptroller as *primâ facie* calculated to deceive it is frequently the practice to supply consents from the owners of the registered marks. These may be received by the comptroller as evidence that the marks will not clash, or as evidence that the goods are not of the same description, though these consents do not in any way bind the comptroller to put the mark on the register (*s*).

Practice on applications to register "identical" marks.

It will be observed that the comptroller has no jurisdiction in any case to register a mark identical with one already on the register for the same goods or description of goods. Where the mark applied for is an "old mark" the course is to get the comptroller formally to refuse registration, and then to appeal to the Board of Trade from his refusal, requesting the Board of Trade to refer the appeal to the court.

The Board of Trade by the order for reference directs notice to be served on the comptroller and on the owners of the conflicting marks. See order in *H. J. Neill's Trade Mark*, *No.* 1, Appendix, *post*, and see *Bancroft's Trade Mark* (*t*).

The court can then on the appeal exercise its jurisdiction on such terms as it thinks fit. *Primâ facie* the court will, subject to the "Three Marks Rule," direct an "old mark" to be registered as of course.

The practice is the same in the case of new marks which are refused by the comptroller, but it is much more difficult, if not impossible, to induce the court to direct the registration of a "new" mark identical with one already on the register (*u*).

Where, on an application to register a mark for particular goods in a class, the comptroller refused on the ground that for other goods of the same class there was a mark on the register which too nearly resembled the applicant's mark, the application was with the consent of the owners of the registered mark allowed to proceed upon the undertaking of the applicant not to use his mark for the goods in respect of which the existing mark was registered (*x*).

(*p*) *Re Farina*, 27 W. R. 457.

(*q*) See judgment of JESSEL, M.R., *Re Jelley, Son and Jones*, 51 L. J. Ch. (N.S.) 640, n.; and judgment of Lord ESHER, M.R., *Re Christiansen's Trade Mark*, 3 R. P. C. 55, 60.

(*r*) *Re Rosing*, 54 L. J. Ch. 975.

(*s*) See *Re Dewhurst's Trade Mark*, [1896] 2 Ch. 137.

(*t*) 5 R. P. C. 209; *Kenrick and Jefferson's Trade Mark*, 7 R.P.C. 321.

(*u*) See *Re Hargreaves*, 11 Ch. D. 669.

(*x*) *Kenrick and Jefferson's Trade Mark*, 7 R. P. C. 321, Seton, 1991.

When the comptroller refused to register on the ground that there was a similar mark on the register belonging to a foreign company, and the applicant moved for an order to the comptroller to proceed, and gave full information by letter to the foreign company of the nature of the application, and the latter did not appear, although there was evidence that they had received the communication, the comptroller was directed to proceed without prejudice to any opposition, the applicant undertaking to give full notice to the foreign company of the advertisement (*y*).

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As to proceeding with the registration of an old mark with consent of the registered owner of conflicting marks, and with disclaimer of exclusive use of particular devices used by other persons, see the order in *H. J. Neill's Trade Mark, No.* 2, Appendix, *post*, and see also under s. 74.

Where a trade mark has been invented for a joint adventure by two or more parties it does not, in the absence of contract, after the termination of the joint adventure belong exclusively to any of the parties (*z*); and even if there were a contract that the trade mark should become the property of one of the parties, it is doubtful whether it could be registered in his name, as such a registration would be calculated to deceive (*a*).

Trade mark invented for joint adventure.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the *exclusive* use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

Further restriction on registration.

By s. 15 of the Act of 1888 this section is amended by the omission from it of the word "exclusive." In its original form the section was a re-enactment of the latter part of s. 6 of the Act of 1875.

Further restrictions on registration will be found in s. 86, and the notes to that section (*post*, p. 458.)

"By reason of their being calculated to deceive," etc.—In *Re Horsburgh's Trade Mark* (*b*), it was said by JESSEL, M. R., in reference to the corresponding section of the Act of 1875, that "the deception in the Act of Parliament refers to the words themselves being calculated to deceive, not to deception being occasioned because they are like another trade mark. . . . . It is not competition between two marks to which reference is made; what is meant is, a thing deceptive in itself—something representing the goods to be that which they are not for the

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(*y*) *Stringer's Application*, 8 R. P. C. 445. And see also *Kenrick and Jefferson's Trade Mark*, 7 R.P.C. 321.

(*z*) *Robinson* v. *Finlay*, 9 Ch.D. 487.

(*a*) *Re Jones' Trade Mark*, 53 L. T. (N.S.) 1.

(*b*) 53 L. J. Ch. 237.

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purpose of deception." And therefore an opposition by oil merchants, owners of a mark being a device containing the word "Valvoline," to the registration of another different device with the word "Valvoleum," on the ground that the similarity of the two words was calculated to deceive, was not allowed to prevail.

But ss. 72 and 73 point to this, that registration ought not to be allowed if the court in its discretion should think the mark would be calculated to deceive (*c*), and the judgments in the House of Lords in the case of *Eno* v. *Dunn* (*d*) seem to show that under the present Act the comptroller's discretion is not limited as suggested in *Re Horsburgh's Trade Mark*.

In *Eno* v. *Dunn*, cited above, (a case under the present section as it stood before the Act of 1888), where it was shown that the words "fruit salt" had been for many years used on a well known medical preparation, it was held by the House of Lords (Lord HALSBURY, L. C., and Lord MORRIS, *diss.*), on an application to register the words "fruit salt baking powder," that the registration of the applicant's words would be calculated to deceive, and they were accordingly refused registration. And it was said that the comptroller ought to reject words which involve a misleading allusion or a suggestion of that which is not strictly true as well as words which contain a gross and palpable falsehood (*e*).

And where the word "Coco" had been used in connection with cotton goods, but not as a trade mark, the registration of the words "Kokoko" as a trade mark for the same class of goods was refused (*f*).

Where, however, the words sought to be registered consisted partly of the applicants' name, the mere circumstance that the opponent of the same name had used the same combination of words, there being no evidence that the goods sold by the applicants were being sold as those of the opponent, was held not sufficient to justify the refusal of the registration (*g*).

"Be deemed disentitled to protection," etc.—If there is false representation in the mark, or if the trade itself is fraudulent, a Court of Equity will not interfere for its protection. And it was said by MELLISH, L. J., that the same would be the rule at common law, and that the case would come within the maxim *Ex turpi causâ non oritur actio* (*h*). The first of these cases is that alone which is dealt with in

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(*c*) *Per* COTTON, L.J., *Re Australian Wine Importers and Mason*, 41 Ch. D. 284. And see also *Re Grossmith's Trade Mark*, 6 R. P. C. 180, 183, and *Eno* v. *Dunn*, 15 App. Cas. 252.

(*d*) 15 App. Cas. 252.

(*e*) *Per* Lord MACNAGHTEN, *Eno* v. *Dunn*, 15 App. Cas. 263.

(*f*) *Re Jackson & Co.'s Trade Mark*, 60 L. T. (N.S.) 93.

(*g*) *Swift Specific Co.'s Trade Mark*, 6 R. P. C. 352.

(*h*) *Ford* v. *Foster*, L. R. 7 Ch. 611, 630, 631. See, however, observations by VAUGHAN WILLIAMS, L. J., *Jamieson* v. *Jamieson*, 15 R. P. C. 169, 191.

this section. Cases in which the trade itself is fraudulent will be considered under s. 77. Sect. 73.

As to fraudulent representation in the mark itself— NOTE.

In *Pidding* v. *How* (*i*) plaintiff was refused relief in respect of certain tea which he sold in packets labelled "Howqua's Mixture," Howqua being a celebrated Chinese merchant, and it being proved that plaintiff's tea was neither made nor sold by Howqua. False representation in the mark itself.

Where the plaintiffs had succeeded to the business of a firm of J. R. and C. P. Crockett, who were manufacturers of leather cloth, but plaintiffs did not themselves carry on business in that name, the insertion on the trade mark of the words "J. R. and C. P. Crockett, Manufacturers," was held to be a misrepresentation disentitling the plaintiffs to relief. So, also, the insertion in the mark of the words "Tanned, patented," where the mark was used for goods neither tanned nor patented (*k*).

And where a company claimed to use the words "Anglo-Portugo Oysters" upon a trade mark for oysters, whether the oysters were or were not brought from Portugal and fattened in English waters, as had been the case with the oysters in connection with which the name was first used, registration was refused (*l*).

And where a trade mark contained the words "sole makers," and the persons registering the mark were not in fact the "sole makers" of the article, the registration was ordered to be expunged (*m*).

So, also, the words "H.'s coker canvas" were not considered a proper old trade mark, it being shown that though goods were asked for as "coker canvas" or "Hayward's coker canvas," the latter three words were never stamped on the goods, and it being also shown that a former partner named H. was also carrying on business and selling "coker canvas" (*n*).

And where a trade mark comprising amongst other things two shields had been registered by the plaintiff with the centres of the shields blank, and was used by the plaintiff having the blanks filled in with words which the court held to convey a misrepresentation, an injunction was refused (*o*).

Where a trade mark has been invented for a joint adventure by two persons, one of them cannot after the determination of the joint adventure register it as his own, whether there is or is not a contract for that purpose, as such a registration might mislead the public (*p*).

(*i*) 8 Sim. 477.

(*k*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. 523.

(*l*) *Re Saunion & Co.*, Seb. Dig., p. 331. See also a case of guano made in England sold as "Peruvian guano," mentioned in the judgment of MELLISH, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. 631.

(*m*) *Hayward's Trade Mark*, 54 L. J. Ch. 1003.

(*n*) *Hayward's Trade Mark*, *ubi supra*.

(*o*) *Newman* v. *Pinto*, 4 R. P. C. 508.

(*p*) *Re Jones' Trade Mark*, 53 L. T. (N.S.) 1.

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Where the registered mark has been fraudulently used, as where registered owners of the word "Eton" for cigarettes sold "Eton" cigarettes in boxes so labelled as to denote manufacture at St. Petersburg by a Russian firm (*q*), an injunction at the suit of such registered owners was refused, and the mark was on the application of the defendants in the action expunged from the register. But this was held not to apply in a case where, although the goods were not made by the owner of the mark, it was used in such a way as only to imply that they were sold by him (*r*).

Where the user of the mark had its inception in fraud and was calculated to deceive, registration was refused, though the mark had actually been used by the applicants for fifty years, and the court did not impute to the present applicants for registration any intention to commit fraud (*s*). And where the mark had been used with a fraudulent addition, implying an untruth as to the place of manufacture, the court refused to allow it to be registered *minus* the fraudulent addition (*t*).

But the use of the word "Habana" on boxes of cigars, with the words "British manufacture" (*u*), was held not to vitiate the registration. And the mere use on a label of the word "registered," with a number, does not imply that it is registered as a trade mark, or constitute such a deception as to disentitle the plaintiff to sue (*x*).

So, also, where it was shown that a medicinal preparation sold as "Syrup of Figs," though it was not entirely composed of fig syrup, contained that article as a large factor in its composition and added the flavouring, an objection that plaintiff was not entitled to relief failed (*y*).

If the wrongful representation on the trade mark has been abandoned before action, the plaintiff may be entitled to relief (*z*).

Use of the word "patent."

The question of deceptiveness in the mark itself has most commonly arisen on the use of the word "patent" or "patented," or the like, in the trade mark.

If the article had never been patented, the use of the word "patent" or "patented" on the mark was held to disentitle the plaintiff to relief (*a*), unless from the usage of many years the goods have acquired

(*q*) *Wood* v. *Lambert*, 32 Ch. D. 247.

(*r*) *Wills's Trade Marks*, [1893] 2 Ch. 262.

(*s*) *In re Heaton's Trade Mark*, 27 Ch. D. 570.

(*t*) *Fuente's Trade Marks*, [1891] 2 Ch. 166.

(*u*) *Hargreaves* v. *Freeman*, 8 R. P. C. 237. See also *Wills's Trade Marks*, [1893] 2 Ch. 262.

(*x*) *Benedictus* v. *Sullivan*, 12 R. P. C. 25.

(*y*) *California Fig Syrup Co.* v. *Taylor's Drug Co.*, 14 R. P. C. 341, reversed on other points in C. A. 14 R. P. C. 564.

(*z*) *Benedictus* v. *Sullivan*, 12 R. P. C. 25, 32.

(*a*) *Flavel* v. *Harrison*, 10 Ha. 467; *Morgan* v. *McAdam*, 36 L. J. Ch. 228; *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 352; *Lamplough* v. *Bulmer*, W. N. (1867), 293; *Nixon* v. *Roffey*, W. N. (1870), 227. And see *Melachrino* v. *Melachrino, etc. Co.* 4 R. P. C. 215, 224.

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the designation in the trade generally of "patent" (*b*), or there was some foundation for the use of the word, as that patented machinery was used in the manufacture of the article (*c*), or that the plaintiff had registered the article as a design (*d*).

But if the article had once been the subject of a patent, and the word "patent" was used as descriptive only, relief was not refused (*e*), unless the word was used in the mark in such a manner as to imply that the patent was still subsisting (*f*); and *a fortiori* if the plaintiff's advertisements and circulars stated that he had no patent right, or the word had become merely descriptive of the article made (*g*).

In connection with this subject it must now be remembered that henceforth the use of such words where no patent has been granted may render the party using them liable to a penalty (*post*, s. 105).

If it be intended to rely on the wrongful use by the plaintiff of the word "patent," the question must be raised on the pleadings of the defendant, otherwise he will not be allowed to cross-examine plaintiff upon it at the trial (*h*). And where the question was not raised till the trial, leave to amend was refused (*i*).

In an action for infringement of trade mark to which the defendant replied by a motion to expunge the registration, it was held that the use by the defendant of the word "patented," even if unfounded, would not bar his right to resist the plaintiff's claim (*k*).

Placing the words "special registered trade mark" on a label when the mark was not, in fact, registered, though an application had been sent in for registration, was held not to disentitle the plaintiff to an injunction the object of which was the protection not of the label but of the name acquired by its use (*l*). So, also, as to the mere use of the words "trade mark" on a label, the question is whether the words are so used that a claim is wrongfully made to a particular part only (*m*).

(*b*) *Marshall* v. *Ross*, 8 Eq. 651; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. 523, judgment of Lord KINGSDOWN.

(*c*) *Cochrane* v. *MacNish*, 13 R. P. C. 100.

(*d*) *Care* v. *Myers*, Seb. Dig., p. 181.

(*e*) *Sykes* v. *Sykes*, 3 B. & C. 541; *Edelsten* v. *Vick*, 11 Ha. 78; *Leather Cloth Co.* v. *Hirschfield*, 1 N. R. 551. See also *Gridley* v. *Swinborne*, 5 Times R. 71.

(*f*) *Cheavin* v. *Walker*, 5 Ch. D. 850; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. 523. And see the Merchandise Marks Act, 1887 (50 & 51 Vict. c. 28), ss. 2 (d) and 3 (e).

(*g*) *Ransome* v. *Graham*, 47 L. T. 218.

(*h*) *Lever* v. *Godwin*, W. N. (1887), 107.

(*i*) *Ibid.*

(*k*) *National Starch, etc. Co.* v. *Munn's Patent Maizena, etc. Co.*, [1894] A. C. 275, 282.

(*l*) *Read* v. *Richardson*, 45 L. T. 54. See judgment of COTTON, L. J., p. 59.

(*m*) *Hammond* v. *Brunker*, 9 R. P. C. 301.

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"Or otherwise."—Another ground on which words have been held disentitled to protection as trade marks is that they are merely descriptive or mere indications of quality.

Descriptive words.

The words "or otherwise" in this section "are sufficient to exclude the registration as part of a trade mark of words which are merely descriptive of the article, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market" (*n*).

It will be convenient to consider these in order:

Words from their nature descriptive.

1. *Words merely descriptive from their nature*, as "Paraffin Oil" (*o*), "Nourishing Stout" (*p*), "Castle Album" (for a photograph album, with descriptive pictures of castles) (*q*).

And the words—"Anglo-Portugo Oysters" (*r*), "Porous," or "A—s Porous Plaster," as applied to a particular kind of plaster (*s*); "Reversi," as the name of a new game which depended on the player "reversing" his adversary's counters (*t*); "Emollio," as a name for a perfumery cream (*u*); "Monobrut," meaning "very dry" as a mark for champagne (*x*), have been refused registration, or struck off the register as being only descriptive.

Words which have become descriptive by usage.

2. *Words originally not merely descriptive, but which have become so by the course of the trade and in the market.*

Of these there are two classes:—

(a.) Fancy names originally applied to new articles which are patented, such as "Linoleum" (*y*), "Paraffin Oil" (*z*), "Maizena" (*a*), "Home Washer" (*b*), "Braided Fixed Stars" (*c*), "Native Guano" (*d*); or of which the first producer is for some time the sole maker, such as "Macassar" (*e*), "Golden

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(*n*) See *per* CHITTY, J., *Re Anderson's Trade Mark*, 26 Ch. D. 415; *Re Arbenz's Application*, 35 Ch. D. 248.

(*o*) *Young* v. *Macrae*, 9 Jur. (N.S.) 322.

(*p*) *Raggett* v. *Findlater*, L. R. 17 Eq. 29.

(*q*) *Schove* v. *Schwinke*, 33 Ch. D. 546.

(*r*) *Re Saunion & Co.*, Seb. Dig., p. 381.

(*s*) *Re Brandreth*, Seb. Dig., p. 382.

(*t*) *Waterman* v. *Ayres*, 39 Ch. D. 29.

(*u*) *Re Grossmith's Trade Mark*, 6 R. P. C. 180.

(*x*) *Vignier's Trade Mark*, 6 R. P. C. 490.

(*y*) *Linoleum Co.* v. *Nairn*, 7 Ch. D. 834.

(*z*) *Young* v. *Macrae*, *ubi supra*.

(*a*) *National Starch, etc., Co.* v. *Munn's Patent Maizena, etc., Co.*, [1894] A. C. 275.

(*b*) *Ralph's Trade Mark*, 25 Ch. D. 194.

(*c*) *In re J. B. Palmer's Trade Mark*, 24 Ch. D. 504.

(*d*) *Native Guano Co.* v. *Sewage Manure Co.*, 4 R. P. C. 475; 8 R. P. C. 125.

(*e*) *Rowland* v. *Breidenbach*, Seb. Dig., p. 230.

Ointment" (*f*), "Chlorodyne" (*g*), "Angostura Bitters" (*h*), "Valvoline" (*i*), "Gem" as applied to an air gun (*j*). Sect. 73.

(b.) Words connected with the name of the original maker or discoverer, such as "Velno's Vegetable Syrup" (*k*), "Dr. Johnson's Yellow Ointment" (*l*), "Taylor's Patent Solid-headed Pins" (*m*), "Burgess' Essence of Anchovies" (*n*), "Lieutenant James' Horse Blister" (*o*), "Liebig's Extract of Meat" (*p*), "Condy's Fluid" (*q*), "Wheeler and Wilson" (*r*), or "Singer System" (*s*), as applied to sewing machines. NOTE.

In all these cases, where the patent has expired (*t*), or the secret has become known (*u*), or the manufacture has from any cause become general (*v*), the right, originally exclusive, will be lost (*x*). It has been said that the test whether the name has become *publici juris* is that the use of it by other persons has ceased to deceive the public as to the maker of the article (*y*). But no full or exhaustive definition can be given of the circumstances which will make a word or name *publici juris*; each case must depend on its own facts (*z*).

The books of the Registrar, showing the marks of which registration has been refused, are not evidence that those marks have become *publici juris* (*a*).

In the case of an article patented by the first maker of it, the fact that in the specifications of subsequent patents he describes it under a

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(*f*) *Green* v. *Rooke*, W.N. (1872), 49.

(*g*) *Browne* v. *Freeman*, W. N. (1873), 178.

(*h*) *Siegert* v. *Findlater*, 7 Ch. D. 801.

(*i*) *Leonard* v. *Wells*, 26 Ch. D. 288.

(*j*) *Re Arbenz's Application*, 35 Ch. D. 248.

(*k*) *Canham* v. *Jones*, 2 V. & B. 218.

(*l*) *Singleton* v. *Bolton*, 3 Doug. 293.

(*m*) *Edelsten* v. *Vick*, 11 Ha. 78.

(*n*) *Burgess* v. *Burgess*, 3 D. M. & G. 896.

(*o*) *James* v. *James*, L. R. 13 Eq. 421.

(*p*) *Liebig's Extract of Meat Co.* v. *Hamburg*, 17 L.T.(N.S.) 298; *Same* v. *Anderson*, L. J. No. Ca. (1882), 119; W. N. (1882), 147; W. N. (1883), 185.

(*q*) *Condy* v. *Mitchell*, 37 L. T. (N.S.) 268, 766; 26 W. R. 269.

(*r*) *Wheeler and Wilson Manufacturing Co.* v. *Shakespear*, 39 L. J. (N.S.) Ch. 36. See also *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376.

(*s*) *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 15, 26.

(*t*) *Linoleum Co.* v. *Nairn*, 7 Ch.D. 834; *In re J. B. Palmer's Trade Mark*, 24 Ch. D. 504; *Ralph's Trade Mark*, 32 W. R. 168; *S.C.* 49 L. T. (N.S.) 504; *Leonard* v. *Wells*, 26 Ch. D. 303; *Native Guano Co.* v. *Sewage Manure Co.*, 8 R. P. C. 125, 132, 134; *Davis's Trade Mark*, 14 R. P. C. 903.

(*u*) *James* v. *James*, L. R. 13 Eq. 421.

(*v*) *Canham* v. *Jones*, 2 V & B. 221.

(*x*) *Magnolia Metal Co.'s Trade Mark*, [1897] 2 Ch. 371, 391.

(*y*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*z*) *National Starch, etc. Co.* v. *Munn's Patent Maizena, etc. Co.*, [1894] A. C. 275, 280.

(*a*) *Orr Ewing* v. *Johnston*, 13 Ch. D. 434.

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particular name, shows that the name has become descriptive, and he cannot afterwards claim the exclusive use of that name (*b*).

NOTE. When the name of a patented article has been registered as a trade mark, it may be removed from the register, although the patent is still in force (*c*).

Names too general to be appropriated.

There are also other words which, as being too general, are held incapable of appropriation, such as "Colonial" (*d*), or "London and Provincial" (*e*), or "London Assurance" (*f*), as applied to an insurance company; "India and China," as applied to a tea company (*g*); "Merchants," as the name of a bank (*h*); "Chronicle" (*i*), "Pictorial" (*k*), or "Mail" (*l*), as names of newspapers; "Post Office," as applied to a directory (*m*). And, generally, any name which merely describes the nature of the business or the locality of its operations (*n*).

It will be remembered that the present Act gives a rule for ascertaining, at least for the purpose of registration, whether a trade mark has become non-exclusive, *post*, s. 74, sub-s. (3). And by that section marks common to the trade may, in certain cases, be registered as additions to trade marks.

Mark indicating quality.

The courts would also refuse protection to a so-called trade mark, which was, in fact, a mere advertisement of the character and quality of the goods (*o*), or a mere description of an article as made according to a particular patent (*p*). And the word "guaranteed," as applied to a corset, was held not entitled to protection (*q*).

When descriptive words registered.

Descriptive words may, however, be registered as non-essential parts of a mark (*r*). Thus, under the Act of 1875, the words "Valvoline"

(*b*) *Native Guano Co.* v. *Sewage Manure Co.*, 4 R.P.C. 473; 8 R.P.C. 125, 134.

(*c*) See *Magnolia Metal Co.'s Trade Mark*, *ubi supra*; *Mcaby* v. *Triticine, Ltd.*, 15 R. P. C. 1.

(*d*) *Colonial Life Assurance Co.* v. *Home and Colonial Assurance Co.*, 33 Bea. 548.

(*e*) *London and Provincial Law Assurance Society* v. *London and Provincial Joint Stock, etc. Co.*, 17 L. J. Ch. 37.

(*f*) *London Assurance* v. *London and Westminster Assurance Corporation, Ltd.*, 32 L. J. Ch. 664.

(*g*) *India and China Tea Co.* v. *Teede*, W. N. (1871), 241.

(*h*) *Merchants' Banking Co. of London* v. *Merchants' Joint Stock Bank*, 9 Ch. D. 560.

(*i*) *Cowen* v. *Hulton*, 46 L. T. (N.S.) 897.

(*k*) *Spottiswoode* v. *Clarke*, 2 Ph. 154.

(*l*) *Walter* v. *Emmott*, 54 L. J. Ch. 1059.

(*m*) *Kelly* v. *Byles*, 13 Ch. D. 683.

(*n*) *Per* JAMES, L.J., *Australian Mortgage Land and Finance Co.* v. *Australian and New Zealand Mortgage Co.*, W. N. (1880), 6.

(*o*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. 523.

(*p*) *Chearin* v. *Walker*, 5 Ch. D. 850.

(*q*) *Symington* v. *Footman*, 8 Times R. 488.

(*r*) *Re Hudson's Trade Marks*, 32 Ch. D. 311. See also observations of MALINS, V.-C., *Re Barrow's Trade Marks*, 5 Ch. D. 358.

and "Valvoleum," both being considered descriptive only, were held non-essential parts of two trade marks of which the devices were different, and the registered owner of a mark with the one word was held not entitled to prevent the registration of the mark containing the other word (*s*). And the words, "Carbolic Acid Soap Powder," though common to the trade and merely descriptive, were admitted to registration as part of a trade mark (*t*). So, also, a motion to rectify the register by expunging the words "The Sanitary Filter, easily cleaned," from a mark consisting of a device with these words round it, which had been registered under the Act of 1875, was refused (*u*).

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When the mark consisted of the combination of a device with the words "Swift's Specific," it was registered, the applicant, on the opposition of a person of the same name who had used the words in his business, disclaiming any right to the exclusive use of the words (*x*).

In the above cases, however, it is the device only and not the descriptive word which is protected (*y*). And see now, *ante*, s. 64 (2).

Saving for power to provide for entry on register of common marks as additions to trade marks.

74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(a.) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(b.) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

(*s*) *Re Horsburgh*, 53 L. J. Ch. 237.

(*t*) *Re Hudson's Trade Marks*, *ubi supra*.

(*u*) *Re Atkins' Trade Mark*, 3 R. P. C. 164.

(*x*) *Swift Specific Co.'s Trade Mark*, 6 R. P. C. 352. See also *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(*y*) *Re Horsburgh*, *ubi supra*; *Re Hudson's Trade Marks*, *ubi supra*; *Re Atkins' Trade Mark*, *ubi supra*.

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(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

By s. 16 of the Act of 1888, the following is substituted for sub-s. (2) of this section :—

"(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

This section appears to relate only to marks not already registered. With regard to marks already registered, see s. 92, *post*, p. 484. The section only applies where there are words and figures or other marks common to the trade (*z*). It provides that a trade mark may be registered if it contains some distinctive device, mark, etc., which is made by the Act an essential particular, although coupled with some feature which is common to the trade, provided that the right to the exclusive use of such common feature be disclaimed (*a*). For an order by consent for the comptroller to proceed with the registration of an old mark on the applicant's disclaiming the exclusive use of particular devices in use by other persons see *H. J. Neill's Trade Mark*, *No.* 2, Appendix, *post*.

(*z*) *Thompson* v. *Montgomery*, 41 Ch. D. 35, 49.

(*a*) *Per* NORTH, J., *Baker* v. *Rawson*, 45 Ch. D. 519, 532.

"**Distinctive,**" that is, *primâ facie* distinctive (*b*). And see under s. 64 (1) (*c*).

NOTE.

"**Common to the trade.**"—This expression does not mean "in common use at the time of application," it means "open to the trade" (*c*).

A mark was held to be common to the trade because similar, though not in each case identical, marks were in use by more than three persons engaged in the same trade; although in some of the cases the mark was not actually placed on the goods, but was only used on billheads, trade circulars, advertisements, or show cards (*d*).

Where a brewery had been carried on by the plaintiffs at Stone, and their ale had become known as "Stone ale," it was held that the word "Stone" was not common to the trade within this section (*e*).

When a firm had on the register a mark consisting of a winged cross, and afterwards sought to register as an old mark the winged cross surrounded by two circles, with a disclaimer of the circles as common to the trade, the application was refused as absurd (*f*).

SUB-SECTION 2.

Disclaimer.

The disclaimer here contemplated is of matter common to the trade, and where a proposed mark consisted of a key and the words "Geneva Key Brand," which were not common to the trade, being only used by the applicants and the opponents, it was held that a disclaimer of the words could not be required (*g*).

The words "Smokeless Powder" are not distinctive, and therefore a disclaimer of them was not required under this section (*h*).

Words contained in a label registered as a whole are not an addition to the label and need not be disclaimed (*i*).

And see also notes under s. 64 (2) (3), *ante*, pp. 396, 398.

The disclaimer must be made at the time of application and cannot, at the instance of the applicant, be added subsequently (*k*).

(*b*) See *per* CHITTY, J., *Burland* v. *Broxburn Oil Co.*, 42 Ch. D. 274.

(*c*) *Burland* v. *Broxburn Oil Co.*, 42 Ch. D. 274; *Humphries* v. *Taylor Drug Co.*, 59 L. T. (N.S.) 820; *Apollinaris Co.'s Trade Mark*, [1891] 2 Ch. 186.

(*d*) *Re Wragg's Trade Mark*, 29 Ch. D. 551.

(*e*) *Thompson* v. *Montgomery*, 41 Ch. D. 35. See also *Barlow* v. *Johnson*, 7 R. P. C. 395.

(*f*) *Baker* v. *Rawson*, 45 Ch. D 519, 530.

(*g*) *Meeus' Application*, [1891] 1 Ch. 47, 49.

(*h*) *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(*i*) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 186, 233; *Smokeless Powder Co.'s Trade Mark*, *ubi supra*.

(*k*) *Goodall's Trade Mark*, 42 Ch. D. 566; *Meeus' Application*, [1891] 1 Ch. 41.

Sect. 74 (2). When the registration was made on an application before January 1st, 1884, that is, under the Act of 1875, this disclaimer could not be enforced, that Act containing no provision similar to this section (*l*).

NOTE.

But in a case where words too general formed part of the label, the order allowing the registration stated that no exclusive right to the use of the words was acquired thereby (*m*).

When the mark has been registered under the present Act, a disclaiming note may be ordered on an application to that effect made by the defendant to an action for infringement of the mark (*n*).

"Provided that a person need not . . . disclaim his own name," etc.—Where the label contained the words "Smokeless Powder Co.," which was the name of the company registering the label, it was held that no disclaimer could be required of the first two words, as they were part of the name of the owner of the mark (*o*).

SUB-SECTION 3.

This was the rule under the Act of 1875 (*p*). See also, *post*, s. 90.

"Publicly used by more than three persons."—These words do not mean that the mark has been used by such persons as an exclusive trade mark, but include user in any manner (*q*).

The words are not a definition, or explanatory of the words "common to the trade," except so far as that user by more than three persons is to be deemed common to the trade, and, therefore, where it was shown that a word was descriptive only, and, as such, open to the trade, a disclaimer of exclusive use was ordered, although the word was not shown to have been used by any persons except the owner of the registered mark and the applicant seeking to rectify the register (*r*).

Effect of Registration.

Registration equivalent to public use.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.

By s. 17 of the Act of 1888, the following is substituted for this section:

(*l*) *Re Hudson's Trade Marks*, 32 Ch. D. 311; *Re Atkins' Trade Mark*, 3 R. P. C. 164.

(*m*) *Re Hudson's Trade Marks*, 3 R. P. C. 155, 161.

(*n*) *Burland* v. *Broxburn Oil Co.*, 42 Ch. D. 274; *Thompson* v. *Miller*, 13 R. P. C. 35.

(*o*) *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(*p*) *Re Jelley, Son, & Jones*, 51 L. J. Ch. (N.S.) 640 n.

(*q*) *Re Wragg's Trade Mark*, 29 Ch. D. 556.

(*r*) *Burland* v. *Broxburn Oil Co.*, 42 Ch. D. 274, 280. See also *Humphries* v. *Taylor Drug Co.*, 59 L. T. (N.S.) 820.

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"Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration."

The section in its original form is a re-enactment of the last clause of s. 2 of the Act of 1875. That clause was for the benefit of those making new trade marks (*s*), and altered the old law under which a person who had not acquired by use a reputation for a mark had no exclusive right to it (*t*). The fact of there having been no previous user does not prevent the registration of a trade mark either under this Act or the Act of 1875. See *ante*, p. 377. But there must be a *bonâ fide* intention of using the mark (*u*).

"The date of application," etc.—The new section makes retrospective the rule which was established by the Trade Marks Rules, 1883, r. 32, as to applications under the Act of 1883.

Right of first proprietor to exclusive use of trade mark

76. The registration of a person as proprietor of a trade mark shall be primâ facie evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, *subject to the provisions of this Act.*

Under the corresponding section (s. 3) of the Act of 1875, it was held that a mark which is not a trade mark, and which, therefore, ought not to be registered, does not acquire the character of a trade mark by being on the register for five years, and may be removed from the register (*x*).

If a word has been wrongly registered as a trade mark, not being capable of registration at all, the owners of the mark cannot thereby obtain any right to the exclusive use of the word, although in fact they may during the registration have had practically the sole use of it (*y*).

(*s*) *Per* Lord BLACKBURN, *Orr Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 496.

(*t*) *Hudson's Trade Mark*, 32 Ch. D. 312; *Wilson* v. *Maxfield*, Seb. Dig. p. 275.

(*u*) *Batt & Co.'s Trade Mark*, [1898] W. N. 44 (15).

(*x*) *Re Palmer's Application*, 21 Ch. D. 48; *Leonard* v. *Wells*, 26 Ch. D. 288, 300; *Palmer's Trade Mark*, 24 Ch. D. 504; *Edwards* v. *Dennis*, 30 Ch. D. 454; *Wood* v. *Lambert*, 32 Ch. D. 247.

(*y*) *Leonard* v. *Wells*, 26 Ch. D. 299.

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NOTE.

So, also, where the mark was *primâ facie* a distinctive trade mark, capable as such of registration, but was at the time common to the trade (*z*).

These principles apply to cases under the present Act (*a*).

But a defendant in an action for infringing a trade mark which has been on the register five years cannot set up as a defence that the mark ought not to have been registered as a trade mark. If that point is to be raised, it must be by a motion to rectify the register (*b*).

Where the mark has been on the register for five years, an injunction may be obtained against the use of a mark which infringes, even though the latter be also registered (*c*). And a defendant who had registered a mark was restrained from using it for goods which by that user came to bear the same name in the market which the plaintiff's goods had acquired by reason of a mark previously registered by him (*d*).

Where a photograph of a foreign picture of which at the time there was no copyright in England had been registered by the defendants as a trade mark, it was held that they had an interest within s. 6 of the International Copyright Act, 1886, in advertising it by show cards and trade lists, and could not be prevented from so doing by persons who had subsequently acquired and registered in England copyright in the picture (*e*).

"**The date of the registration**"—that is, the date of the application. See the amended s. 75, *ante*, p. 439, and T. M. R. 1890, r. 34, *post*.

"**Subject to the provisions of this Act.**"—These words make this section subject to s. 90, and, therefore, any person aggrieved may, even after the five years, show that the registered device is one which ought not to have been registered, and accordingly, when it was, after a lapse of five years from the date of registration, shown that the mark was at the date of registration in use by more than three persons, an application to remove it from the register was granted (*f*).

(*z*) *Wragg's Trade Mark*, 29 Ch.D. 551.

(*a*) *Baker* v. *Rawson*, 45 Ch. D. 519, 531; and see *Wragg's Trade Mark*, *ubi supra*.

(*b*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478, 483; *Apollinaris Co.* v. *Snook*, 7 R. P. C. 474; 8 R. P. C. 166. See *Edwards* v. *Dennis*, 30 Ch. D. 477. A contrary view had been suggested by JESSEL, M.R., *Re Palmer's Application*, 21 Ch. D. 59, 60.

(*c*) *Edwards* v. *Dennis*, 30 Ch. D. 457 (A. L. SMITH, J.). The injunction was dissolved in the Court of Appeal (30 Ch. D. 466), but not on grounds affecting the law as here held.

(*d*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454.

(*e*) *Schauer* v. *Field*, [1893] 1 Ch. 35.

(*f*) *Lloyd & Son's Trade Mark*, 27 Ch. D. 646; *Wragg's Trade Mark*, 29 Ch. D. 551; *Wood* v. *Lambert*, 32 Ch. D. 247.

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Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request (*g*), and on payment of the prescribed fee, grant a certificate that such registration has been refused.

"Unless, in the case of a trademark capable of being registered," etc.—These words appear to include not merely all marks, whether new or old, within s. 64 (1) and (2), but also old marks which, under the authority given by s. 64 (3), are allowed to be registered; and a certificate of refusal of registration appears to be sufficient only in the case of actions brought for infringement of *other trade marks in use, etc.*, that is, old marks which, though in use as trade marks before August 13th, 1875, are not permitted to be registered, such, for instance, as the single letter in the case of *Re Mitchell's Trade Mark* (*h*) under the Act of 1875 (*i*).

As to marks in this position, the owner, on obtaining a certificate that the registration has been refused, is in the same situation for suing for the protection of his trade mark as if the Act had not passed (*j*).

But there are two cases to which the section does not appear to apply, viz. :—

(a.) New trade marks within the definition of s. 64, sub-s. (3), not capable of registration as new marks, but which, if old, could have been registered under that sub-section.

(b.) Names, whether new or old, which are "so appropriated by user as to come to mean the goods of a particular person, though 'the name' is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark properly so called, or within" the Trade Marks Registration Acts (*k*).

(*g*) See T. M. R. Form L.

(*h*) 7 Ch. D. 36.

(*i*) See *Goodfellow* v. *Prince*, 35 Ch. D. 9.

(*j*) *Per* MALINS, V.-C., *Re Barrow's Trade Marks*, 5 Ch. D. 359.

(*k*) See *Singer Manufacturing Co.* v. *Loog*, judgment of Lord BLACKBURN, 8 App. Cas. 32. See also *Somerville* v. *Schembri*, 12 App. Cas. 453.

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NOTE.

Old law preventing one man from selling his goods as the goods of another not altered.

The principles on which the court acts in preventing a man from passing off his goods as those of another have not been altered by the Trade Marks Registration Act (*l*), and therefore relief may still be had in classes (a.) and (b.) mentioned above, in cases were relief would have been given before the Acts. The principles referred to are thus laid down by Lord KINGSDOWN (*m*): "The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot therefore (in the language of Lord LANGDALE in *Perry* v. *Truefitt* (*n*), ('be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.'" And again, in *The Singer Manufacturing Co.* v. *Loog* (*o*), Lord BLACKBURN said: "The original foundation of the whole law is this, that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established alike at law, *Blofeld* v. *Payne* (*p*), and in equity, *Edelsten* v. *Edelsten* (*q*), that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior."

Infringement of common law trade mark.

And in *Somerville* v. *Schembri* (*r*), it was held, upon the general principles of commercial law, that "as soon as a trade mark has been so employed in the market as to indicate to purchasers that the goods to which it is attached are the manufacture of a particular firm, it becomes to that extent the exclusive property of the firm; and no one else has a right to copy it or even to appropriate any part of it, if by such appropriation unwary purchasers may be induced to believe that they are getting goods which were made by the firm to whom the trade mark belongs." Such a trade mark has been called a "common law trade mark" as distinguished from a registered mark (*s*).

Upon these principles it was held that a question of alleged infringement of a trade mark registered as a white selvage could not be decided without considering whether the alleged infringement (which in fact was dark grey) was not, according to the custom of the trade, a white

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(*l*) *Mitchell* v. *Henry*, 15 Ch. D. 181; *Price's Patent Candle Co.*, 27 Ch. D. 681; *Great Tower Street Tea Co.* v. *Langford*, 5 R. P. C. 66; *Edwards* v. *Dennis*, 30 Ch. D. 454; *Jay* v. *Ladler*, 40 Ch. D. 649; 60 L. T. (N.S.) 27.

(*m*) *Leather Cloth Co.* (*Limited*) v. *American Leather Cloth Co.*, 11 H. L. C. 538, cited with approval by Lord BLACKBURN; *Johnston* v. *Orr Ewing*, 7 App. Cas. 228.

(*n*) 6 Ben. 66, 73.

(*o*) 8 App. Cas. 15, 29.

(*p*) 4 B. & Ad. 410.

(*q*) 1 D. J. & S. 185.

(*r*) 12 App. Cas. 453, 457 (judgment of Lord WATSON).

(*s*) See *per* LINDLEY, L.J., *Reddaway* v. *Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639, 641.

selvage, and if it was, then whether the differences in quality and position of the threads in the defendant's selvage were sufficient to distinguish the defendant's goods from those of the plaintiff so as to prevent purchasers from being misled (*t*).

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NOTE.

Use of descriptive words: how far restrained

The mere circumstance that a word is descriptive will not, if it has in fact come to denote exclusively the goods of a particular trader, entitle another trader to use it for his goods, without so distinguishing it as to avoid deception (*u*). And the use of such a word may be restrained, although it is incapable of registration as a trade mark. Thus injunctions were granted to prevent the use of the word "Stone," as a name for ale (*x*), "Yorkshire Relish," as a name for sauce (*y*), although the words were held incapable of registration, and expunged *from the register.*

So also, when the plaintiff's mark had become distinctive of his goods, of descriptions other than those for which it was registered, he was held entitled to protection (*z*).

And if the mark has become distinctive of the plaintiff's goods, it will be protected against a rival trader even though the reputation was acquired by the exertions of the latter as an importer and vendor on behalf of the plaintiff (*a*).

And where the plaintiff had registered the words "The Self Washer" as a trade mark for soap, and sued the defendants (who used the words "Self Washing") for infringement of trade mark, and also for passing off their goods as goods of the plaintiff, and the court held the trade mark incapable of registration, and dismissed the action so far as it sought protection for the trade mark, the injunction was granted as to the other relief sought (*b*).

If the mark complained of be calculated to deceive, and the court sees reason to believe that it is used to enable defendant to pass off his goods as those of the plaintiff, the injunction will be granted to restrain infringement of the registered mark, without considering the question

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(*t*) *Mitchell* v. *Henry*, 15 Ch. D. 181.

(*u*) *Reddaway* v. *Banham*, [1896] A. C. 199 (the order is printed p. 222). See also *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389; *Huntley & Palmer* v. *Reading Biscuit Co.*, 10 R. P. C. 277. See also order in *Wolmershausen* v. *Wolmershausen*, Seton, Addenda, p. 2112.

(*x*) *Thompson* v. *Montgomery*, 41 Ch. D. 35; [1891] A. C. 217.

(*y*) *Powell* v. *Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; affirmed in H. L. 14 R. P. C. 720. See also *Thompson* v. *Miller*, 13 R. P. C. 35.

(*z*) *Jay* v. *Ladler*, 40 Ch. D. 649.

(*a*) *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645.

(*b*) *Lever* v. *Goodwin*, 4 R. P. C. 492. See also *Humphries* v. *Taylor Drug Co.*, 5 Times R. 41; *Slazenger* v. *Feltham* (No. 2), 6 R. P. C. 536; *Hart* v. *Colley*, 7 R. P. C. 93.

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NOTE.

whether or not the registration is good (*c*); and the injunction may be granted even though some part of the mark was capable of registration and has not been registered (*d*).

Where a plaintiff had a patent and sold his goods as "Patent Cups," which name was understood in the trade to denote articles made by plaintiff according to his patent, defendant, who had registered a design for a similar article, was restrained from selling his articles as "Patent Cups" (*e*).

But in the case of a descriptive word the injunction will only be granted against using the word without distinguishing the defendant's goods from those of the plaintiff (*f*), and if the defendant does in fact so distinguish his goods, the injunction will not be granted at all (*g*).

Question is whether public misled.

In considering whether, in an action for infringement, the alleged trade mark is calculated to deceive, the question is not whether it is calculated to deceive the trade, but whether the public will be likely to be misled (*h*). And in order to obtain an injunction it is not necessary to prove an intention to mislead, nor that any one has in fact been misled (*i*). And where the defendant sold to middlemen and not to retailers, and an injunction was granted, the account of profits was directed as to all sales by the defendant, and was not limited to those sales in which it could be shown that purchasers had bought the defendant's article in the belief that it was the plaintiff's (*k*).

But where the words were capable of registration as a trade mark, and had not been registered, and there was no evidence to show such appropriation by user of the words as to cause them to mean the goods of the plaintiff, an injunction was refused (*l*).

So also where a registered trade mark included certain letters the exclusive use of which was disclaimed, and the alleged infringement consisted in the use of these letters (*m*).

(*c*) *Compania General de Tabacos* v. *Rehder*, 5 R. P. C. 61.

(*d*) *Great Tower Street Tea Co.* v. *Langford*, 5 R. P. C. 66.

(*e*) *Lawrie* v. *Baker*, 2 R. P. C. 215; and see *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454.

(*f*) *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389. And see cases in note (*u*), p. 443.

(*g*) *Linoleum Co.* v. *Nairn*, 7 Ch. D. 834.

(*h*) *Steinway* v. *Henshaw*, 5 R. P. C. 77; *Great Tower Street Tea Co.* v. *Langford*, *ubi supra*; *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183.

(*i*) *Reddaway* v. *Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639, 644; *Millington* v. *Fox*, 3 My. & Cr. 338; *Johnston* v. *Orr Ewing*, 7 App. Cas. 219; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376, 391; *Paine* v. *Daniells*, [1893] 2 Ch. 567; *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645.

(*k*) *Lever* v. *Goodwin*, 4 R. P. C. 492; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 189, 203.

(*l*) *Goodfellow* v. *Prince*, 35 Ch. D. 9.

(*m*) *Rosenthal* v. *Reynolds*, [1892] 2 Ch. 301.

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NOTE.

Infringement of registered trade mark.

Where plaintiff had registered a mark of an elephant for tea, and the defendants had registered a mark of an elephant for coffee, an interlocutory injunction was granted restraining the defendants from using their mark for tea, although the word "Coffee" appeared in the mark and the figures of the elephant and the get up of the plaintiff's and defendants' packets were different in many respects (*n*).

And where the word "*Demon*" was registered as part of a trade mark, and was used to denote articles made under a patent which was held invalid, it was nevertheless held that the defendant could be restrained from using in respect to the same article the word "Demotic" so as to represent that the articles were made by the plaintiff (*o*).

Where the only act complained of was the taking of a part marked with the plaintiff's registered mark, and attaching it to the defendant's machine, there being no evidence that the public was thereby induced to believe that the whole machine was made by the defendant, it was held that there was no infringement of the trade mark (*p*).

Although a descriptive word may have been registered as a trade mark, the registration gives no right to restrain any use of it except as a trade mark, and therefore where the word "*Bodega*" (a word understood to mean a superior class of wine shop), which had been registered as plaintiff's trade mark, was used to describe the shop of the defendants, but not in such a way as to be calculated to lead to the belief that it was the place of business of the plaintiff, an interlocutory injunction was refused (*q*).

A registered trade mark containing a facsimile signature of the owner, is not infringed by the mere use of another facsimile signature of a rival trader bearing the same surname (*r*).

The mere fact that the plaintiff uses his registered mark with additions which form no part of his mark, and which cannot be registered, does not affect his right to sue to restrain infringement of his registered mark (*s*). And where the trade mark is registered with certain blanks which are afterwards filled up, the trade mark is not so different from the one registered as to give grounds for any objection to

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(*n*) *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183.

(*o*) *Slazenger* v. *Feltham* (No. 2), 6 R. P. C. 531. See also *Hart* v. *Colley*, 7 R. P. C. 93.

(*p*) *Harrison* v. *Woodroffe*, 7 R. P. C. 25.

(*q*) *Bodega Co.* v. *Owens*, 6 R. P. C. 236. It was afterwards, on the evidence, granted at the trial, 7 R. P. C. 31. See also *Singer Co.* v. *Loog*, 8 App. Cas. 33.

(*r*) *Crawford* v. *Bernard*, 11 R. P. C. 380.

(*s*) *Melachrino* v. *Melachrino*, 4 R. P. C. 215: *Hammond* v. *Brunker*, 9 R. P. C. 301; *Cochrane* v. *Mac Nish*, 13 R. P. C. 100.

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an action for infringement, at any rate in the case of a defendant who is using the mark as filled up (*t*).

NOTE.

When there was only one case of alleged misrepresentation (which was made by servants), and there was no reason to suppose that the misrepresentation would be repeated, the injunction was refused (*u*).

Where the name of the article has been registered as a trade mark, and the article is sold by the makers in bulk to the retailers, the latter may sell it in bottles marked with the name, and even though the article may have been deteriorated by keeping (*x*).

If a trade mark consists of a device in combination with a word which, being merely descriptive, could not by itself be registered, the mark will only be infringed if the device itself is encroached upon (*y*).

If the trade mark is on the register an assignee may sue, although at the time of bringing the action the assignment has not been registered (*z*). But persons having the sole right to sell in this country goods marked with the trade mark of the foreign manufacturers, but not being themselves owners of the mark, have no right to sue for infringement (*a*).

An action for infringement of a registered trade mark survives, and may be continued by the executor of the registered owner (*b*).

Under the Copyright Act, 1842 (*c*), where registration is required as a condition precedent to suing, the day may be divided into fractions, so that it is sufficient if the writ, though issued on the same day as the registration is effected, is issued after the registration has been made (*d*).

When the trade itself is fraudulent.

Cases of false representation in the trade mark itself have been already dealt with under s. 73. But the trade itself may be fraudulent, and in such a case the Court of Equity has been accustomed not to interfere (*e*).

Thus, in *Pidding* v. *How* (*f*), the plaintiff, a tea-dealer, who sold under the name of "Howqua's Mixture" a mixed tea composed of different kinds of teas, sought to restrain the defendant from selling teas under the same name, and in packages with labels resembling the

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(*t*) *Newman* v. *Pinto*, 4 R. P. C. 508.

(*u*) *Leahy* v. *Glover*, 10 R. P. C. 141.

(*x*) *Condy* v. *Taylor*, 3 Times R. 665.

(*y*) *Ante*, p. 435, under s. 73.

(*z*) *Ihlee* v. *Henshaw*, 31 Ch. D. 323.

(*a*) *Richards* v. *Butcher*, 7 R.P.C. 288.

(*b*) *Oakey* v. *Dalton*, 35 Ch. D. 700. See also *Hatchard* v. *Mège*, 18 Q. B. D. 771; *Jones* v. *Simes*, 62 L. T. (N.S.) 447.

(*c*) 5 & 6 Vict. c. 45.

(*d*) *Warne* v. *Laurance*, W. N. 1886, 55.

(*e*) Nor apparently could the plaintiff have succeeded at law. See judgment of MELLISH, L.J., *Ford* v. *Foster*, L. R. 7 Ch. 630.

(*f*) 8 Sim. 477.

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NOTE.

plaintiff's. The plaintiff, however, had stated in his labels and advertisements that the mixture was made by one Howqua, a celebrated Canton merchant, and was purchased from him and imported into this country in the packages in which it was sold, and that the tea which gave it its peculiar flavour was rare in China, and could not be procured in England. All these statements were proved to be untrue, and on that ground SHADWELL, V.-C., although satisfied that the defendant's proceedings were improper, refused to interfere by injunction until the plaintiff had established his right at law.

So, also, in the case of *Perry* v. *Truefitt* (*g*), the plaintiff, a maker of a preparation which he called "Medicated Mexican Balm," sought to restrain the sale by a rival trader of a different preparation under the same name. The plaintiff's advertisement, however, having stated his preparation to have been "made from an original recipe of the learned J. F. Blumenbach, and recently presented to the proprietor by a very near relative of that illustrious physiologist," whereas in fact he had purchased the preparation from one Leathart, an injunction was refused, but the motion was ordered to stand to the hearing, with liberty for the plaintiff to bring an action at law.

Where plaintiff sold under the name of "Estcourt's Hop Supplement," an article which was a substitute for hops, and was intended to deceive the public, he was held not entitled to protection (*h*).

But a merely collateral misrepresentation by the owner of the trade mark, as, for instance, a statement in invoices and a few advertisements that he was a patentee when he was not (*i*), or a statement, contrary to the fact, that he was a professor (*k*), was insufficient to disentitle the plaintiff to relief, either at law or in equity.

Notwithstanding the registration of a trade mark, the court will still act on the principles laid down before the passing of the Registration Acts, and refuse, as in *Pidding* v. *How* (*l*), "to extend its protection to persons whose case is not founded in truth."

Thus, where the plaintiff, having a registered trade mark for cigars, used it on a box stamped with various devices forming an "elaborate concatenation of pictorial lies," which represented that the cigars were made in Havana, when in fact they were not, it was held that he was engaged in a fraudulent trade, and an injunction was refused (*m*).

(*g*) 6 Bea. 66.

(*h*) *Estcourt* v. *The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276.

(*i*) *Ford* v. *Foster*, L. R. 7 Ch. 611. See *per* VAUGHAN WILLIAMS, L.J., *Jamieson* v. *Jamieson*, 15 R.P.C. 191.

(*k*) *Holloway* v. *Holloway*, 13 Bea. 209.

(*l*) 8 Sim. 477.

(*m*) *Newman* v. *Pinto*, 4 R. P. C. 508. (See judgment of BOWEN, L.J., p. 519). See also *Apollinaris Co.* v. *Snook*, 7 R. P. C. 474, 476.

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NOTE.

The questions arising on the use of the word "patent" have been already considered under s. 73.

The last part of the marginal note to the section is an error (*n*).

77A. In an action for infringement of a registered trade mark the court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the court or judge trying the subsequent action certifies that he ought not to have the same.

This section was added by the Act of 1888, s. 18, and introduces into actions for infringement of a registered trade mark the practice as to costs which, under s. 31, applies to actions for infringement of patent. See notes under that section, *ante*, p. 316.

Where the defendants to an action for infringement of trade mark moved to expunge the registration of the trade mark, and failed on the ground that they had not discharged the *onus* which lay upon them of showing that the mark ought not to be on the register, and it was admitted that on the motion failing there was no defence to the action, and the court accordingly gave judgment in the action for the plaintiff, it was held that the validity of the trade mark had not been tried in the action, and a certificate under this section was refused (*o*).

Register of Trade Marks.

Register of trade marks.

78. There shall be kept at the patent office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed (*p*).

See s. 81 as to the "Sheffield Register" for the registration of cutlery marks on applications by applicants in Hallamshire, or within six miles thereof. See also s. 87.

(*n*) The marginal notes form no part of an Act of Parliament, *Sutton* v. *Sutton*, 22 Ch. D. 513.

(*o*) *Edgington* v. *Edgington*, 6 R. P. C. 513.

(*p*) See T. M. R. rr. 32—51.

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Removal of trade mark after fourteen years unless fee paid.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee ; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may without removing such trade mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for nonpayment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the register for nonpayment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade mark which is already registered (*q*).

By s. 19 of the Act of 1888, sub-s. 5 of this section is amended as follows:

(1.) In sub-section five of section seventy-nine of the principal Act, for the words "the five years" shall be substituted the words "one year."

(*q*) T. M. R. r. 47.

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(2.) To the same sub-section the following words shall be added; namely, "unless it is shown to the satisfaction of the comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

This section is substantially a re-enactment of rules 29 to 32 of the Trade Marks Rules of March, 1883.

Fees.

Fees for registration, etc.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct (*r*).

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

(2.) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in*

(r) T. M. R., First Schedule, *post*.

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respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875:

(3.) An application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*, shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (*s*):

(4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6.) Upon the registration of a trade mark in the Sheffield register, the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of

(*s*) T. M. R. rr. 56—59.

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application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day :

(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register ; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :*

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutler's register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned :

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks :

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to

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the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks:

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm reverse or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court (*t*):

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.

By s. 20 of the Act of 1888, this section is amended as follows:—

(1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted:

"(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal

(*t*) T.M.R. Form W.

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goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

(2.) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted :

(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto ; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade Marks, respectively ; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company : Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register.

(4.) To the same section the following sub-sections shall be added ; namely,—

(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought,

unwrought, or partly wrought, and all goods composed wholly or partly of any metal. Sect. 81.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.

These provisions differ considerably from the corresponding provisions in the Act of 1875.

A list and short abstract of the Cutlers' Company's Acts is given in "Sebastian on Trade Marks," Third Edition, Appendix G.

Where the Cutlers' Company opposed the registration of a trade mark for cutlery for three classes of goods, on the ground that it so nearly resembled a Sheffield corporate mark previously assigned to another manufacturer of cutlery, and still used by him, as to be calculated to deceive, and in the Court of Appeal succeeded as to two of the classes, but abandoned their opposition as to the third class, it was held that applicant must pay the costs of the appeal, but that no costs of the motion in the court below could be given (*u*).

Sub-section (2).

This sub-section relates only to old marks, and the duty of registration thereby thrown on the company is merely ministerial, and is not subject to any appeal to the comptroller under sub-s. (12) (*v*).

Under this section, in its original form, it was held that old marks might be registered for more goods than the mark is actually used for (*x*).

Sub-sections (3), (4), (5), (6).

These sub-sections apply only to new marks (*y*).

Sub-section (7).

As to the assignment of a corporate trade mark granted by the Cutlers' Company, see *Bury* v. *Bedford* (*z*).

As to the construction of this sub-section, see *Re Lambert's Trade Mark* (*a*).

(*u*) *Re Rosing*, 54 L. J. Ch. 975.

(*v*) *Re Lambert's Trade Mark*, 5 R. P. C. 542; affirmed 5 Times R. 367; 6 R. P. C. 344.

(*x*) *Re Lambert's Trade Mark*, 5 R. P. C. 555.

(*y*) *Re Lambert's Trade Mark*, *ubi supra*.

(*z*) 4 De G. J. & S. 352. See also *In re Rabone Brothers*, Seb. Dig., p. 395.

(*a*) 5 R. P. C. 542, 554.

NOTE. This sub-section relates to cases in which a decision has been arrived at by the Cutlers' Company, not to cases under sub-s. (2), where the company have merely a ministerial duty to perform (*b*).

PART V.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as the Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(*b*) *Re Lambert's Trade Mark*, *ubi supra*.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament. Sect. 83.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence. Seal of patent office.

See *ante*, s. 12 (2), p. 60.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive. Trust not to be entered in registers.

Before the passing of this Act, the Patent Office registered deeds of trust relating to patents (*c*). As regards trade marks, this section is an enactment of Rule 22 of the Rules of August, 1876, re-enacted in Rule 23 of the Rules of March, 1883.

Under this section it is irregular to enter, on the register of two similar trade marks in the same class, a note that the user of the marks is subject to an agreement merely referred to and not stated (*d*), or being in the nature of a trust (*e*). But a note of the mutual undertakings of the parties restricting the user of the trade mark may be entered on the register (*f*).

Where a patentee entered into an agreement under which the other party to the agreement was to promote a company for working the patents, and was to have a share in the proceeds of sale, and containing provisions for making it void in certain events, it was held that such an agreement ought not to be entered on the register, and the registration was expunged (*g*).

But in *Casey's Patents* (*h*) it was held by the Court of Appeal that the section only excludes notices of trusts and does not exclude documents which affect the proprietorship, whether by creating trusts or otherwise, and a letter written by owners of certain patents agreeing to give their

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(*c*) Johnson's Patentees' Manual, 4th ed., p. 221.

(*d*) *Mitchell & Co.'s Trade Mark, and Houghton & Hallmark's Trade Mark*, 28 Ch. D. 666.

(*e*) *De Otadny's Trade Mark*, W. N. 1885, p. 177.

(*f*) *Ibid.*; *Mitchell & Co.'s Trade Mark, ubi supra*; *Re Rabone & Co.*, Seb. Dig., p. 396.

(*g*) *Haslett* v. *Hutchinson*, 8 R. P. C. 457.

(*h*) [1892] 1 Ch. 104.

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manager a share in consideration of his services was held to be an equitable assignment and to have been properly entered on the register.

Refusal to grant patent, etc., in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Restrictions on registration.

The comptroller will also decline to register as part of any trade mark the Royal arms, or arms so nearly resembling them as to be calculated to deceive (except in the case of old marks); or the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery"; or, except as old marks or parts of old marks, representations of the Queen or Royal Family, or of the Royal Crown, or the national arms or flags of Great Britain.

It will be remembered that the "Instructions" issued by the Patent Office, in which these restrictions appear (see Appendix, *post*), are merely office regulations and have not the force of rules made under s. 101 of the Act (*i*). But as to some of the words mentioned, they merely express the decision of the courts (*k*); and whether they are or are not binding, the court will be very slow to depart from the practice established thereby (*l*). And see, also, notes under ss. 62, 69 (*ante*, pp. 380, 413), as to the discretion given to the comptroller.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be (*m*). The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to any rights appearing from

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(*i*) See *Re Rotherham's Trade Mark*, 11 Ch. D. 250; affirmed 14 Ch. D. 585.

(*k*) See *Re Royal Baking Powder Co.*, *ante*, p. 404, and *Re Meikle's Trade Mark*, W. N. 1876, 248.

(*l*) *König & Ebhardt's Trade Mark*, 13 R. P. C. 449.

(*m*) See P. R. rr. 67—71; D. R. rr. 20—28; T. M. R. rr. 32—41, *post*.

such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property. Sect. 87.

By the Act of 1888, s. 21, this section is amended as follows :—

In section eighty-seven of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

See *ante*, ss. 23, 55, 78.

PATENTS.

"Assignment."—See s. 36. The right of assignment depends on the words of the patent itself (*n*); and in the form in the First Schedule (*post*, p. 504) the grant is to the "patentee," which word, by a previous recital, is made to include his assigns.

A patentee may assign a distinct and separate part (*o*), or an undivided share (*p*) of a patent, and the assignee, whether of the entirety, or of a part or share, takes the legal interest, and is not to be considered merely as a licensee (*q*).

Agreement as to co-ownership of patent on conditions.

Where a patentee agreed with a purchaser that upon making certain payments the purchaser should become part owner of the patent with the patentee, and should have the sole right to manufacture and sell the patented article subject to certain conditions, one of which was the payment of half the future cost of maintaining the patent, "and thereupon the purchaser should be and continue such part owner as aforesaid," it was held that on the purchaser failing to pay half of a sum which became payable as duty for keeping up the patent, he ceased to be part owner, and an injunction was granted at the suit of the patentee restraining subsequent assignees of the trustee in liquidation of the purchaser from infringing the patent (*r*).

Rights of co-owners

The law as to the rights of co-owners of a patent is thus laid down by LINDLEY, L.J. (*s*): "In the case of a patent belonging to several

(*n*) Hindmarch on Patents, p. 234.
(*o*) *Dunnicliff* v. *Mallet*, 7 C. B. (N.S.) 209.
(*p*) *Walton* v. *Lavater*, 8 C. B. (N.S.) 162.
(*q*) *Per* ERLE, C.J., *ibid.*, p. 184.
(*r*) *King* v. *Oliver*, 1 R. P. C. 23, 42.
(*s*) Lindley on Partnership, 6th ed. p. 36, citing *Dunnicliff* v. *Mallet*, 7

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persons in common, each co-owner can assign his share, and sue for an infringement, and can also work the patent himself and give licences (*t*) to work it; and sue for royalties payable to him for its use; and it is now settled that even if he be a mortgagee of the other share he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licences."

Where two persons entered into a partnership for working a patent belonging to one, it was held by BACON, V.-C., that the patent was an asset of the partnership, and that neither partner could assign it without the other, but that both had a licence to work the invention, and when they separated each could work it on his own account (*u*).

Where a patentee on assigning his patents reserved a right to work them personally, such liberty not to be transferable, an injunction was granted to restrain the patentee's firm from working the patent (*x*).

Form and effect of assignment.

An assignment of a patent must be by deed (*y*), but an equitable assignment may be placed on the register (*z*).

An assignment of a patent does not, in the absence of express covenant, warrant the validity of the patent (*a*); nor does a sale of a patented article warrant that the patent is valid or that it does not infringe another patent (*b*). And in an action by the vendor for specific performance of an agreement to purchase a patent, a defence that the patent was invalid was struck out as embarrassing under S. C. R. Order XXVII, r. 1 (*c*).

Mortgagor and mortgagee.

Where the assignees of a patent by way of mortgage were not registered as proprietors but as mortgagees, it was held that the mortgagor might sue alone without joining the registered mortgagees (*d*), and it would seem that this would be the case even if the mortgagees were registered as proprietors (*e*).

C. B. (N.S.) 209; *Walton* v *Lavater*, 8 C. B. (N.S.) 162; *Sheehan* v. *Great Eastern Rail. Co.*, 16 Ch. D. 59; *Steers* v. *Rogers*, [1892] 2 Ch. 13, on appeal [1893] A. C. 232; *Mathers* v. *Green*, L. R. 1 Ch. 29. See also *Hancock* v. *Beurley*, Johns. 601.

(*t*) See, however, as to licences, *Powell* v. *Head*, 12 Ch. D. 686, 690, p. 469, *post*.

(*u*) *Kenny's Patent Buttonholeing Co.* v. *Somerville*, 26 W. R. 787.

(*x*) *Howard* v. *Tweedales*, 12 R. P. C. 519.

(*y*) *Casey's Patents*, [1892] 1 Ch. 104.

(*z*) *Ibid.*

(*a*) *Hall* v. *Conder*, 2 C. B. (N.S.) 22; *Smith* v. *Neale*, *ibid.*, 67; 26 L. J., C. P. (N.S.) 143.

(*b*) *Monforts* v. *Marsden*, 12 R.P.C. 266.

(*c*) *Liardet* v. *Hammond Electric etc. Co.*, 31 W. R. 710.

(*d*) *Van Gelder, etc. Co.* v. *Sowerby Bridge, etc. Society*, 44 Ch. D. 374.

(*e*) *Ibid.*

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Note. "Assigns."

Where a patent was assigned to two persons who covenanted that they, "their executors, administrators, and assigns," would endeavour to introduce the patent apparatus into use, and that the patentee should receive a certain percentage on the profits derived by them "or the survivor of them, or the executors or administrators of such survivor, their or his assigns," it was held that a company purchasing with notice of this covenant were bound by it and must account to the patentee (*f*).

Future patent rights.

An agreement by a vendor of a patent to assign to a purchaser all future patent rights which the vendor may "hereafter acquire of a like nature to the patent sold" is not void as against public policy (*g*).

Improvements.

A covenant to assign improvements of which the assignor shall become possessed will not extend to patented improvements of which the assignor is only part owner with others (*h*).

Where in a deed of assignment the patentee covenanted to communicate to the plaintiffs, and render available for their exclusive benefit, all further improvements which might be made by him in connection with a certain invention relating to a particular manufacture, it was held that an interlocutory injunction to restrain the patentee from selling, dealing with, or communicating, or disposing of to any person other than the plaintiffs, any invention relating to the particular manufacture, could not be granted, as that would be compelling specific performance of the covenant on an interlocutory application (*i*).

What are improvements.

When persons engaged in manufacturing a patented machine set about experiments to remedy defects in it and alter the machine for that purpose, that is an "improvement" of the original machine (*j*). Ordinarily speaking, an improvement *of* an invention would mean a development of it (*k*). A contrivance differing largely from another may be an improvement *upon* it without being an improvement *of* it (*l*). And an invention may be an improvement within a clause as to improvements though not an infringement of the original patent (*m*).

Need not be under seal.

"**License.**"—The right of a patentee to grant licences is derived from the patent itself. By the patent the Crown grants to the patentee the

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(*f*) *Werderman* v. *Société Générale d'Electricité*, 19 Ch. D. 246.

(*g*) *Printing and Numerical Registering Co.* v. *Sampson*, L. R. 19 Eq. 462. See also *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 345.

(*h*) *Pneumatic Tyre Co.* v. *Dunlop*, 13 R. P. C. 553.

(*i*) *London & Leicester Hosiery Co.* v. *Griswold*, 3 R. P. C. 252.

(*j*) *Wilson* v. *Barbour*, 5 R. P. C. 686.

(*k*) *Ibid*, p. 254.

(*l*) *Ibid.*

(*m*) *Wilson* v. *Barbour*, 5 R. P. C. 245, 675.

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sole privilege, etc., that "the said patentee by himself, his agents, or licensees and no others," may use the invention during the specified term. The Crown then prohibits all persons from practising the invention during the term "without the consent, licence, or agreement of the said patentee in writing under his hand and seal." But notwithstanding these words it was held in *Chanter* v. *Dewhurst* (*n*) that a licence to persons to manufacture and use the patented machine need not be under seal. "To grant a licence not under seal may be a contempt of the Crown, but does not exempt the man to whom it is granted and who derives a benefit from it from paying the price of it" (*o*). And if parties by writing not under seal agree the one to grant and the other to accept, a licence, then in equity they stand in the same position as if the formal legal document had been executed, and on the one hand the grantees are bound to pay the royalties, and on the other hand the grantors are in the same position as if they had executed a licence and the powers stipulated for had been actually reserved (*p*).

Where there had been negotiations, but no concluded agreement, between the plaintiff and defendants for a licence by deed to use the plaintiff's patented invention, and the defendants had agreed to pay and did pay royalties and used the patented articles, it was held that there was a licence during a period covered by the agreement, and the defendants were held liable to account as licensees (*q*).

Not a grant of the patent.

A licence to use a patented invention, even though it is exclusive and for a limited time, is not in any sense a grant of the Letters Patent, but is simply a licence to do that which without that licence would be a violation of the monopoly of the patentee (*r*).

Therefore an exclusive licence is *not equivalent to an assignment*, and the exclusive licensee cannot, without the concurrence of the patentee, sue infringers (*s*).

Mutual covenants going to the whole consideration.

An ordinary licence generally contains covenants on the part of the licensor and of the licensee. Where these are mutual covenants and go to the whole of the consideration on both sides, they are mutual conditions the one precedent to the other. But when they go only to a part of the consideration, when a breach may be paid for in damages, then the defendant has a remedy on his covenant and cannot plead it as a condition precedent (*t*).

(*n*) 12 M. & W. 823.

(*o*) *Per* ALDERSON, B., *Chanter* v. *Dewhurst*, *ubi supra*.

(*p*) See *per* STIRLING, J., *Post Card Automatic Supply Co.* v. *Samuel*, 6 R. P. C. 560, 562.

(*q*) *Tweedale* v. *Howard and Bullough*, 13 R. P. C. 522.

(*r*) *Heap* v. *Hartley*, 42 Ch. D. 461, judgment of COTTON, L. J., 469.

(*s*) *Heap* v. *Hartley*, *ubi supra*.

(*t*) See *per* Lord MANSFIELD, C.J., *Boone* v. *Eyre*, 1 H. Bl. 273 n.

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Thus where there was an agreement that the defendants should have the exclusive right to use certain inventions comprised in several patents, and should pay to the plaintiff an annuity as the consideration for such licence, and one of the patents was void, it was held that the consideration was entire and the payment to be made by the defendants was entire, and the consideration having failed partially had therefore failed entirely, and that no action for the annuity would lie (*u*).

Independent covenants.

But where there was an agreement that in consideration of 500*l.* to be paid by the defendant to the plaintiff, the plaintiff would teach the defendant the invention and permit him to use it, and the plaintiff in consideration of 250*l.* paid and of the further sum of 250*l.* covenanted to be paid by the defendant, covenanted to teach the defendant, and the defendant covenanted to pay the further sum of 250*l.*, it was held that the plaintiff might sue on the covenant to pay without averring that he had taught the defendant as agreed. And Lord Kenyon, C.J., said that the agreement of the plaintiff having been executed in part by transferring to the defendant a right to exercise the patent, he ought not to keep that right without paying the remainder of the consideration because he might have sustained some damage by the plaintiff not having instructed him (*v*).

So also in *Otto* v. *Singer* (*w*), the patentee, before the filing of his complete specification, granted a licence to use the invention for a year certain, and then from year to year on payment of certain royalties and covenanted to complete the patent and to defend it in the event of its being contested, and that if the patent was declared void by a court of law the royalties should cease, with power for either party to determine the licence. While the licence was in force the defendants refused to pay royalties after the first year, on the ground that the Letters Patent were obtained for an invention less than the whole of that described in the provisional specification. It was held by Denman, J., without deciding the latter question, that as the right to use the invention passed by the deed, there had not been a total failure of the consideration, and that the royalties must be paid.

And in *Mills* v. *Carson* (*x*), the patentee granted an exclusive licence for the unexpired term of the patent at a fixed yearly sum, payable on certain named days, the last of which was shortly after the last day of the term. The licence contained the usual covenant by the licensees to pay the royalty, and covenants by the patentee for quiet enjoyment by the licensees, and that he would take proceedings against infringers,

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(*u*) *Chanter* v. *Leese*, 4 M. & W. 295; 5 M. & W. 698; 1 Webst. 295.

(*v*) *Campbell* v. *Jones*, 6 T. R. 573. See also *Cutler* v. *Bower*, 11 Q. B. 973.

(*w*) 7 R. P. C. 7.

(*x*) 10 R. P. C. 12.

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and that if by reason of his not taking proceedings the patent should become void or ineffectual, the royalties should determine. And the patentee also entered into the usual covenant as to improvements. The patent lapsed through non-payment of the renewal fees by the patentee. The defendants declined to pay the royalties any longer, alleging that the non-payment of the renewal fees was a breach of the covenant for quiet enjoyment. It was held by the Court of Appeal, that even assuming this was so, the covenant for quiet enjoyment and the covenant to pay royalties were independent covenants, and the defendants were bound to pay the royalties, notwithstanding the patent had lapsed.

And where there was a licence to use several patented inventions "during all the residues then unexpired of the terms granted by the Letters Patent respectively," and the licensees covenanted to pay a certain royalty "in respect of all steel produced by them during the continuance of the licence in the production of which the said inventions or any of them should be employed," and it was also provided that the royalties should continue "until the expiration by effluxion of time of all the terms" of the patents, it was held that the royalties must be paid so long as any of the patents were in existence, although the patents which covered the process actually used by the licensees had expired (*y*).

Implied covenants.

The Court will not imply contracts or covenants in deeds, unless the inference that such contracts or covenants were in the contemplation of the parties is irresistible (*z*). And, therefore, where in an exclusive licence the grantor entered into express covenants for quiet enjoyment by the licensees, and as to taking proceedings against infringers and as to improvements, the Court of Appeal refused to imply a further covenant by the patentee to pay the fees necessary to keep up the patent (*a*).

So, also, where in a deed of assignment of a patent for a lump sum and the other considerations therein appearing, the patentee covenanted for quiet enjoyment of the patent by the assignees "during the term subsisting therein," and the assignees covenanted to pay to the patentee a royalty for every article which should be manufactured or sold by the assignees under the patent "while subsisting," it was held that there was no implied covenant on the part of the assignees to keep up the patent, and in the same case it was held, in the absence of express

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(*y*) *Siemens* v. *Taylor*, 9 R. P. C. 393.

(*z*) *Per* LOPES, L.J., *Mills* v. *Carson*, 10 R. P. C. 12, 19; *Hamlyn* v. *Wood*, [1891] 2 Q. B. 488. See also *Catlan* v. *Dawson*, 14 R. P. C. 249.

(*a*) *Mills* v. *Carson*, 10 R. P. C. 12.

covenant, that there was no obligation on the part of the assignees to manufacture the patented articles (*b*).

NOTE.

But an exclusive licence implies on the part of the grantor a covenant not himself to use the invention (*c*), and also a contract not to grant leave to anyone else to use it (*d*).

Where in an exclusive licence the patentees covenanted to protect and defend the patent from all infringement, and that in default of their doing so the royalties should cease to be payable, and the patent lapsed by reason of non-payment of duties by the patentees, it was held in an action for royalties, that there being an express obligation to protect, the case of *Mills* v. *Carson*, cited above, did not apply, and that the royalties had ceased to be payable (*e*).

Revocation of licence.

If there is a simple licence to use the invention on payment of royalty, no term being specified, the licensee may at any time put an end to the license, and will then not be liable to pay the royalty. This was decided in *Crossley* v. *Dixon* (*f*), where the respondent was manufacturing under a verbal agreement on payment of a royalty on certain machines supplied to him by the appellant, and afterwards used other machines, which infringed the patent, and it was held that so long as the agreement subsisted the respondent could not dispute the validity of the patent. But it was held that the licensee might put an end to the agreement under the liability, of course, to be treated as an infringer, and a decree of the court below, which had directed an inquiry as to infringing machines unlimited in point of time, was varied by confining it to machines bought during the continuance of the agreement. And on the authority of this case, it was held in *Redges* v. *Mulliner* (*g*), where by an agreement in writing a patentee granted a right to manufacture under the patent, subject to the payment of a royalty for each article manufactured, that the licensee could determine the licence, and that having done this and paid into court a sum which he alleged was sufficient to cover the royalties on articles made while the licence subsisted, he was not liable to render any further account except at the plaintiff's risk.

An exclusive licence containing mutual covenants imposing obligations both on the licensor and licensee is not in the absence of an express power of revocation revocable by the licensor (*h*) nor, apparently,

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(*b*) *Re Railway and Electric Appliances Co.*, 38 Ch. D. 597.

(*c*) *Guyot* v. *Thomson*, [1894] 3 Ch. 397, LINDLEY, L.J.

(*d*) *Heap* v. *Hartley*, 42 Ch. D. 470, *per* FRY, L.J.

(*e*) *Lines* v. *Usher*, 13 R. P. C. 685; 14 R. P. C. 206.

(*f*) 10 H. L. C. 293.

(*g*) 10 R. P. C. 25.

(*h*) *Guyot* v. *Thomson*, [1894] 3 Ch. 388.

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by the licensee (*i*). In such a case the remedy for breach of any of the covenants is by action (*j*).

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What sufficient notice to revoke.

Where the owners of a patent entered into an agreement by deed that they would grant to a certain company a licence to use the invention, during the continuance of the patent, upon certain specified terms and conditions, it was held that the licence having been forfeited by breach of the conditions, a letter was a sufficient indication of the intention of the patentee to take advantage of the forfeiture, and that an instrument under seal was not necessary to determine the licence (*k*).

But an allegation in a pleading that a licence has been determined is not a sufficient notice to determine (*l*).

Grounds of revocation.

Where a licence was to determine if the patent were held invalid, and a judgment which had been obtained against the patent was afterwards reversed on terms of compromise, it was held that the judgment could not be relied upon, and that the licence was still in force (*m*).

Where the patentee granted an exclusive licence to use the invention and to sell the articles manufactured according thereto, when and as the licensees should think fit, it was held that they were not bound to manufacture according to the precise details of the specification (*n*).

Waiver of right to revoke.

Where a licence was determinable by the licensors, on failure by the licensees to pay an annual minimum royalty which they covenanted to pay and the licensors accepted a less annual sum, it was held that they had thereby elected not to act on previous breaches of the covenant as grounds of forfeiture, and could not on those breaches determine the licence (*o*).

Covenant to endeavour to develop sale.

Where there was an agreement between the plaintiff, the patentee, and the defendants that the latter should manufacture the patented machines and pay the plaintiff a royalty, and that the defendants should use their best endeavours to develop the sale of the machines, and that all future improvements on the patent, whether invented by the plaintiff or the defendants, should "belong to the patent," it was held that the defendants, having pushed the sale of a number of machines fitted with a certain apparatus invented by themselves, but which were

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(*i*) *Grayden* v. *Basset*, 13 R. P. C. 537, 543, 545; *S. C.* on appeal to H. L. 14 R. P. C. 701.

(*j*) *Guyot* v. *Thomson*, *ubi supra*, p. 394, ROMER, J.

(*k*) *Ward* v. *Livesey*, 5 R. P. C. 102.

(*l*) *Cheetham* v. *Nuthall*, 10 R.P.C. 321, 333.

(*m*) *Cheetham* v. *Nuthall*, 10 R. P. C. 321.

(*n*) *Guyot* v. *Thomson*, [1894] 3 Ch. 388, 394, ROMER, J.

(*o*) *Warwick* v. *Hooper*, 3 M. & G. 36.

improvements within the meaning of the agreement, for which they had not paid any royalty, had not used their best endeavours to develop the sale of the patented machines and were liable in damages (*p*).

In such a case the measure of damages was the royalties on the machines fitted with the defendants' apparatus, and it was held that the plaintiff could not in addition recover damages for breach of contract (*q*).

Conditions.

The patentee may impose whatever conditions he thinks fit on the use by the licensee of the invention (*r*), as, for instance, that there shall be affixed to the articles sold licence plates purchased from the patentee (*s*), or that the article shall be stamped with particular words in a particular part (*t*), or that it shall be used only in a particular manner (*u*). And these conditions may be enforced by injunction (*v*).

But in order that a restrictive condition may be enforced against a purchaser of the article, it must be brought to his mind at the time of sale (*x*).

As to licences for a limited district, see *ante*, p. 338.

Where there was a licence to use the invention within the United Kingdom for the purpose of applying it to the wheels of bicycles made by the licensees, with a proviso that the licence should not authorize the licensees to make articles according to the invention to be applied to the wheels of bicycles made by any person other than the licensees, and that the licence should only authorize the use of the invention by the licensees jointly, or such of them as should carry on the business now carried on by the licensees at a certain place named, it was held that the assignees of the licence were not limited to the original business of the licensees, but might start other businesses elsewhere and apply the patent article to bicycles made by them in such other businesses (*y*).

The grant of the sole right of constructing a patented machine does not imply a right to use it when constructed (*z*).

Estoppel.

When a defendant in answer to an action for infringement set up on the motion for injunction an agreement for a licence, which the plaintiff alleged was revoked, and also alleged the invalidity of the

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(*p*) *Wilson* v. *Barbour*, 5 R. P. C. 245, 675.

(*q*) *Wilson* v. *Barbour*, *ubi supra*.

(*r*) *Incandescent Gas Light Co.* v. *Cantelo*, 12 R. P. C. 262, 264.

(*s*) *Grover & Baker Sewing Machine Co.* v. *Millard*, 8 Jur. (N.S.) 713.

(*t*) *Crossthwaite* v. *Steel*, 6 R. P. C. 190.

(*u*) *Incandescent Gas Light Co.* v. *Cantelo*, *ubi supra*.

(*v*) *Grover & Baker Sewing Machine Co.* v. *Millard*; *Crossthwaite* v. *Steel*, *ubi supra*.

(*x*) *Incandescent Gas Light Co.* v. *Cantelo*, *ubi supra*.

(*y*) *Bourn* v. *Humber*, 6 R. P. C. 9.

(*z*) *Basset* v. *Graydon*, 14 R. P. C. 701.

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patent, and being put to his election whether he would insist on his rights under the licence, or dispute the validity of the patent, elected to take the latter course, he was ordered to pay the costs of the motion for injunction, and to remove from the articles he was using the words "manufactured under licence from A B" (*a*).

A patentee accepting royalties from the assignee of a licence granted by him cannot dispute the validity of the assignment (*b*).

A person who constructs a patented machine under an agreement giving him the "sole right of constructing" is a licensee, and cannot dispute the validity of the patent (*c*).

Register of Proprietors Act of 1852.

By the Act of 1852 (*d*) a "register of proprietors" was required to be kept at the Great Seal Patent Office, in which an entry of all assignments of letters patent, or of any interest or share, was to be made, and all licences, etc., and it was provided that until such entry should have been made the grantee of the letters patent should be deemed the sole proprietor thereof.

Under this section it was held, in *Chollet* v. *Hoffman* (*e*), that an assignee could not sue until his assignment had been registered, otherwise, as the statute provides that before such registry the original patentee shall be deemed the sole owner, a defendant would be liable to be sued at one and the same time by the grantee and assignee of the letters patent. The reasoning in this case appears equally to apply to the present section, and it would seem that under this present Act, as under the Act of 1852, registration of the assignment is necessary to enable an assignee to maintain an action for infringement.

The case of *Chollet* v. *Hoffman* was, however, a case of litigation between the assignee of a patent and third parties. As between the assignor and assignee the rule was held not to apply, and an assignee might maintain a suit against the assignor, and licensees from the assignor subsequent to and with notice of the assignment, although the assignment has not been registered (*f*).

It was not decided whether and how far the registration of an assignment related back. In *Chollet* v. *Hoffman* the court expressly refused to decide the point, but in *Hassall* v. *Wright* it seems to have been the opinion of Sir RICHARD MALINS, V.-C., that registration under the Act of 1852 related back to the date of the assignment, and that

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(*a*) *Post Card Automatic Supply Co.* v. *Samuel*, 6 R. P. C. 560.

(*b*) *Lawson* v. *Donald Macpherson & Co.*, 14 R. P. C. 696.

(*c*) *Basset* v. *Graydon*, 14 R. P. C. 701 (H. L.).

(*d*) 15 & 16 Vict. c. 83, s. 35.

(*e*) 7 E. & B. 636.

(*f*) *Hassall* v. *Wright*, L. R. 10 Eq. 510.

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an assignee whose assignment was registered might maintain a suit to restrain infringement instituted after the date of the assignment and before registration.

An assignment by executors of a patentee made after probate, but before the probate was registered, the assignment itself being registered after the registration of the probate, gave under the Act of 1852 a valid title to the assignee to sue (*g*).

In an action for infringement brought under the Act of 1852, it was objected that the plaintiff had not proved his title, because the title of his assignors only appeared by a recital in the assignment to him, but the objection was not pressed. It was, however, held by the Court of Appeal that the objection, if pressed, would not have been allowed to prevail, since the defect might have been cured under Supreme Court Rules, Ord. LVIII. r. 4 (*h*).

Upon the bankruptcy of a patentee, letters patent which have been granted to him will vest in the trustee (*a*), and he may therefore maintain a suit to restrain infringement committed before the bankruptcy; but it is presumed that the title of the trustee must be registered.

Letters patent granted to any person vest on his death in his executor or administrator (*b*), who may sue in respect of an infringement committed during the life of the patentee (*c*), the probate of the will being previously registered in the Great Seal Patent Office. See also s. 34.

The register will apparently be conclusive as between persons interested in the patent and third parties, who, it would seem, may safely, in the absence of notice of other claims, deal with the persons appearing on the register.

It is the practice of the Patent Office to register mortgagees not as proprietors of the patent but only as mortgagees, and this practice is right (*d*).

DESIGNS.

In *Powell* v. *Head* (*e*) it was held by JESSEL, M.R., that one part owner of the copyright of a dramatic entertainment could not grant a licence for its representation without the consent of all the other owners. This decision was grounded on the provision of the 3 &

(*g*) *Ellwood* v. *Christy*, 17 C. B. (N.S.) 754; 10 Jur. (N.S.) 1079.

(*h*) *Nordenfelt* v. *Gardner*, 1 R. P. C. 61, 73.

(*a*) *Hesse* v. *Stevenson*, 3 Bos. & P. 565; *Bloxam* v. *Elsee*, 6 B. & C. 169; *S. C.* 9 Dowl. & R. 215.

(*b*) Williams on Executors, 9th ed. Vol. I., p. 724. See also Form of Patent, *post*, p. 504.

(*c*) Hindmarch on Patents, p. 252.

(*d*) See *per* COTTON, L.J., *Van Gelder* v. *Sowerby*, *etc.*, 44 Ch. D. 389.

(*e*) 12 Ch. D. 686.

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4 Will. 4, c. 15, forbidding representation except with the consent of the "author or other proprietor," which words, by the effect of s. 4 of the same statute, meant "authors or other proprietors." On similar grounds it would seem that, since s. 58 of the present Act requires the consent of the *registered proprietor to the use of a registered design*, and by 52 & 53 Vict. c. 63, words in an Act of Parliament importing the singular include the plural, the consent of all the registered proprietors is necessary, and that one of several registered co-owners cannot alone grant a licence for the use of a design.

Similar reasoning seems to show that, whatever may have been the law hitherto, a valid licence for the use of an invention comprised in a joint patent can only be made with the concurrence of all the grantees whose names appear on the Register of Patents.

Trade Marks.

As to assignment of trade marks, see s. 70.

Where two persons who carried on distinct trades at different places of business had derived from a common predecessor in the respective businesses the right to use one and the same particular name as a trade mark, each was held entitled separately to sue to restrain infringement (*f*).

When on a dissolution of partnership between A, B, and C, it was agreed that A, B, and C, and any partners they might take respectively, were to have the common use of all trade marks of the firm, it was held that they could not separately grant licences to use the trade marks, and further, that when one of them was a shareholder and director of a limited liability company, and also had debenture stock in the company he was not a partner with the company, and it could not use the marks (*g*).

Inspection of and extracts from registers.

86. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (*h*).

(*f*) *Dent* v. *Turpin*, 2 J. & H. 139.

(*g*) *Hanson* v. *Game*, 9 R. P. C. 186.

(*h*) P. R. rr. 78, 79; D. R. rr. 33, 34; T. M. R. rr. 52, 60, *post*.

By the Act of 1888, s. 22, this section is amended as follows :— Sect. 88.

In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

This section must be read (so far as it relates to the register of designs) as subject to the provisions of ss. 52 and 53.

Sealed copies to be received in evidence

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

A re-enactment, with alterations, of 16 & 17 Vict. c. 115, s. 4. By that Act the sealed copies were receivable in evidence in all proceedings relating to letters patent for inventions. The present section is general, *and applies to all proceedings.*

Rectification of registers by court.

90. (1.) The Court may (*i*) on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making expunging or varying the entry, as the Court thinks fit ; or the Court may refuse the application ; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(*i*) P. R. r. 74 ; D. R. rr. 27, 28 ; T. M. R. rr. 46, 49, 50, *post*.

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(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

By the Act of 1888, s. 23, this section is amended as follows :—

In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

This section combines the powers of the Act of 1852, s. 38, and the Act of 1875, s. 5, and makes these provisions applicable to all the subjects of this Act. "Making," an entry is, as to patents, an addition to the old powers.

In a trade mark case it was held, under the Act of 1875, that the powers of rectification of the register are only exercisable in cases of mistake or error in the registration, and not where there is a mere devolution of interest (*k*). In such a case the proceeding should be under s. 87, *ante*.

"The Court."—In *King & Co.'s Trade Marks* (*l*), it was held by the Court of Appeal that the High Court of Justice in England has jurisdiction to rectify the register of trade marks, although the registered proprietor may be domiciled in Scotland or Ireland. But the question whether the Scotch and Irish Courts have jurisdiction in such a case was left undecided. In *Bayer* v. *Connell* (*m*), it was held by PORTER, M.R., that the Irish Courts have no such jurisdiction. On the other hand, in *Cowie* v. *Herbert* (*n*), in a Scotch case, the objection was not taken, and the Lord Ordinary therefore assumed that he had jurisdiction, though he stated that s. 111 (*post*), on which it seemed to depend, is very obscure. In the result, the rectification in this case was not insisted on, and the application was dismissed.

PATENTS. (See P. R., *post*, r. 74.)

Under the corresponding section of the Act of 1852 (*o*), by which the jurisdiction was given to the Master of the Rolls alone, it was held that any entry fraudulently made on the register could be expunged, and that any facts relating to the proprietorship could be entered, but not the legal inferences from those facts (*p*).

(*k*) *Re Ward, Sturt, and Sharp's Trade Marks*, 29 W. R. 395.
(*l*) [1892] 2 Ch. 462, 480.
(*m*) 14 R. P. C. 275.
(*n*) 14 R. P. C. 436, 444.
(*o*) Section 38.
(*p*) *Re Morey's Patent*, 25 Bea. 581.

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NOTE.

Thus, where a patentee, having assigned his patent to persons who omitted to register the assignment, afterwards assigned the patent to his father, which assignment was registered at once, the Master of the Rolls ordered the entry of the latter assignment to be expunged (*q*). In this case it appears from the subsequent case of *Re Morey's Patent* (*r*), that there was evidence that the second assignment was clearly fraudulent.

And so, also, an entry made by one of two joint patentees of a deed whereby he assigned his share of the patent, and purported to release his assignee from all claims by himself and his co-patentee, was expunged at the instance of the latter (*s*).

But where a patentee assigned half his patent to A., and afterwards assigned the whole to B. by a deed reciting that he had already granted a licence to A., and B.'s assignment was first registered, Lord ROMILLY, M.R., although holding that B. had on the face of the deed notice of A.'s right, would not (there being no other evidence of notice) enter a statement to that effect on the register, but ordered an entry to be made that the licence referred to in the assignment to B. was the deed of assignment to A. (*t*).

And where a deed is perfectly good and *bonâ fide*, it would seem that no entry could be made on the register qualifying its effect or giving it a construction (*u*).

In *Re Horsley and Knighton's Patent*, cited above, it was contended that the entry ought not to be expunged, as so far as the entry stated the deed to be an assignment it was correct. But Lord ROMILLY, M.R., held that, as he could not alter the deed, the only course was to strike out the whole entry.

In *Re Berdan's Patent* (*x*), it was held that the Master of the Rolls, as Keeper of the Records, had power to order a disclaimer, which had been filed without the consent of the patentee, to be taken off the file. This jurisdiction would seem to be strictly within the present section, "amendments" being entered in the register of patents (see s. 23).

Orders made by the Master of the Rolls under the Act of 1852, s. 38, were not, prior to the Judicature Acts, subject to appeal (*y*), but by these Acts the jurisdiction was transferred to the High Court of Justice, and could be appealed like any order of the court (*z*).

(*q*) *Re Green's Patent*, 24 Bea. 145.

(*r*) 25 Bea. 584.

(*s*) *Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

(*t*) *Re Morey's Patent*, 25 Bea. 581.

(*u*) *Per* Lord ROMILLY, M.R., *Re Morey's Patent*, 25 Bea. 584.

(*x*) L. R. 20 Eq. 347.

(*y*) *Re Horsley and Knighton's Patent*, L. R. 4 Ch. 784.

(*z*) *Re Morgan's Patent*, 24 W. R. 245; *Re Myer's Patent*, W. N. 1882, 53, 56.

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Designs.

Note.

A design not sufficiently new or original which has been registered may, at the instance of a person sued for alleged infringement of it, be removed from the register under this section (*a*), even though it may have been independently invented by the registered proprietor (*b*).

On a motion to rectify the register by striking out the name of the person registered as proprietor and substituting the name of the applicant on the ground that he is the author of the design or the proprietor under s. 61 (*ante*, p. 374), the burden of proof is on the applicant (*c*).

Four clear days' notice of every application under this section for rectification of the register of designs is to be given to the comptroller (*d*).

Trade Marks.

"**Person aggrieved.**"—"Any trader is," in the sense of the statute, "aggrieved whenever the registration of a particular trade mark operates in restraint of what would otherwise have been his legal rights" (*e*).

Thus "whenever *one trader, by means of his wrongly registered* trade mark, narrows the area of business open to his rival, and thereby either immediately excludes or, with reasonable probability will, in the future, exclude a rival from a portion of that trade into which he desires to enter, that rival is an aggrieved person. Again, if the effect produced, or likely to be produced, by the wrongful trade mark, is not the exclusion but the hampering of a rival trader, that rival trader again is an aggrieved person. A man in the same trade as the one who has wrongfully registered a mark and who desires to deal in the article in question, is *primâ facie* an 'aggrieved person'" (*f*).

And persons are "aggrieved" who are in some way or other substantially interested in having the mark removed from the register or persons who would be substantially damaged if the mark remained (*g*).

Upon these principles a person against whom an injunction is sought to restrain the use of a registered trade mark (*h*), and the defendant

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(*a*) *Le May* v. *Welch*, 28 Ch. D. 24; *Smith* v. *Hope*, 6 R. P. C. 200; *Bach's Design*, 42 Ch. D. 661; *Plackett's Design*, 9 R. P. C. 438; *Clarke's Design*, [1896] 2 Ch. 44.

(*b*) *Smout* v. *Slaymaker*, 7 R. P. C. 90.

(*c*) *Heinrich's Design*, 9 R. P. C. 73.

(*d*) D. R., r. 27.

(*e*) *Per* Lord Watson, *Powell* v. *Birmingham Vinegar, etc. Co.*, [1894] A. C. 12.

(*f*) *Per* Fry, L.J., *Apollinaris Trade Marks*, [1891] 2 Ch. 186, 225.

(*g*) *Per* Bowen, L.J., *Powell's Trade Mark*, [1893] 2 Ch. 388, 406. See as to "substantially," *Re Wright, Crossley & Co.*, 15 R. P. C. 131.

(*h*) *Ralph's Trade Mark*, 25 Ch.D. 194, 198.

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in an action seeking to restrain him from using a certain name for his goods when the plaintiff sues on the ground that the name is substantially the same as a registered mark of the plaintiff (*i*) and a dealer who has used a particular word in connection with the article in which he deals (*k*), and a person whose application to register a mark has been *refused by reason of the existence of a rival mark on the register* (*l*), have been held to be "persons aggrieved" within the Act.

So, also, defendants in an action for infringement of a trade mark, who themselves have a mark registered in the same class as the plaintiff's mark, are "persons aggrieved" (*m*). But as to certain classes in which the defendants' trade mark was not, but the plaintiff's was, registered, it was held that the defendants were not "persons aggrieved" and must fail as to these classes (*n*).

And certain champagne growers who had registered as trade marks for champagne the words "Monopole" and "Dry Monopole," were held (whether their own marks were or were not good trade marks) to have a sufficient interest in the question whether a mark "Monobrut," which had been registered for champagne by a rival firm, should remain on the register to entitle them as "persons aggrieved" to expunge it as being merely descriptive (*o*).

Under the corresponding s. 5 of the Act of 1875, it was held that a person may be aggrieved, within that section, by the entry of a trade mark on the register, though not himself entitled to register the mark (*p*).

And where the words "Yorkshire Relish" had been registered as a name for a sauce, persons in the same trade, though not at the time intending to sell that particular sauce, though if the mark were removed they might possibly do so, were held entitled as "persons aggrieved" to move to expunge the mark from the register (*q*).

And foreigners not carrying on or intending to carry on business in England, may be "persons aggrieved" by the wrongful registration of a trade mark in this country (*r*).

And the fact that persons have agreed with the owners of a registered trade mark to act as their sole agents, and to sell under the mark only articles supplied by such owners, does not prevent their being

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(*i*) *Gianaclis' Trade Mark*, 6 R. P. C. 467.

(*k*) *Rose* v. *Evans*, 48 L. J. Ch. 518; *Ralph's Trade Mark*, 25 Ch. D. 194.

(*l*) *Batt's Trade Mark*, 6 R. P. C. 494.

(*m*) *Baker* v. *Rawson* 45 Ch. D. 519.

(*n*) *Ibid.*

(*o*) *Vignier's Trade Mark*, 6 R.P.C. 490.

(*p*) *Re Riviere's Trade Mark*, 26 Ch. D. 54.

(*q*) *Powell's Trade Mark*, [1893] 2 Ch. 388, affirmed in H. L. See *Powell* v. *Birmingham Vinegar, etc. Co.*, [1894] A. C. 8.

(*r*) *Re Riviere's Trade Mark*, 26 Ch. D. 54.

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"persons aggrieved" within the present section if the mark is not properly on the register, and they may move to have it struck off the register (*s*).

Where English consignees from a foreign manufacturer had registered under an alleged agreement with him the foreigner's trade mark in their own name, the purchasers of the foreign business were held entitled as "persons aggrieved" to move to expunge the registration (*t*).

"**Entry made without sufficient cause.**"—Where the circumstances are such that, if the applicant for rectification had been opposing the registration, the comptroller would have been justified in refusing to register, the entry has been made without sufficient cause (*u*).

But if the trade mark on the register is one which is not in itself illegal or improper, it will not be removed from the register merely because at the date of registration its registration might have been perhaps successfully opposed by some third party who did not in fact oppose it (*x*).

A trade mark wrongly registered will not be allowed to remain on the register on the ground that if removed it could by reason of change of circumstances be at once re-registered, as the public ought, by means of advertisements, to have the opportunity of opposing the new application (*y*).

The purity of the register is of much importance to the trade in general, apart from the merits or demerits of particular litigants. And therefore if on a motion to expunge, the attention of the court is called to an entry on the register of a trade mark which cannot in law be justified as a trade mark, the duty of the court may well be, whatever the demerits of the applicant, to purify the register and to expunge the illegal entry in the interests of trade (*z*).

The section presupposes the mark to be on the register, and does not enable the court to order the comptroller to register a trade mark which he has refused to register on the ground that it was not a trade mark within s. 64 of the Act. In such a case the applicant must appeal to the Board of Trade under s. 62 (4), *ante*, p. 376, (*a*).

Common mark

If a mark which is common to the trade, or which contains words or devices common to the trade, has got on the register, it may, on the

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(*s*) *Ainslie & Co.'s Trade Mark*, 4 R. P. C. 213.

(*t*) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

(*u*) *La Société Anonyme des Verreries de l'Etoile*, [1894] 1 Ch. 61.

(*x*) *Paine* v. *Daniell & Sons' Breweries*, [1893] 2 Ch. 567, 585.

(*y*) *Apollinaris Co's Trade Mark*, [1891] 2 Ch. 186.

(*z*) *Per* BOWEN, L.J., *Paine* v. *Daniell's Breweries*, [1893] 2 Ch. 567.584. See also *Re Talbot's Trade Marks*, 11 R. P. C. 77, 81; *Re Wright, Crossley & Co.*, 15 R. P. C. 131.

(*a*) *Re Trade Mark "Normal,"* 35 Ch. D. 231, 246.

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removed or note added to register.

application of other persons in the same trade, be removed (*b*), even after the lapse of five years (*c*); or a note may be added that a particular word (*d*), or a particular device (*e*), or particular words and devices (*f*), in the mark is or are common to the trade; or that the registered proprietor is not entitled to the exclusive use of particular words (*g*), or that a particular device in the mark is not claimed *per se*, but only in combination (*h*). This, however, will not be done in the absence of the registered owner without his consent (*i*). And see now s. 74, (*ante*, p. 435).

Where a word has been wrongly registered as having been "used as a trade mark" when it has not been, in fact, so used, it may be removed from the register on the application of a person aggrieved (*k*).

And when the mark has the effect of causing goods to be known by the name which goods of a previously registered owner have acquired, a note may be added to the register limiting the use of the mark to goods which will not clash with the goods of the owner of the first mark (*l*).

A word originally registered as a trade mark may, by the *laches* of the registered proprietor in enforcing his rights, become common to the trade, and may then be expunged from the register (*m*).

And a new mark which is on the register may be expunged on the motion of the owner of an old mark subsequently registered if the new mark was calculated to deceive (*n*).

Where a foreigner had, under circumstances which the court held to be user, used his trade mark in England, and consignees from him registered the trade mark in their own name without the sanction of the foreigner, who subsequently sold his business and trade mark to an American company, it was held, on the application of the latter, that the entry on the register had been made without sufficient cause, and the registration was expunged (*o*).

(*b*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 724; *In Re Palmer's Trade Mark*, 21 Ch. D. 504; *Leonard* v. *Wells*, 26 Ch. D. 289.

(*c*) *Re Lloyd & Son's Trade Mark*, 27 Ch. D. 646; *Re Wragg's Trade Mark*, 29 Ch. D. 551. See also *ante*, p. 439, under s. 76.

(*d*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

(*e*) *Baker* v. *Rawson*, 45 Ch. D. 519, 535.

(*f*) *Re Leonardt*, Seb. Dig. p. 373.

(*g*) *Re Hayward's Trade Mark*, 54 L. J. Ch. 1003; *Humphries* v. *Taylor Drug Co.*, 5 Times R. 41; W. N. 1888, p. 214; *Burland* v. *Broxburn Oil Co.*, 42 Ch. D. 274; *Thompson* v. *Miller*, 13 R. P. C. 35.

(*h*) *Re Kuhn & Co.*, Seb. Dig., p. 390.

(*i*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

(*k*) *Leonard* v. *Wells*, 26 Ch. D. 289.

(*l*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454.

(*m*) *National Starch Manufacturing Co.* v. *Munn's Patent Maizena, etc. Co.*, [1894] A. C. 275.

(*n*) *Christiansen's Trade Mark*, 3 R. P. C. 55.

(*o*) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

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NOTE.

Although an application to register a mark has been duly advertised, a person who has not seen the advertisement, and who desires to rectify the register in respect of that mark, is not prejudiced by delay if he come to the court with due diligence after the fact has come to his knowledge (*p*), but the delay must be accounted for (*q*).

And when a trader did not move to expunge the mark till the registered owner had commenced an action against him to restrain him from using a similar mark, which he alleged he was entitled to use, it was held that the delay was no answer to the motion (*r*).

When a mark had been registered by the sole consignee in England of wines from a vineyard in Australia, as a trade mark for wines and with the intention only to use it for wines from this vineyard, and the trustees in liquidation of the consignee sold the consignee's business and trade mark to a company who registered themselves as owners of the mark, the register was, on the motion of the owners of the vineyard, rectified by removing the company's name, and inserting the names of the owners of the vineyard as proprietors of the mark (*s*).

Registration in wrong name.

Where a person has registered in his own name the trade mark of another person without the knowledge or consent of the true proprietor, the register of trade marks cannot be rectified by transferring the registration into the name of the true proprietor. The false entry will be expunged, and the true owner must apply in the usual way to register the mark (*t*). And he will not be entitled to an order for substitution of his name as owner of the mark, as every new registration requires fresh advertisements, etc. (*u*).

And when the trade mark of A. had been registered in the name of B., it was held on an application of A. and B. to expunge B.'s name from the register, and insert that of A., that the application, so far as it sought to register the name of A., must be refused, and that A. must apply for registration in the usual way (*x*).

Where a trade mark belonging to a firm has, on an application by one of the partners described as trading under the firm's name, been registered in the name of that partner, the register may be rectified by cancelling the name of that partner as registered proprietor, and inserting the names of all the partners trading under the firm's name (*y*). But

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(*p*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 726.

(*q*) *Ransome* v. *Graham*, 51 L. J. (N.S.) Ch. 903.

(*r*) *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165.

(*s*) *Australian Wine Co.*, 61 L. T. (N.S.) 427.

(*t*) *Ex parte Lawrence Brothers*, 29 W. R. 392. See *Re European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

(*u*) *Re Rivière*, 55 L. J. Ch. 545.

(*x*) *Kingsford & Son's Application*, 6 R. P. C. 413.

(*y*) *Rust & Co.'s Trade Mark*, 29 W. R. 393.

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this could not be done where the registration had been applied for and obtained through a mistake of the firm in the sole name of one of the partners, without any mention of the firm's right to the mark. In such a case the proper course was, under the old practice, for the registered partner to assign the trade mark to the firm (*z*), and this is still the practice (*a*).

When a firm changed their style after registering a trade mark and applied to be registered as proprietors under their new name, the comptroller refused the application on the ground that the alteration could only be made by the court, and on an application to the court under this section, an order was made directing the comptroller to enter on the register the new firm (by its name) "*formerly trading as*," the old firm (naming it) (*b*).

Under the corresponding section of the Act of 1875 (*c*), it was held that the application should be by motion, of which two clear days' notice should be given, and that an affidavit of the applicant verifying his case would be all the evidence that was required (*d*).

If the owner becomes bankrupt after notice of motion has been given the trustee may be added as respondent (*e*).

The burden of proof lies on the person seeking to remove the mark from the register (*f*). His own evidence may be insufficient, but the *onus* is discharged if it appears from the evidence of the owner of the mark that it ought not to be on the register (*g*).

Although the 90th section points to a name it enables any entry improperly made to be struck out (*h*).

When the original maker of a material registered in respect of it, in 1878, the word "Frigidomo" as an old mark, and on a motion made by the defendant in an action for injunction to remove this from the register, on the ground that it had not been used as a trade mark before 1875, it was shown that in 1876, the original maker had registered an arrow as a trade mark for the same article which he described as an article "prepared by him and called by him Frigidomo," and had stated in his application that he had used the arrow as the trade mark for three years before 1876. It was held that the original owner being dead, and the application to expunge not being made till 1889, and then only under the stress of an action for infringement, and in the

(*z*) *Farina's Trade Mark*, 29 W. R. 391.

(*a*) *Greenlees's Trade Mark*, 9 R. P. C. 93.

(*b*) *Patent Plumbago Crucible Co.'s Marks*, 7 R. P. C. 282.

(*c*) 38 & 39 Vict. c. 91, s. 5.

(*d*) *Ex parte Stephens*, W. N., 1876, 202.

(*e*) *Rowe's Trade Mark*, 48 L. T. (N.S.) 388.

(*f*) *Leonard* v. *Wells*, 26 Ch. D. 289. See also *Edgington* v. *Edgington*, 6 R. P. C. 513.

(*g*) *Leonard* v. *Wells*, *ubi supra*.

(*h*) *Arbenz's Application*, 35 Ch.D. 260, 261.

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absence of evidence that anyone but the defendant and the assignee of the original proprietor had ever used the words, the defendant had not discharged the *onus* of showing that the words ought not to be on the register (*i*).

Under s. 5 of the Act of 1875, which, in express terms, enabled an aggrieved person to apply to rectify the register if the name of the person "who is not for the time being entitled to the exclusive use" of the mark is entered on the register, the words "for the time being" were held to apply to the time when the registration is made (*k*).

When an entry has been wrongly made, because the application ought to have been treated under s. 63 as abandoned, the court is not bound to expunge the entry, but may rectify the register by stating the date from which the registration is to run (*l*).

The register cannot be rectified on an application by way of counterclaim (*m*).

Under the 34th rule of the Trade Marks Rules, 1875, a trade mark could be removed at the suit of any person aggrieved, if the registered proprietor were not engaged in any business concerned in the goods within the same class as the goods in respect of which the mark was registered. This rule was acted on in *Re Ralph's Trade Mark* (*n*). This provision is not re-enacted in the present Act or rules; but if there is no real user before or after registration and no *bonâ fide* intention at the date of registration to use the mark it may be expunged from the register (*o*).

Registered owner out of jurisdiction.

A notice of motion to rectify the register by removing a mark registered in the name of a foreigner cannot be served out of the jurisdiction, and the foreigner resident out of the jurisdiction ought not to be named on the notice of motion. The notice of motion should be addressed to the comptroller alone, and a copy sent to the foreigner with an intimation that proceedings are pending which may affect his interests (*p*). And where the applicants resided in Scotland, and had given no address for service, it was held on an appeal by the opponents from a decision of the comptroller allowing registration, that the course above indicated should be followed (*q*). And when the registered proprietor of a trade mark was resident in Ireland it was held that sending him a copy of a notice of motion, addressed to the comptroller, to expunge the mark, with a letter informing him that proceedings had been commenced which might affect his interests was sufficient and the

(*i*) *Edgington* v. *Edgington*, 6 R. P. C. 513.

(*k*) *Wood* v. *Lambert*, 32 Ch. D. 247.

(*l*) *Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(*m*) *Pinto* v. *Badman*, 8 R. P. C. 181, 190.

(*n*) 25 Ch. D. 194.

(*o*) *Batt & Co.'s Trade Mark*, [1898] W. N. 44 (15).

(*p*) *La Compagnie Générale d'Eaux Minérales, etc.*, [1891] 3 Ch. 451.

(*q*) *Robertson, Sanderson, & Co.'s Application*, 9 R. P. C. 213.

court made an order to expunge the mark, although the registered proprietor did not appear (*r*). Sect. 90 (1).

A foreign company having no address for service in this country, but who have had notice of a motion to expunge their trade mark, may appear, and, on submitting to the jurisdiction, be added as respondents without giving security for costs (*s*). NOTE.

Appl cations may be made under this section in relation to old corporate marks placed on the register by the Cutlers' Company under s. 81 (2) (*t*).

When an order is made under this section, the comptroller may, if he thinks any rectification or variation of the register should be made public, publish at the expense of the applicant the circumstances attending such rectification or variation (*u*).

It is convenient that an applicant seeking to expunge a trade mark from the register should state in writing the grounds of his application (*x*).

Four clear days' notice of every application under this section for rectification of the register of trade marks must be given to the comptroller (*y*).

COSTS.

Patents.—In *Re Green's Patent* (*z*), the original assignor and the second assignee, and in *Re Horsley and Knighton's Patent* (*a*), the persons who put the wrong entry on the register, were ordered to pay the costs of rectifying the register; but in *Re Morey's Patent* (*b*), the order was made without costs.

Trade marks.—Where a trade mark, which had, in fact, been common to the trade, had been registered as an old mark by a firm of traders, and it was shown that they had known of its user by other firms for above six years before registration, they were ordered to pay the costs of a successful application for its removal from the register (*c*); and it was held that it was no objection to the allowance of the costs that the applicants, who had not seen the advertisements in the "Trade Marks Journal," had *not opposed the registration* (*d*); *nor in a similar*

(*r*) *King & Co.'s Trade Mark*, [1892] 2 Ch. 462: *Royal Baking Powder Co.'s Trade Marks*, 14 R.P.C. 425 (in this case the registered proprietors were foreigners).

(*s*) *Re La Société Anonyme des Verreries de l'Etoile*, 10 R. P. C. 290.

(*t*) *Lambert's Trade Mark*, 5 R. P. C. 542, 555, affirmed 6 R. P. C. 344.

(*u*) T. M. R. r. 50.

(*x*) *Wills's Trade Marks*, [1892] 3 Ch. 201.

(*y*) T. M. R. r. 49.

(*z*) 24 Bea. 145.

(*a*) L. R. 8 Eq. 475

(*b*) 25 Bea. 581.

(*c*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 725. See also *Re Kuhn & Co.*, Seb. Dig., p. 390.

(*d*) *Re Hyde & Co.'s Trade Mark*, *ubi supra*.

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case that the applicants had not informed the person on the register of their intention to take action (*e*).

But if a mark has actually become common by being copied without the owner's permission, and is then registered by the original owner, it may be that the costs of an application to remove it will not be given (*f*).

And where a person had adopted, without inquiry, some words which had been registered as the trade mark of another, and afterwards, being sued by the owner of this trade mark for infringement, moved to expunge the trade mark from the register, on the ground that it was incapable of registration, the court, although directing the mark to be expunged from the register, refused, under the circumstances, to give the applicant any costs (*g*).

So, also, when the applicant had imitated the get-up of the boxes in which the owner of the mark expunged sold his goods (*h*).

Where there was an action to restrain the defendant from passing off his goods as the goods of the plaintiff, founded to some extent on a trade mark of the plaintiff, though no injunction to restrain infringement of the mark was asked in terms, the costs of a successful motion by the defendant to expunge the mark were reserved till the trial of the action (*i*).

Where it was desired to disclaim the words "trade mark" from a registered mark and the application was granted upon terms, it was ordered that the comptroller's costs should be paid (*k*).

When an order as to an entry on the register had been obtained *ex parte*, and was afterwards, on the application of the comptroller, varied on the ground that in its original form it was against s. 85 of the Act, the respondents had to pay the costs of the application to vary (*l*).

When, on a motion to expunge a trade mark on various grounds an order had been made directing the owners of the trade mark to make an affidavit of documents relating to certain specified questions, as to the first use of the mark, whether it was common to the trade, and the like, the order was discharged by the Court of Appeal as likely to be oppressive, but without prejudice to any order the judge at the trial might think fit to make with respect to the discovery of documents (*m*).

(*e*) *Re Kuhn & Co.*, Seb. Dig., p. 390.

(*f*) *Re Kuhn & Co., ubi supra.*

(*g*) *Perry Davis's Trade Mark*, 5 R. P. C. 333.

(*h*) *Re Bradley's Trade Mark*, 9 R. P. C. 206.

(*i*) *Glanaclis' Trade Mark*, 6 R. P. C 457.

(*k*) *Colman's Trade Marks*, 8 R. P. C. 209, 213.

(*l*) *Mitchell & Co., and Houghton and Hallmark's Trade Marks*, 28 Ch. D. 669.

(*m*) *Re Wills's Trade Marks*, [1892] 3 Ch. 201.

Where an applicant for removal of a trade mark from the register served notice of discontinuance of the proceedings on the registered owner, it was held that it was doubtful whether the respondent could have his costs under Order XXVI., r. 1, and that he was justified in coming to the court and asking for the costs of the motion as an abandoned motion (*n*).

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See *Re Salamon* (*o*), where an action was directed.

The provision as to damages was introduced by the present Act.

SUB-SECTION 3.

When an order is made under this section, an office copy of the order is to be left at the Patent Office (*p*).

91. The comptroller may, on request in writing accompanied by the prescribed fee,—

Power for comptroller to correct clerical errors.

(a.) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark (*q*); or

(b.) Correct any clerical error in the name style or address of the registered proprietor of a patent, design, or trade mark.

(c.) Cancel the entry or part of the entry of a trade mark on the register (*r*): Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

By the Act of 1888, s. 24, the following clause is added to the section :—

"(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting

(*n*) *Re Dyson's Trade Mark*, W. N. 1891, p. 176.

(*o*) Seb. Dig., p. 340.

(*p*) P. R. r. 74; T. M. R. r. 46; D. R. r. 28.

(*q*) P. R. Form P.; D. R. Form M.; T. M. R. r. 48, and Forms M. and Q.; *post*. In the case of designs and trade marks, the Rules include amendment of drawings.

(*r*) T. M. R. Forms O. and P.

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any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

(a.) All documents for the amending of which no special provision is made by the Act may be amended if and on such terms as the comptroller may think fit (P. R., r. 10). This will include clerical errors in a specification, and, apparently, whether provisional or complete (*Ibid.* Form P). See, also, D. R., r. 30; T. M. R., r. 54.

(c.) If more than mere cancellation is required, the application must be made to the court under s. 92.

Under the old Act a mark might be struck out of the register on the application of the registered proprietor (s).

Alteration of registered mark.

92. (1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application (t).

(3.) If the Court grants leave, the comptroller shall, on proof thereof (u) and on payment of the prescribed fee (x), cause the register to be altered in conformity with the order of leave.

Substantially a re-enactment of rr. 34 and 35 of the Rules of March, 1883.

Certain additions to marks, the subject of applications for registration, may be made by the comptroller under ss. 64 (2) and 74, *ante*. But as to marks already registered, the applicant must proceed under this present section.

Act of 1875.

Under the Act of 1875 leave was given, on the application of the registered proprietor, to alter the mark by substituting in it a new for an existing word, denoting the address of the proprietor (y); to rectify the register by limiting the registration to particular goods (z); to vary

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(s) *Ex parte Sales, Pollard & Co.*, Seb. Dig., p. 378.
(t) T. M. R. r. 51.
(u) *Ibid.* r. 46, and Form N.
(x) First Schedule, T. M. R.
(y) *Ex parte Walker & Co.*, Seb. Dig., p. 381.
(z) *Re Lysaght*, Seb. Dig., p. 381.

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the address and change the type (*a*), or to substitute the name of an assignee for that of the assignor, where the latter was printed in ordinary type (*b*), or to remove the name of the proprietor from a mark, leaving a blank space, with permission to insert therein the name of the firm for the time being (*c*). But the substitution of the name of the assignee for that of the assignor was not allowed when the latter name had been printed in the form of a signature, so as to be an essential particular of the mark (*d*).

Present practice.

A limited company which had taken over the business and trade marks of a firm, and was incorporated under the name of the firm, was held entitled to add the word "limited" to a facsimile signature of the firm, which was part of the trade mark (*e*). But leave to add the abbreviation "Ltd." was refused (*f*).

Where a trade mark for cotton goods consisted of an elaborate device with the words "Grass Bleach—1st Quality," the owners were allowed, under this section, to alter the mark by substituting their own name for the word "Grass," upon satisfying the court that two other marks on the register, in which the same name appeared, belonged to other firms than the applicants, and that the devices on their marks were altogether different from that on the applicants' mark (*g*).

And where the name of a company owning a trade mark was changed, and the initials of the old name were on the registered mark, the mark was altered by substituting the initials of the new name (*h*).

Where the application was to alter certain registered trade labels by expunging the word "trade mark" which appeared on the labels, leave was granted under this section, but only on the terms of the applicants undertaking to endorse on their application and enter on the register a statement of the essential particulars of each mark, and a disclaimer of any exclusive right to the added matter, if any, to the satisfaction of the comptroller (*i*).

Old marks

There is an important distinction under this section between old and new marks. A mark registered as an old mark ought to be registered, and kept registered, just as it was used, with the exception of such

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(*a*) *Ex parte Lazenby*, Sebastian on Trade Marks, 3rd ed. p. 406.

(*b*) *Re Dewhurst, ibid.*

(*c*) *Re Boord, ibid.* But this is now objected to. See *Brown's Trade Marks*, 11 R. P. C. 365.

(*d*) *Re Dewhurst, ubi supra.*

(*e*) *Re Guinness & Co.'s Trade Mark*, 5 R. P. C. 316; *Re Bryant & May, Limited*, 4 Times R. 675; *Re Burke's Trade Marks*, [1891] W. N. 2.

(*f*) *Hayward & Sons' Trade Mark*, 13 R. P. C. 729.

(*g*) *Reiss' Trade Mark*, 5 R.P.C. 291.

(*h*) *National Wholesale Tea Supply Association's Trade Mark*, 10 R. P. C. 164.

(*i*) *Colman's Trade Marks*, [1891] 2 Ch. 402. The Order is printed, 8 R. P. C. 213.

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alterations or additions as the circumstances of the case from time to time render necessary (*j*).

And therefore in old marks, applications to expunge the words "trade mark" (*k*), or to alter the initials of a former proprietor into the name of a subsequent proprietor (*l*) were refused, though, as appears above, similar alterations have been allowed in new marks.

So, also, where an old mark contained the word "patent," leave to strike out the word was refused (*m*).

And where the applicants desired to add words of quality to an old mark, they were only allowed to do so on condition of disclaiming the exclusive use, not merely of the words added, but also of other words on the mark which they would be bound to disclaim if they were registering under the present Act (*n*).

And where a mark was a combination mark consisting of certain oval lines and a device, the proprietors were not allowed to alter the mark by omitting the oval lines (*o*).

The name of the "works" mentioned in a trade mark is not an essential particular. And where a trade mark had the words "Burham Works" at the top, and the words "Murston Works" at the bottom, it was allowed to be altered by striking out the latter words and altering the position of the former words so as to read "Burham" at the top and "Works" at the bottom (*p*).

And the name of a firm is not of necessity an essential particular, and therefore in a proper case a new name of the registered owners of the trade mark may be substituted for their old name (*q*).

Where, by a clerical error in a mark in the Russian character, the initial letter was printed in English character, the mistake was rectified under this section (*r*). But leave was refused to strike out the name of a place in Russian characters and substitute the owner's name in English characters, since, to a person not understanding Russian, the mark, when altered, would be different to the original mark, and altered in a material particular (*s*).

Where an order has been made under this section, an office copy of the order is to be left at the Patent Office (*t*).

(*j*) *Per* KEKEWICH, J., *Clay and Bock & Co.'s Trade Mark*, 9 R. P. C. 449.

(*k*) *Phillips' Trade Marks*, [1891] 3 Ch. 139.

(*l*) *Clay and Bock & Co.'s Trade Mark, ubi supra.*

(*m*) *Adams' Trade Marks*, 9 R. P. C. 174.

(*n*) *Orlando Jones & Co.'s Trade Marks*, 12 R. P. C. 278.

(*o*) *Orlando Jones & Co.'s Trade Marks*, 12 R. P. C. 278.

(*p*) *Re Burham, etc. Co.'s Trade Marks*, 9 R. P. C. 422.

(*q*) *Re Stock Owners' Meat Co. of New South Wales*, 14 R. P. C. 733.

(*r*) *Ermen and Roby's Trade Mark*, 4 R. P. C. 70.

(*s*) *Savin's Trade Mark*, 13 R. P. C. 21.

(*t*) T. M. R. r. 46, *post*. And if the

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93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Falsification of entries in registers.

A re-enactment in substance of s. 37 of the Act of 1852.

That section, however, only related to patents, but the present section applies to every register kept under this Act.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent (*u*).

Exercise of discretionary power by comptroller.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Power of comptroller to take directions of law officers.

96. A certificate (*x*) purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Certificate of comptroller to be evidence.

A re-enactment of s. 8 of the Act of 1875, making its provisions generally applicable to this Act.

97. (1.) Any application, notice, or other document authorised or required to be left made or given at the

Applications and notices by post.

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comptroller thinks that the rectification or variation of the register should be made public, he may publish the same at the expense of the applicant, T. M. R. r. 50.

(*u*) See P. R. rr. 11—14; D. R. rr. 12—14; T. M. R. rr. 17—19; *post*.

(*x*) P. R. *post*, r. 79, Second Schedule, Form Q.; D. R. *post*, r. 34, Forms G., J.; T. M. R. *post*, r. 60, Form U.

Sect. 97 (1). patent office or to the comptroller, or to any other person under this Act (*y*), may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Where a witness produced a copy of a letter which he said was made by him, and swore that he should, in the ordinary course of business, have posted the original, it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence (*z*). But neither proof of an entry made by a deceased person in the ordinary course of business in a postage-book of a letter to be posted, nor proof of possession by the deceased person for the purpose of posting, is sufficient evidence of postage (*a*).

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Declaration by infant, lunatic, etc.

99. If any person is, by reason of infancy lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be

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(*y*) Or under the rules; see P. R. r. 16A, *post*. D. R. r. 11, and T. M. R. r. 16, are similar.

(*z*) *Trotter* v. *Maclean*, 13 Ch. D. 574.

(*a*) *Rowlands* v. *De Vecchi*, 1 Cab. & Ell. 10.

none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted. Sect. 99.

Taken from Rule 67 of the Trade Marks Rules of March, 1883.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals. Transmission of certified printed copies of specifications, etc.

A re-enactment, with modifications, of 16 & 17 Vict. c. 115, s. 5.

101. (1.) The Board of Trade may from time to time make such general rules (*b*) and do such things as they think expedient, subject to the provisions of this Act— Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.

(a.) For regulating the practice of registration under this Act:

(b.) For classifying goods for the purposes of designs and trade marks:

(*b*) P. R. 1890 and 1892, D. R. 1890 and 1893, and T. M. R. 1890 and 1897.

Sect. 101 (1).

(c.) For making or requiring duplicates of specifications, amendment, drawings, and other documents :

(d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications drawings amendments and other documents :

(e.) For securing and regulating the making printing publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents :

(f.) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies, and institutions at home and abroad :

(g.) Generally for regulating the business of the patent office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid (*c*).

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as herein-after mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House,

(*c*) This has been done as to certain Forms in the Schedule to the Act. See the various Rules, *post*.

resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule. Sect. 101 (5).

As to the power of making Rules conferred by this section on the Board of Trade, see *Chartered Institute of Patent Agents* v. *Lockwood* (*d*).

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act. Annual reports of comptroller.

102a. (1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board. Proceedings of Board of Trade.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

This section was added by the Act of 1888, s. 25.

For definition of the expression "Board of Trade," see 52 & 53 Vict. c. 63, s. 12 (8).

(*d*) 10 R. P. C. 167; on appeal to H. L., 11 R. P. C. 374; 1894, A. C. 347.

Sect. 103. *International and Colonial Arrangements (e).*

International arrangements for protection of inventions, designs, and trade marks.

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the *date of the protection obtained* in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an

(e) P. R. rr. 24—29.

ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act: Sect. 103 (3).

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare *them* to be applicable, and so long only in the case of *each* state as the Order in Council shall continue in force with respect to that state.

This section is amended by the Act of 1885, s. 6, which enacts that in the above sub-s. 1 the words "date of the application" shall be substituted for the words "date of the protection obtained" (*f*).

Since the passing of this Act an international convention for the protection of industrial property has been entered into at Paris between various foreign Governments, and her Majesty's Government have become parties to the convention. See *post*.

SUB-SECTION (1).

"**Any person who has applied.**"—A patent under the International Convention can only be granted to the person who has made the foreign application (*g*). Therefore, applications by the agent of the assignee of the foreign patent (*h*), and by the director of a foreign company, who were applicants for a foreign patent, that a patent might be granted to the company's agent in England (*i*), were refused.

It would seem that there is no distinction under this section between Englishmen and foreigners (*k*). And further, that corporations can apply under this section (*l*).

"**Trade Mark.**"—The trade mark to be capable of registration under this section must be within the definition of s. 64 of the Act (*m*).

"**Any such state.**"—Although the state may only have come into the convention after the date of the foreign application in that state, the foreign applicant is within this section, and if he satisfies it in other

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(*f*) As to the meaning of these words, see *Nordenfelt* v. *Gardner*, cited *ante*, p. 347.

(*g*) *Shallenberger's Application*, 6 R. P. C. 550.

(*h*) *Shallenberger's Application*, *ubi supra*.

(*i*) *Carez's Application*, 6 R. P. C. 552.

(*k*) *Shallenberger's Application*, *ubi supra*.

(*l*) *Carez's Application*, *ubi supra*.

(*m*) *Carter Medicine Co.'s Trade Mark* (1892), 3 Ch. 472.

Sect. 103 (1). respects, is entitled to have his English patent dated in priority to a patent on an English application made before the accession of the foreign state to the convention, but after the date of the foreign application (*n*).

NOTE.

"**In priority to other applicants.**"—Where an Englishman applied for a patent on August 20th, 1886, and two Frenchmen applied, on October 8th, 1886, for a patent for the same invention, and the Englishman, being on May 28th, 1887, in a position to oppose, gave notice of opposition, on the ground that the invention had already been patented on his application, and it appeared that the Frenchmen on August 18th, 1886, applied for a patent for their invention in France, it was held under this section that they were entitled to have their English patent ante-dated to the last-mentioned date (*o*). But on the same application it was held that a notice of opposition to the grant of the Englishman's patent, given by the Frenchmen subsequent to the Englishman's application, conferred on them no *locus standi* to oppose under s. 11, and the Englishman's patent was allowed (*p*).

Where foreigners' English specification contained claims of inventions not described in their foreign specification, they were allowed, on applying to have their patent ante-dated to the date of their foreign application, to strike out the claim applicable to so much as was not described in the French specification, leaving, however, the description of the new portion; and the law officer refused to consider this as an application for amendment which would justify his imposing any terms on granting the foreigners' patent (*q*).

In a conflict between foreigners and an Englishman under this section the law officer will not require it to be shown that the foreigners' English complete specification is in terms and actual words in the form of the foreign specification (*r*).

It may be doubtful whether this section applies if the English patent has been completely granted before the foreign application in this country is made (*s*).

"**Provided that his application is made,**" **etc.**—Where a foreigner, the subject of a state which had acceded to the International Convention, did not apply for registration in England of his trade mark within four months of his applying to register in the foreign state, it was held that under this section, notwithstanding Article VI. of the International Convention (*post*), registration must be refused (*t*).

(*n*) *Main's Patent*, 7 R. P. C. 13.

(*o*) *L'Oiseau & Pierrard's Patent*, Griffin, L. O. C. 36.

(*p*) *Ererritt's Patent*, No. 10680 of 1886, Griffin, L. O. C. 28.

(*q*) *L'Oiseau & Pierrard's Application*, Griffin, L. O. C. 36.

(*r*) *L'Oiseau & Pierrard's Application*, *ubi supra*.

(*s*) *Main's Patent*, 7 R. P. C. 13.

(*t*) *Californian Fig Syrup Co.'s Trade Mark*, 6 R. P. C. 126.

Where the application in the foreign state was a renewed application, there having been a prior application which had become abortive and of no force and effect, and it was shown that the applicant had no right under that prior application, and that the proceedings in the foreign state under the renewed application were the same in all respects as if no prior application had been made, it was held that, for the purposes of this section, the time was to be reckoned from the date of the renewed application (*u*). Sect. 103 (1). — NOTE.

SUB-SECTION (2).

Section 103 gives a double right to a foreign inventor. He may apply for the restricted right given by the section, in which case he does not get the full term of fourteen years, or he may apply in the ordinary way for a patent for the full term. In the latter case the patent will be invalidated by a publication in England after the date of the foreign patent, and before that of the English application (*x*). And the date of the English patent is conclusive as to whether the patentee has or has not availed himself of the section (*y*).

Where a foreigner, owner of a label which was registered in France, and which could have been registered in England under this section as his trade mark, did not so register the label, he was held to be precluded by s. 77 (*ante*, p. 441) from suing in this country to restrain infringement of the label as a trade mark (*z*).

When the grant to the foreign applicant was opposed on the ground that the invention had been patented in this country on an application of prior date, that prior date being subsequent to the date of the application of the foreigner in the foreign state, and the comptroller under this section ante-dated the foreigner's English patent, it was held that s. 11 (1) applied, and that there was an appeal from the comptroller to the law officer (*a*).

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding Provision for colonies and India.

(*u*) *Van de Poele's Patent*, 7 R. P. C. 69.

(*x*) *British Tanning Co.* v. *Groth*, 8 R. P. C. 113.

(*y*) *British Tanning Co.* v. *Groth*, *ubi supra*.

(*z*) *Goodfellow* v. *Prince*, 35 Ch. D. 9.

(*a*) *Main's Patent*, 7. R. C. P. 13.

Sect. 104 (1). section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

This section is based on s. 7 of the Act of 1835 (*b*), as to patents, and s. 11 of the Act of 1842, as to designs. As to trade marks, see also the Merchandise Marks Act, 1887 (*c*).

Where a defendant, intending to induce the plaintiff to desist from printing a particular design, and to acquire the same for himself, falsely stated to the plaintiff that the design was registered, it was held, on demurrer, that the action would lie (*d*).

"**When no patent has been granted.**"—This section does not apply to cases of false representation of an expired patent as being still subsisting, such as in *Cheavin* v. *Walker* (*e*), cited, *ante*, p. 431. But such a representation is a false "trade description" within s. 3 (*e*) of the Merchandise Marks Act, 1887, and as such is a criminal offence under s. 2 (*d*) of that Act.

(*b*) See *Myers* v. *Baker*, 3 H. & N. 802.

(*c*) 50 & 51 Vict. c. 28.

(*d*) *Barley* v. *Walford*, 9 Q. B. 197.

(*e*) 5 Ch. D. 863.

An article which is only the subject of provisional protection must not be sold as patented (*f*). But the section does not apply if the complete specification has been accepted, as the applicant has then, under s. 15 (*ante*, p. 65), the rights of a patentee (*g*). Sect. 105. NOTE.

"**Registered.**"—Using the word "registered" on a trade mark not registered within the United Kingdom is an offence within this section, although the trade mark is registered abroad (*h*).

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds. Penalty on unauthorised assumption of Royal arms.

Scotland; Ireland; etc.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts. Saving for courts in Scotland.

For the purposes of this section, "court of appeal" shall mean any court to which such action is appealed.

The last part of this section is a re-enactment of part of s. 43 of the Act of 1852.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in ~~the~~ the sheriff court. Summary proceedings in Scotland.

(*f*) *R.* v. *Wallis*, 3 R. P. C. 1; *R.* v. *Crampton*, 3 R.P.C. 367. And see *Melachrino* v. *Melachrino, etc. Co.*, 4 R. P. C. 215, 224.

(*g*) *R.* v. *Townsend*, 13 R. P. C. 265.

(*h*) *Wright* v. *Dobbin*, 15 R. P. C. 21.

Sect. 109.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

See *ante*, s. 26.

Sub-s. 1 is a re-enactment of the last part of s. 43, and sub-s. 2 of part of s. 35 of the Act of 1852.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

A re-enactment of the last clause of s. 29 of the Act of 1852.

Before that Act it was the practice to grant separate patents for the three kingdoms, and under that practice it was held, in *Brown* v. *Annandale* (*h*), that the public use of an invention in England prior to the date of letters patent for Scotland invalidated the letters patent.

Upon this case it is observed by Mr. Webster (*i*), that neither in *Roebuck's* nor in *Brown's Case* was the grantee of the letters patent the true and first inventor in England, and he suggests that the decision would not be held to apply to a case in which the true and first inventor in one part of the realm was the grantee of the letters patent in the other part; and this view was followed in *Magill* v. *Ewing* (*k*), where it was held by the Lord Chancellor of Ireland that where an inventor who had obtained letters patent in England subsequently obtained letters patent in Ireland for the same invention, the Irish patent was not invalid by reason of prior publication in England.

In *Bovill* v. *Finch* (*l*), it was held under the Act of 1852 and the amending Act of 1853 (*m*), that a prolongation patent, which, by those Acts, was under the Great Seal of the United Kingdom, was to be considered as granting three separate prolongations of three distinct

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(*h*) 1 Webst. 433, following *Roebuck* v. *Stirling*, 1 Webst. 45. See also *Re Poe's Patent*, 2 Webst. 5; *S.C.* under name *Robinson's Patent*, 5 Moo. P. C. 65.

(*i*) 1 Webst. 454, n.

(*k*) 11 Ir Jur. (N.S.) 164.

(*l*) L. R. 5 C. P. 523.

(*m*) 15 & 16 Vict. c. 83; 16 & 17 Vict. c. 115.

patents, and that although the prolongation might be invalid as to one grant (the Scotch) by reason of the want of novelty in Scotland at the time of the original patent, it might be good as to the English and Irish grants. The court did not, however, decide what would be the effect of want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal, which has been the case with all patents since 1852, and is continued by the present Act. See *ante*, s. 36.

Sect. 110.

NOTE.

A strict construction of this section might lead to the conclusion that the patent can only be revoked as regards Ireland by an Irish Court. But such a construction cannot, it is submitted, be correct, since it is inconsistent with the general power given in s. 26 (2), which is unlimited, and moreover would make it possible that there should at the same time be a patent in force in one branch of the United Kingdom while revoked in another, which, having regard to s. 16, can hardly have been intended. It would appear, therefore, that the present section must be construed to relate only to patents which have never been revoked by any of the courts mentioned in s. 111 as included in the word "court" where used in the Act.

General saving for jurisdiction of courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

The High Court of Justice in England has jurisdiction to rectify the register of trade marks notwithstanding the registered proprietor is

Sect. 111. domiciled in Scotland or Ireland (*n*), and it would seem that such jurisdiction is an exclusive one (*o*).

NOTE.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts ;

(2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court ;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction of Lancashire Palatine Court.

112A. The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression "the court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that court in other cases.

This section was added by the Act of 1888, s. 26, *post*. And now by s. 3 of the Chancery of Lancaster Act, 1890 (*p*), the Court of Chancery of the

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(*n*) *King & Co.'s Trade Mark*, [1892] 2 Ch. 462.

(*o*) *Bayer* v. *Connell*, 14 R. P. C. 275 ; see, however, *Cowie* v. *Herbert* *ibid.* 436, in which no objection was taken to jurisdiction.

(*p*) 53 & 54 Vict. c. 23.

County Palatine of Lancaster has, as to all persons and property within its jurisdiction, the same powers and jurisdiction as the Chancery Division of the High Court. Sect. 112. NOTE.

Repeal; Transitional Provisions; Savings.

113. The enactments described in the third schedule to this Act are hereby repealed. But this repeal of enactments shall not— Repeal and saving for past operation of repealed enactments, etc.

(a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

The following cases have been divided under this section, but as its provisions are now or will shortly become inoperative by lapse of time, the cases are not here stated at length.

Singer v. *Stassen*, 1 R. P. C. 121, 125. *Hayward's Trade Marks*, 54 L. J. Ch. (N.S.) 1003. *Jackson* v. *Napper*, 35 Ch. D. 162. *Wittman* v. *Oppenheim*, 27 Ch. D. 260, 266. *Brandon's Patent*, 9 App. Cas. 589. *Jablochkoff's Patent*, [1891] A. C. 293.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act. Former registers to be deemed continued.

(2.) The registers of designs and of Trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Sect. 115.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed (*q*) altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

A re-enactment of part of s. 16 of the Act of 1852.

The grant of a patent is discretionary in the Crown, and may be stopped at any stage of the proceedings (*r*).

The Patent Office declines to receive an application from a person resident abroad for an invention being a communication from abroad. See *ante*, p. 8.

Section 4 of the Statute of Monopolies (*s*), giving a right of action to persons "hindered, grieved, disturbed, or disquieted," by any monopoly or letters patent refers to invalid and improper exercises of the prerogative, and does not refer to letters patent for inventions granted under s. 6 of the same Statute (*t*).

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

(*q*) This was done by P. R. 1883, r. 78; D. R. 1883, r. 37; T. M. R. 1883, r. 60. These Rules have now themselves been repealed by the Rules of 1890, *post*.

(*r*) Hindmarch on Patents, p. 17.

(*s*) 21 Jac. 1, c. 3

(*t*) *Peck* v. *Hinde*, 67 L. J. Q. B. 272; 14 Times R. 164.

Sect. 117.

"Law Officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks:

"Prescribed" means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

"**The Court.**"—In *Proctor* v. *Sutton Lodge Chemical Co.* (*u*), it was held that the Court of Appeal, sitting on appeal from the Vice-Chancellor of the County Palatine of Lancaster, is not a court within the meaning of the Act. But now, by s. 112A, *ante*, added by the Act of 1888, the Court of Chancery of the County Palatine of Lancaster has, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester office, the like jurisdiction under this Act as the High Court of Justice in England. And see also 53 & 34 Vict. c. 23, s. 3, cited under s. 112A, *ante*, p. 500.

"**Scotland, Ireland, and Isle of Man.**"—See ss. 107—112, *ante*.

(*u*) 5 R. P. C. 184.

Schedule 1.

SCHEDULES.

THE FIRST SCHEDULE.

Forms of application, etc. (*a*).

FORM A.—Form of application for Patent.

FORM B.—Form of Provisional Specification.

FORM C.—Form of Complete Specification.

FORM D.—Form of Patent.

Section 33.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:

Whereas *John Smith* of 29, *Perry Street*, *Birmingham*, in the county of Warwick, engineer, hath by his solemn declaration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We, of our especial grace, certain knowlege, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee (*b*) by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the

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(*a*) Under the powers given by s. 101 (2), *ante*, p. 490, the Board of Trade have substituted for the forms in this schedule other forms. See Forms A, A1, A2, B, and C, Second Schedule, P. R. *post*; Form E, Second Schedule, D. R. *post*; Form F, Second Schedule, T. M. R., *post*. The forms A, B, and C in the Schedule to the Act are, therefore, not printed here.

(*b*) In the case of patents granted to two or more persons jointly, the form adopted at the Patent Office uses the word "patentees" throughout for the word "patentee," and interprets the word "patentees" as meaning the grantees, "together

said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage (*c*) from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: and to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command (*d*) all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything herein-before contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted, shall determine and become void notwithstanding anything herein-before contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said

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with their executors, administrators, and assigns," adding the word "successors" when one of the grantees is a company.

(*c*) As to these words, see *Elmslie* v. *Boursier*, L. R. 9 Eq. 217; *Van Heyden* v. *Neustadt*, 14 Ch. D. 232.

(*d*) These prohibitory words, though addressed only to the subjects of the Crown, are in aid of the grant and not in derogation of it, and therefore form no ground of objection to an injunction against foreigners coming into this country. *Caldwell* v. *Vanvlissengen*, 9 Ha. 415, 428.

Schedule 1. patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee (*e*). In witness whereof we have caused these our letters to be made patent this

FORM D. one thousand eight hundred and and to be sealed as of the one thousand eight hundred and .

(Seal of Patent Office.)

Section 47.

FORM E.

Form of Application for Registration of Design.

See now Design Rules, 1890, *post*.

Section 62.

FORM F.

Form of Application for Registration of Trade Mark.

See now Trade Mark Rules, 1890, *post*.

Section 24.

THE SECOND SCHEDULE.

Fees on Instruments for obtaining Patents, and Renewal.

These fees are all included in the list of fees, P. R. 1892 (Second Set), *post*, p. 539, and are therefore not here printed.

Section 113.

THE THIRD SCHEDULE.

Enactments repealed.

21 James 1, c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83. [1835.]	An Act to amend the law touching letters patent for Inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.

(*e*) See remarks of LINDLEY, L.J., on this clause, *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 307.

Schedule 3.

7 & 8 Vict. c. 69 (*a*) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely,— Sections two to five, both included.
13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70. [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870,— In part; namely,— Section sixty-five, and in the Schedule the words and figures. "Certificate of the registration of a design...£5 0 0. And see section 65."
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

(*a*) NOTE.—Sections 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

THE PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT) ACT, 1885.

(48 & 49 VICT. c. 63.)

An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August 1885.]

BE it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Construction and short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of s. 5 of 46 & 47 Vict. c. 57.

2. Whereas sub-section two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that :

The declaration mentioned in sub-section two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

5 & 6 Will. 4, c. 62.

Amendment of ss. 8, 9, and 12 of 46 & 47 Vict. c. 57.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required

by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times: Be it therefore enacted as follows:

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Specifications etc. not to be published unless application accepted.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

Notwithstanding this section the court, for the purposes of justice, can allow the specification to be produced, and can look at it. (*f*).

Power to grant patents to several persons jointly.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

See *ante*, under Act of 1883, s. 5, sub-s. 2, *ante*, p. 5.

Amendment of s. 103 of 40 & 47 Vict. c. 57.

6. In sub-section one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

(*f*) *Pneumatic Tyre Co. Ltd.* v. *The English Cycle, etc. Co.*, 14 R. P. C. 851.

THE PATENTS ACT, 1886.

(49 & 50 Vict. c. 37).

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

[25th June 1886.]

46 & 47 Vict. c. 57.

WHEREAS by section five of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Short title and construction. 46 & 47 Vict. c. 57. 48 & 49 Vict. c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

The same drawings may accompany both specifications.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no

patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification.

Protection of patents and designs exhibited at international exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the Controller the prescribed notice of his intention to do so :

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows :

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the Controller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

(51 & 52 Vict. c. 50).

An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December 1888.]

46 & 47 Vict. c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Register of patent agents.

1.—(1). After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2). The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules (*g*) as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been *bonâ fide* practising as a patent agent

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(*g*) See Register of Patent Agents Rules, 1889—1891, published by Messrs. Eyre and Spottiswoode.

shall be entitled to be registered as a patent agent in pursuance of this Act. Sect. 1 (3).

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

As to discovery in the case of communications between patent agents and their clients, see *Moseley* v. *Victoria Rubber Co.*, cited *ante*, p. 296.

The mere signing, by a person, of a specification of a patent as "Agent for Applicant," is not a describing himself as a patent agent within this section (*i*).

The rules of the Board of Trade imposing annual fees on persons registered as a condition of remaining on the register are *intra vires* (*k*).

2. For section seven of the principal Act the following section shall be substituted, namely :— Amendments of 46 & 47 Vict. c. 57.

"7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application ; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with. s. 7, as to applications.

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

"(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

(*i*) *Graham* v. *Fanta*, 9 R. P. C. 164. See also *Graham* v. *Eli*, 14 Times R. 370.

(*k*) *Institute of Patent Agents* v. *Lockwood*, 1894, A. C. 347.

Sect. 2.

"(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

See *ante*, p. 28.

s. 9, as to disclosure of reports of examiners.

3. In sub-section five of section nine of the principal Act the words "other than an appeal to the law officer under this Act," shall be omitted.

s. 11, as to opposition to grant of patent.

4. In sub-section one of section eleven of the principal Act the words from "or on the ground of an examiner" to "a previous application," both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, "or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification."

See *ante*, p. 55.

s. 18, as to amended specifications.

5. For sub-section ten of section eighteen of the principal Act, the following sub-section shall be substituted, namely:—

"(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending."

See *ante*, p. 86.

s. 52, as to inspection of designs.

6. After sub-section one of section fifty-two of the principal Act, the following words shall be added; namely,

"Provided that where registration of a design is refused

on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered." Sect. 6.

7.—(1.) In section fifty-eight of the principal Act the words "or caused to be applied" shall be added after the word "apply." s. 58, as to piracy of registered designs.

(2.) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

See *ante*, pp. 365, 370.

8.—(1). In sub-section two of section sixty-two of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed." s. 62, as to application for registration.

(2.) To the same section of the principal Act the following sub-section shall be added:—

"(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given."

9. In section sixty-three of the principal Act for the words "the application shall be deemed to be abandoned" shall be substituted the words "the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned." s. 63, as to limit of time for proceeding with application.

10.—(1.) For section sixty-four of the principal Act the following section shall be substituted, namely— s. 64, as to fancy words.

"64.—(1.) For the purposes of this Act, a trade mark must

[Sect. 10. consist of or contain at least one of the following essential particulars :

(a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or

(b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or

(c.) A distinctive device, mark, brand, heading, label, or ticket ; or

(d.) An invented word or invented words ; or

(e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"(3.) Provided as follows :

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof :

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act."

See *ante*, p. 402.

Sect. 11.

11. In section sixty-seven of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

s. 67, as to colours of trade marks.

12. In section sixty-eight of the principal Act after the word comptroller shall be added the words "unless the comptroller refuse to entertain the application."

s. 68, as to advertisement of applications.

13.—(1.) In sub-section one of section sixty-nine of the principal Act for the words "two months" shall be substituted the words "one month or such further time, not exceeding three months, as the comptroller may allow."

s. 69, as to opposition to registration.

(2.) In the same sub-section the word "first" shall be omitted.

(3.) In sub-section two of the same section for the words "two months" shall be substituted the words "one month."

(4.) For sub-sections three and four of the same section the following sub-sections shall be substituted; namely,

"(3.) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the court, and in that event the court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5.) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

Sect. 13 (4).

"(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

See *ante*, p. 412.

s. 72. as to restrictions on registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

s. 73, as to restriction on registration.

15. In section seventy-three of the principal Act the word "exclusive" shall be omitted.

s. 74, as to additions to trade marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted; namely,

"(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

See *ante*, pp. 397, 436.

s. 75, as to effect of registration.

17. For section seventy-five of the principal Act the following section shall be substituted; namely,

"Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration."

See *ante*, p. 438.

Sect. 18.

18. After section seventy-seven of the principal Act the following section shall be added and numbered 77A ; namely,

Certificate as to exclusive use and costs thereon.

"In an action for infringement of a registered trade mark the court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the court or judge trying the subsequent action certifies that he ought not to have the same."

See notes under s. 31 of the Act of 1883, *ante*, p. 316, and under this section as s. 77A, *ante*, p. 448.

Amendments of 46 & 47 Vict. c. 57.

19.—(1.) In sub-section five of section seventy-nine of the principal Act, for the words "the five years" shall be substituted the words "one year."

s. 79, as to removal of trade mark from the register.

(2.) To the same sub-section the following words shall be added ; namely, "unless it is shown to the satisfaction of the comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

s. 81, as to Sheffield marks.

20.—(1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted :

"(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned

38 & 39 Vict. c. 91.

Sect. 20.

by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

(2.) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted:

"(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register."

(4.) To the same section the following sub-sections shall be added; namely,—

(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register

a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller. Sect. 20 (4).

See *ante*, p. 455.

s. 87, as to entry of assignments, etc.

21. In section eighty-seven of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 88, as to inspection.

22. In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 90, as to rectification of register.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

s. 91, as to correction of errors

24. To section ninety-one of the principal Act the following sub-section shall be added; namely,

"(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

Proceedings of Board of Trade.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

"(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

"(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

"(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act

Sect. 25.

of the Board, shall be conclusive evidence of the fact so certified."

See *ante*, p. 491.

Jurisdiction of Lancashire Palatine Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely,

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that court in other cases."

See *ante*, p. 500.

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act (*l*).

Commencement of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

(*l*) *Re Burgoyne's Trade Mark*, 6 R. P. C. 227; 5 Times R. 326; and see *Anderson & Anderson's Patent*, 7 R. P. C. 323.

PATENTS RULES, 1890.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

Short Title.

1. These Rules may be cited as the Patents Rules, 1890. Short title.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of March, 1890. Commencement.

Interpretation.

3. In the construction of these Rules, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the First Schedule to these Rules. Fees.

Forms.

5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A1, A2, B, and C in the Second Schedule to these Rules. Forms. Alterations.

6. (1.) An application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the Act of 1883 and section 2 of the Act of 1885 shall be made either in the Form A or the Form A1, or the Form A2, set forth in the Second Schedule to these Rules as the case may be. Application.

(2.) The Form B in such Schedule of provisional specification and the Form C of complete specification shall respectively be used. Specification.

(3.) The remaining forms other than A, A1, A2, B, and C, set forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules. Other forms.

Rule 7.

GENERAL.

Hours of business.

7. The Patent Office shall be open to the public every week-day between the hours of ten and four, except on the days and times following:—

Christmas Day. Good Friday.

The day observed as Her Majesty's birthday.

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency.

8. (*a*) An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require, resident in the United Kingdom, but the Comptroller shall not be bound to recognise as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

Statement of address.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this Rule be in the United Kingdom.

Size, etc. of documents.

10. All documents and copies of documents, except Statutory Declarations and Affidavits, sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters and unless otherwise directed in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

Exercise of discretionary power by Comptroller.

Notice of hearing.

11. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller. Statutory

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(*a*) Substituted for original Rule 8 by Patents Rules, 1898, not printed separately in this book.

Declarations and Affidavits shall be in the form for the time being in use in the High Court of Justice. **Rule 11.**

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter. Notice by applicant.

13. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require. Comptroller may require statement, etc.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby. Decision to be notified to parties.

15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice, in writing, of his intention to exhibit, publish, or use the invention, as the case may be. Industrial or International Exhibitions.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

16. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit. Power of amendment, etc.

This rule includes apparently amendment of clerical errors in specification (Second Schedule, Form P). These errors, which before the Act of 1883 could be corrected only on application to the Master of the Rolls (*ante*, p. 73), are not mentioned in s. 91 (*ante*, p. 483); but the rule appears to be within the powers of s. 101 (1) (*c*), *ante*, p. 489), and by that section has the force of an Act of Parliament.

Under this rule the title of a prior invention might on an opposition be added at the hearing to a notice which gave only number and date, and

Rule 16.

NOTE.

therefore did not comply with rule 34 of Patent Rules, 1883 (*m*). The present rule (r. 36) does not require the title to be given.

And a notice of opposition was amended by changing the name of the opponent's agent, who had signed the notice but had since died, into that of the real opponent (*n*). See rule 42, *post* and notes.

16A. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

See note under s. 97, *ante*, p. 488.

Manner in which, and persons before whom, declaration is to be taken.

17. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows :—

(a.) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b.) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(c.) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

17A. Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject.

Declarations must be made in the fullest good faith, and therefore where a statement in a declaration of the applicant was not considered quite candid, the law officer, although dismissing the appeal, dismissed it without costs (*o*).

Declarations in oppositions and other proceedings before the comptroller must be strictly confined to relevant matters, and must not be multiplied unnecessarily (*p*).

(*m*) *Airey's Application*, 5 R. P. C. 348, 349.
(*n*) *Lake's Application*, Griffin, L. O. C. 35.
(*o*) *Anderton's Patent*, Griffin, L. O. C. 25.
(*p*) See *Brand's Application*, 12 R. P. C. 102.

APPLICATION WITH PROVISIONAL OR COMPLETE SPECIFICATION. Rule 18.

Order of recording applications.

18. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

Application for separate patents by way of amendment.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the Comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall, if the applicant notify his desire to that effect to the Comptroller, bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these Rules, as if every such application had been originally made on that date.

See under s. 33, *ante*, p. 335.

Application by representative of deceased inventor.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative and must be supported by such further evidence as the comptroller may require.

Notice and advertisement of acceptance.

21. On the acceptance of a provisional or complete specification the comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

Inspection on acceptance of complete specification.

22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

APPLICATION ON COMMUNICATION FROM ABROAD.

Communication from abroad.

23. An application for a patent for an invention communicated from abroad shall be made in the form A1 set forth in the Second Schedule to these rules.

See, *ante*, p. 4.

Rule 24.

INTERNATIONAL AND COLONIAL ARRANGEMENTS (*q*).

24. The term "foreign application" shall mean an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order of Her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify all the Foreign States or British Possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within 7 months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

26. The application in the United Kingdom shall be made in the Form A2 in the Second Schedule to these Rules, and in addition to the specification, provisional or complete, left with such application must be accompanied by

(1.) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such Foreign State or British Possessions as aforesaid, or otherwise verified to the satisfaction of the Comptroller;

(2.) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

27. On receipt of such application, together with the precribed specification and the other document or documents accompanying the same, required by the last preceding rule, and with such other proof (if any) as the Comptroller may

(*q*) See under s. 103, *ante*, p. 492.

require of or relating to such foreign application or of the official date thereof, the Comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively. Rule 27

28. All further proceedings in connection with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

Sizes and methods of preparing Drawings accompanying Provisional or Complete Specifications.

30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if drawings are furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letter-press should appear in the specification itself. Drawings for specifications.

31. Drawings (if any) must be delivered at the Patent Office either in a flat state or on rollers so as to be free from folds, breaks, or creases.

They must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface and good quality, and where possible without colour or Indian-ink washes. Requirements as to paper, etc.

They must be on sheets of one of the two following sizes (the smaller being preferable), 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be ½ an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in. Size drawings.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration Quality of ink.

Rule 31. of this requirement. Reference figures and letters must be bold, distinct, not less than $\frac{1}{8}$ of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the figure, and connected with the part referred to by a fine line.

Scale of drawings. The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, etc. need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Drawings to bear name of applicant, etc. Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

No written description of the invention should appear on the drawings.

Restrictions as to wood engravings. Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Copies of drawings. 32. A *facsimile* of the original drawings but *without* colour or Indian ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked "true copy."

Provisional drawings used for complete specification. 33. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

Opposition to Grants of Patents.

Notice of opposition. 34. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person giving such notice (herein-after in Rules 37, 38, 41 and 43 called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

Copy for applicant. 35. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant.

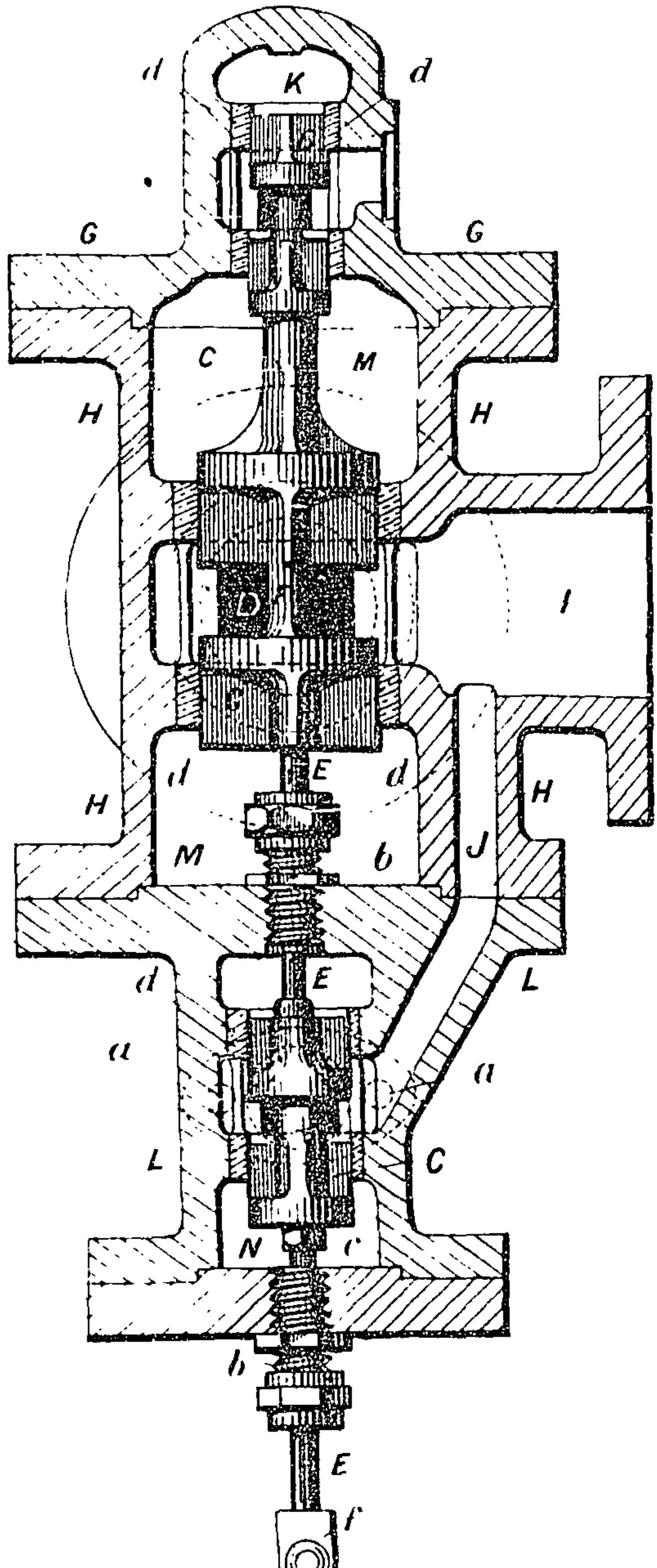
Specimen drawing for Specifications.

Border Line ½ an Inch from edge of Paper

A D 18 *No* *(Sheets)*

Smith's Specification *Sheet*

FIG 1.



Jas. Smith (Applicant)

C. Jones & Co.

Agents for Applicant

Size of paper for Specification drawing { *Eight inches by 8 inches* or *13 " " 16 inches*

To Face Page 33 *Border line ½ an Inch from edge of paper*

36. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice. Rule 35. Particulars of prior patent.

37. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof. Opponent's evidence.

38. Within 14 days from the delivery of such list the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within 14 days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply. Applicant's evidence. Evidence in reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

39. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application in writing made to him for that purpose. Closing of evidence.

Where no evidence had been filed on either side, leave was given to the opponent at the hearing to file evidence conditional on its being filed within a given time and the opponent paying a certain sum for costs, and the hearing was adjourned (*r*).

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

41. On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties 10 days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the Comptroller an application on Form E. The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the Comptroller shall decide the case and notify his decision to the parties. Notice of hearing.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, Disallowance of opposition in certain cases

(*r*) *Hatfield's Patent*, Griffin P. C. 288.

Rule 42. and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

At the hearing of an opposition to grant of patent, or an opposed application for amendment, the applicant begins.

"Number and Date."—Any error in this particular may, it would seem, be corrected by the Comptroller at the hearing, under Rule 16, as an irregularity in procedure, if the correction can, in the opinion of the Comptroller, be made without detriment to the interests of any person; and in *Airey's Application* (*s*), the opponent was allowed to amend a notice of opposition, which stated only the number and date, and which was therefore defective under Rule 34 of P. R. 1883, which required the title also, by adding the title of the prior patent.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

Decision to be notified to parties.

44. The decision of the Comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties.

Payment of Annual Fees for Continuance of Patent.

4. (*t*) If a patentee intends at the expiration of the fourth year from the date of his patent to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance.

The form J. in the Second Schedule, duly stamped, should be used for the purpose of this payment.

Certificate of payment.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in

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(*s*) 5 R. P. C. 350.
(*t*) Substituted by P. R. 1892 (second set), r. 4, for original rules 45, 46, 47

which the patentee by accident, mistake or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement. Rule 49.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as the Comptroller may think necessary. Extension of time for leaving and accepting complete specification.

51. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct. In other cases.

Amendment of Specification.

52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter in Rules 54, 55 and 57 called the applicant) and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct. Request for leave to amend. Advertisement.

53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy. Notice of opposition

See Form G.

If the notices are not signed when left at the Patent Office the Comptroller will nevertheless proceed with the hearing if the applicant is not prejudiced by the notice not having been signed as required by this rule (*u*).

And see Rule 80, *post*.

54. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant. Copy for the applicant.

55. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to Opponent's evidence.

(*u*) *Codd's Patent*, Griffin P. C. 306.

Rule 55. amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition and on so leaving shall deliver to the applicant a list thereof.

Further proceedings. 56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Requirements thereon. 57. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31.

Leave by Order of Court. 58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office.

Advertisement of amendment. 59. Every amendment of a specification shall be forthwith advertised by the Comptroller in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may direct.

COMPULSORY LICENSES.

[See also scheme of procedure under s. 22, *post*, p. 633, and forms of order of Board of Trade, with license annexed, *post*, pp. 634, 635.]

Petition for compulsory grant of licenses. 60. A petition to the Board of Trade for an order upon a patentee to grant a license shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

To be left with evidence at Patent Office. 61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

Directions as to further proceedings unless petition refused. 62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the Comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure. 63. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner

shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof. **Rule 63.** Petitioner's evidence.

64. Within fourteen days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner. Patentee's evidence.

65. The petitioner within fourteen days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply. Evidence in reply.

66. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition. Further proceedings.

The provisions as to compulsory licences were introduced by the present Act. They do not apply to patents granted before the commencement of the Act of 1883, or on applications then pending. (Sect. 45 (2), *ante*, p. 345.)

Neither the Act nor the Rules contain any provision as to costs, which, if the application be unfounded, may be a serious burden to the patentee.

The Act gives no appeal from the decision of the Board of Trade. But by sect. 22 (*ante*, p. 95) the order of the Board of Trade for a compulsory licence may be enforced by *mandamus*. A writ of *mandamus* is, however, a prerogative writ, and not a writ of right, and it is in this sense in the discretion of the court whether it shall be granted or not. The court may refuse to grant the writ, not only upon the merits, but upon some delay or other matter personal to the party applying for it (*x*), or possibly on matters connected with the conduct of the parties (*y*). The writ may also be refused where it is inequitable to grant it (*z*), and it was refused where performance of an order of the Board of Trade, which the applicant sought to enforce, was shown to be impossible owing to want of funds (*a*). It would seem, therefore, that where a compulsory licence has been ordered, the patentee may, on the application for a *mandamus*, obtain a review of the decision of the Board of Trade. Where, however, the compulsory licence has been refused by the Board of Trade, the applicant has no remedy.

(*x*) *R.* v. *Churchwardens of All Saints', Wigan*, 1 App. Cas. 611; judgment of Lord CHELMSFORD, p. 621.

(*y*) *Ibid.*, p. 622; judgment of Lord HATHERLEY.

(*z*) *R.* v. *Garland*, L. R. 5 Q. B. 269.

(*a*) *Re The Bristol and North Somerset Rail. Co.*, 3 Q. B. D. 11.

Rule 67. REGISTER OF PATENTS.

Entry of grant.

67. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

See notes under section 23, *ante*, p. 96.

Signature of request.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

Particulars to be stated in request.

70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

Production of documents of title and other proof.

71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent, or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall be produced to the Comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the Comptroller.

See notes under section 23, *ante*, p. 96.

Copies for Patent Office.

72. There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy. Rule 72.

73. A body corporate may be registered as proprietor by its corporate name. Body corporate.

74. Where an order has been made by Her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent or the rectification of the register under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be. Entry of orders of the Privy Council or of the Court.

75. Upon the issue of a certificate of payment under Rule 48, the Comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate. Entry of payment of fees on issue of certificate.

76. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register. Entry of failure to pay fees.

77. An attested copy of every license granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original license shall at the same time be produced and left at the Patent Office if required for further verification. Entry of licenses.

78. The register of patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and the times following:— Hours of inspection of register.

(a.) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

(b.) Days which may may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(c.) Times when the register is required for any purpose of official use.

Rule 79.

Certified copies of documents.

79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

Power to Dispense with Evidence, etc.

80. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence

Repeal.

Repeal

81. All general rules heretofore made by the Board of Trade under the Patents Designs and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application then pending.

Dated the 31st day of March, 1890.

M. E. Hicks-Beach,
President of the Board of Trade.

[NOTE—*By the Patent Rules*, 1892 (*second set*) *the following list of fees is substituted for the fees specified in the First Schedule to the Patent Rules*, 1890.]

Schedule 1.

SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNECTION WITH LETTERS PATENT.

Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection ...	1	0	0			
2. On filing complete specification	3	0	0 (*b*)			
				4	0	0
or						
3. On filing complete specification with first application ...				4	0	0
4. On appeal from Comptroller to Law Officer. By appellant				3	0	0
5. On notice of opposition to grant of patent. By opponent				0	10	0
6. On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
On application to amend specification :—						
7. Up to sealing. By applicant				1	10	0
8. After sealing. By patentee				3	0	0
9. On notice of opposition to amendment. By opponent ...				0	10	0
10. On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
11. On application to amend specification during action or proceeding. By patentee				3	0	0
12. On application to the Board of Trade for a compulsory license. By person applying				5	0	0
13. On opposition to grant of compulsory license. By patentee				5	0	0
On certificate of renewal :—						
14. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year				5	0	0
15. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year				6	0	0
16. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year				7	0	0
17. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year				8	0	0
18. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year				9	0	0
19. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year				10	0	0
20. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year				11	0	0

(*b*) These payments are in lieu of the fees under the Act of 1853, which, up to the specification, amounted to 25*l*.

Schedule 1.

		£	s.	d.
	On certificate of renewal—*continued.*			
21.	Before the expiration of the 11th year from the date of the patent and in respect of the 12th year	12	0	0
22.	Before the expiration of the 12th year from the date of the patent and in respect of the 13th year	13	0	0
23.	Before the expiration of the 13th year from the date of the patent and in respect of the 14th year (*c*)	14	0	0
	On enlargement of time for payment of renewal fees:—			
24.	Not exceeding one month	1	0	0
25.	,, two months	3	0	0
26.	,, three months	5	0	0
27.	For every entry of an assignment, transmission, agreement, license, or extension of patent	0	10	0
28.	For duplicate of letters patent ... ... each	2	0	0
29.	On notice to Comptroller of intended exhibition of a patent under Section 39	0	10	0
30.	Search or inspection fee ... ... each	0	1	0
31.	For office copies ... ... every 100 words (but never less than one shilling)	0	0	4
32.	For office copies of drawings, cost according to agreement.			
33.	For certifying office copies, MSS. or printed ... each	0	1	0
34.	(*d*) On request to Comptroller to correct a clerical error up to sealing	0	5	0
	after sealing	1	0	0
35.	For certificate of Comptroller under section 96	0	5	0
36.	For altering address in register	0	5	0
37.	For enlargement of time for filing complete specification, not exceeding one month	2	0	0
38.	For enlargement of time for acceptance of complete specification:—			
	Not exceeding one month	2	0	0
	,, two months	4	0	0
	,, three months	6	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

July 4th, 1892
Approved:
SIDNEY HERBERT,
HERBERT EUSTACE MAXWELL,
Lords Commissioners of Her Majesty's Treasury.

(*c*) These payments will be in time if made before midnight on the anniversary of the day of the date of the patent (*Williams* v. *Nash*, 28 Bea. 93). See also sect. 98 of the Act of 1883, *ante*, p. 488.

(*d*) The following fee is added by the Patent Rules, 1892, 1st set.—*On postal request for printed copy of specification, 8d.*

THE SECOND SCHEDULE.

FORMS.

A.—Form of Application for Patent, p. 542.
A1.— ,, ,, ,, communicated from Abroad, p. 543.
A2.— ,, Application for Patent under International and Colonial Arrangements, p. 544.
B.— ,, Provisional Specification, p. 544.
C.— ,, Complete, p. 545.
D.— ,, Opposition to Grant of Patent.
E.— ,, Application for Hearing by Comptroller.
F.— ,, ,, to amend Specification or Drawings.
G.— ,, Opposition to Amendment of Specification or Drawings.
H.— ,, Application for Compulsory Grant of License.
H1.— ,, Petition for Compulsory Grant of Licenses.
I.— ,, Opposition to Compulsory Grant of License.
J.— ,, Application for Certificate of Payment or Renewal.
K.— ,, Application for Enlargement of Time for Payment of Renewal Fee.
L.— ,, Request to enter Name upon the Register of Patents.
M.— ,, Request to enter Notification of License in Register.
N.— ,, Application for Duplicate of Letters Patent.
O.— ,, Notice of Intended Exhibition of Unpatented Invention.
P.— ,, Request for Correction of Clerical Error.
Q.— ,, Certificate of Comptroller.
R.— ,, Notice for Alteration of an Address in Register.
S.— ,, Application for Entry of Order of Privy Council in Register.
T.— ,, Appeal to Law Officer.
U.— ,, Application for Extension of Time for leaving a complete Specification.
V.— ,, Application for Extension of Time for acceptance of complete Specification.

To these is added by Patent Rules, 1892 (first set), Form C. 1 : *Application for Copy of a Specification.*

The forms from D. onward are not printed in this edition.

Schedule 2.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

(PATENT.) FORM A.

To be accompanied by two copies of Form B. or of Form C.

Application for Patent.

* do hereby declare that in possession of an invention the title of which is † that ‡ the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of knowledge and belief; and humbly pray that a Patent may be granted to for the said invention.

Dated day of , 18 .

§ ——

* Here insert name and full address and calling of applicant or applicants.

† Here insert title of invention.

‡ In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.

§ To be signed by applicant or applicants. In the case of a firm, each member of the firm must sign.

NOTE.—Where application is made through an agent (Rule 8), the authorization on the back (if used) should be signed by the applicant or applicants.

To the Comptroller, Patent Office,
25, Southampton Buildings, Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorization to an agent and statement of address respectively are printed below.

(1) *Where Application is made through an Agent* (*Rule* 8).

hereby appoint of to act as agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such agent at the above address.

day of , 18 .

*——.

* To be signed by applicant or applicants.

(2) *Where Application is made without an Agent* (*Rule* 9).

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at .

day of , 18 .

†——.

† To be signed by applicant or applicants.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888. **Schedule 2.**

(PATENT.) FORM A1.

To be accompanied by two copies of Form B. or of Form C.

Application for Patent for Inventions communicated from Abroad.

I* of in the county of do hereby declare that I am in possession of an invention the title of which is † , which invention has been communicated to me by ‡ ; that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my knowledge and belief; and I humbly pray that a Patent may be granted to me for the said invention.

Dated day of , 18 .

§———.

* Here insert name, and full address and calling of applicant.
† Here insert title of invention.
‡ Here insert name, address, and calling of communicant.
§ To be signed by applicant or applicants.

NOTE.—Where application is made through an agent (Rule 8) the authorization on the back (if used) should be signed by the applicant or applicants.

To the Comptroller, Patent Office,
25, Southampton Buildings, Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorization to an agent and statement of address respectively are printed below.

(*These forms are not here printed, being the same as those in Form A. above.*)

The Patent Office does not receive applications upon this form from persons resident abroad. See Notice, April 21st, 1884. This rule prevents applications for patents for communications from abroad being made by agents resident abroad, such as was allowed in *Re Wirth's Patent*, 12 Ch. D. 303.

In a communication from abroad it is not necessary to distinguish between the parts communicated and the parts invented by the patentee. (*Moser* v. *Marsden*, 10 R. P. C. 350.)

Schedule 2.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

(PATENT.) FORM A2.

Application for Patent under International and Colonial Arrangements.

* do hereby declare that I (or we) have made foreign applications for protection of my (or our) invention of † in the following Foreign States and on the following official dates, viz. : ‡ and in the following British Possessions and on the following official dates, viz. : § .

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the ‖ to the best of knowledge, information and belief, and humbly pray that a patent may be granted to for the said invention in priority to other applicants, and that such patent shall have the date ‖ .

¶ ——.

* Here insert name and full address and calling of applicant, or of each of the applicants.

† Here insert title of invention.

‡ Here insert the names of each Foreign State followed by the official date of the application in each respectively.

§ Here insert the names of each British Possession followed by the officia date of the application in each respectively.

‖ Here insert the official date of the earliest foreign application.

¶ Signature of applicant or of each of applicants.

To the Comptroller, Patent Office,
25, Southampton Buildings, Chancery Lane, London, W.C.

To be issued with Form A., A1., or A2.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form B.

Provisional Specification.

(To be furnished in Duplicate.)

* ——.

†, do hereby declare the nature of this invention to be as follows :—‡

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon white ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows :—

"Dated this day of , 18 ."

To the Comptroller, Patent Office,
25, Southampton Buildings, Chancery Lane, London, W.C.

* Here insert title as in declaration.

† Here insert name, and full address and calling of applicant or applicants as in declaration.

‡ Here insert short description of invention.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888. **Schedule 2.**

Where Provisional Specification has been left, quote No. and date.
No. .
Date .

(PATENT.) Form C.

Complete Specification.

(*To be furnished in Duplicate*—one unstamped.

* .

† do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :—

‡ .

NOTE.—This document must form the commencement of the Complete Specification ; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Complete Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows :-

"*Dated this* day of , 18 ."

To the Comptroller, Patent Office,
25, Southampton Buildings, Chancery Lane, London, W.C.

* Here insert title as in declaration.

† Here insert name, and full address and calling of applicant or applicants as in declaration.

‡ Here insert full description of invention, *which must end with a distinct statement of claim or claims, in the following form:*—

"Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is (1) ; (2) ; (3) ." [Here state distinctly the features of novelty claimed.]

PATENTS RULES, 1890, AND PATENTS RULES, 1892 (SECOND SET), AND PATENTS RULES, 1898.

These rules having been embodied in the Patent Rules, 1890 (*ante*, pp. 524, 532, 539, 540), are not here repeated.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Acts, he shall within fourteen days from the date of the decision appealed against file in the Patent Office a notice of such his intention.

See Form T. in Second Schedule to P. R. 1890.

Where the Comptroller by his decision on an opposition to the grant of a patent requires an amendment to be made in the specification, and does not in his decision settle the specific words of the amendment, the time for appealing to the law officer dates from the day of forwarding to the opponent a copy of the amendment approved by the Comptroller (*d*). The notice of appeal may be signed by the appellant's agent (*e*).

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

The effect of Rules 1 and 2 is to limit the hearing before the law officers to points specifically raised by the notice of appeal, and where a notice of appeal is given as to part only of the Comptroller's decision, the person receiving such notice, and desiring to question other parts of the Comptroller's decision, must give a counter-notice (*f*). The rule is the same when the appeal is from the whole decision (*g*).

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent, on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

In opposition cases this Rule applies only where the applicant appeals (*h*). But in *Re Hills Application* (*i*) it was stated that directions would be given

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(*d*) *Chandler's Patent*, Griffin, P. C. 270, 273; *Cooper and Ford's Patent*, Griffin, P. C. 275, 276.

(*e*) *Anderson and McKinnell's Patent*, Griffin, L. O. C. 24.

(*f*) *Bairstow's Patent*, 5 R. P. C. 287.

Re Hall and Hall's Patent 5 R . C. 283.

(*h*) *Anderson and McKinnell's Patent*, Griffin, L. O. C. 23, 24.

(*i*) 5 R. P. C. p. 601. See also *Ryland's Patent*, 5 R. P. C. 668.

to the Patent Office or to the official clerk that notice should be sent to the respondent, if he was the applicant before the comptroller.

Rule III.

Note.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

Under this Rule a further specification cannot be put in before the law officer, on opposition to the grant of a patent. Such further specification is not evidence, but is an additional ground of opposition (*k*).

Where one of the objections in a notice of opposition had imputed fraud, but no evidence in support of this imputation had been filed before the comptroller, the law officer, on the hearing of an appeal from the decision of the comptroller overruling the other objections allowing the patent, confined the opposition to the points argued before the comptroller, and refused to go into the question of fraud, or to allow evidence on that question to be put in (*l*).

Where on an opposition by an Englishman to foreigners' application for a patent, the foreigners stated that they had made an application for a patent for the same invention abroad prior in date to the Englishman's application, and asked to have the English patent ante-dated under s. 103 (*ante*, p. 492), but having filed no evidence before the comptroller as to the

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(*k*) *Bailey's Patent*, Griffin, P. C. 269.

(*l*) *Huth's Patent*, Griffin, P. C. 292.

Rule VIII. foreign patent, he had refused to notice it, they were on appeal to the law officer allowed to file evidence on paying all the costs (*m*).

NOTE. Where there was a serious conflict of scientific chemical evidence, the law officer declined to allow one chemist on each side to give *viva voce* evidence before him, but stated that he would, if necessary, call in an expert, or the appellants might apply for leave to cross-examine witnesses who had made declarations (*n*).

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

See notes under s. 38 of the Act of 1883, *ante*, p. 338.

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.
FARRER HERSCHELL, S.G.

(*m*) *L'Oiseau and Pierrard's Application*, Griffin, L. O. C. 36.

(*n*) *Lake's Patent*, 6 R. P. C. 548.

JUDICIAL COMMITTEE RULES.

AT THE COURT AT WINDSOR CASTLE, the 26th day of November, 1897.

Present,

THE QUEEN'S MOST EXCELLENT MAJESTY.
LORD PRESIDENT.
LORD PRIVY SEAL.
MR. RITCHIE.

WHEREAS by the 25th Section of an Act of Parliament passed in the 46th and 47th years of Her Majesty's reign, intituled "The Patents Designs and Trade Marks Act, 1883," it is amongst other things enacted that a patentee may, after advertising in manner directed by any rules made under the said Section his intention to do so, present a Petition to Her Majesty in Council, praying that his patent may be extended for a further term, but such Petition must be presented at least six months before the time limited for the expiration of the patent; that if Her Majesty shall be pleased to refer any such Petition to the Judicial Committee of the Privy Council the said Committee shall proceed to consider the same; and that it shall be lawful for Her Majesty in Council to make from time to time rules of procedure and practice for regulating the proceedings on such Petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee:

And Whereas Her Majesty in Council has deemed it expedient to make rules for regulating proceedings in such Petitions.

Her Majesty is therefore pleased by and with the advice of Her Privy Council to approve of the several rules and regulations contained in the Schedule hereunto annexed, and to order as it is hereby ordered that on and after the 1st January 1898 the same be respectively observed.

Whereof all persons whom it may concern are to take notice and govern themselves accordingly.

C. L. PEEL.

Rule I.

THE SCHEDULE *above referred to.*

RULES to be observed in PROCEEDINGS before the JUDICIAL COMMITTEE of the PRIVY COUNCIL under the PATENTS DESIGNS and TRADE MARKS ACT 1883, Section 25.

I.

A party intending to apply by Petition under Section 25 of the Act shall give public notice by advertising three times in the *London Gazette* and once at least in each of three London newspapers.

If the applicant's principal place of business is situated in the United Kingdom at a distance of fifteen miles or more from Charing Cross he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

The applicant shall in his advertisements state the object of his Petition and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the Matter thereof which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that Caveats must be entered at the Council Office on or before such day so named in the said advertisements.

The advertisements are proved before the case is heard (*o*).

"Once at least in some local newspaper," etc.—The old Rules required the petitioner to advertise three times in the local paper.

Under the Act of 1835 it was held that if the patentee resides aboard, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in the places where the manufacture is actually carried on (*p*).

The name of an equitable assignee of a co-petitioner must appear in the advertisements (*q*).

For forms of advertisements, see Appendix, *post*, p. 618.

(*o*) *Perkin's Patent*, 2 Webst. 8.
(*p*) *Derosne's Patent*, 2 Webst. 2.
(*q*) *Noble's Patent*, 7 Moo. P. C. 191.

II. Rule II.

A Petition under Section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

The Petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the 1st of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The Petitioner shall apply to the Lords of the Committee to fix a time for hearing the Petition, and when such time is fixed the Petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

"Must be presented within one week," etc.—In case of delay arising from mistake this Rule has not been insisted on (*r*). And a supplementary statement to correct errors in the petition has been allowed to be delivered before the hearing (*s*).

Where a petitioner who was entitled to a moiety of the patent, and who, with the assignees of the other moiety, had presented a petition for prolongation, died before the petition was heard, his widow, being executrix and residuary legatee, was allowed to appear at the hearing without a supplemental petition, but the Judicial Committee directed, in case a prolongation should be granted, that sufficient proof should be afforded to enable the recital of the death and bequest to be inserted in the new letters patent (*t*).

"Shall apply . . . to fix a time for hearing."—Where on an application to fix hearing it appeared that the petition had been presented nearly eighteen months before the expiry of the patent, the application was ordered to stand over, as the profits accruing in the meantime might materially affect the question of extension (*u*). Whether on a renewal of such an application the notices served before the first application will be sufficient, *qu.* (*x*).

Under the repealed Acts it was required that the petition should be prosecuted with effect before the patent expired; otherwise, unless the petition was presented more than six months before the date of expiration (*y*), no extension could be granted; and "prosecuted with effect" meant obtaining the report of the Judicial Committee (*z*). There is no such requirement in the present Act, and it is submitted that if the petition is presented in time extension may be granted, although the hearing does not take place till the patent has expired (*a*).

(*r*) *Hutchinson's Patent*, 14 Moo. 364.

(*s*) *Reese's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*t*) *Herbert's Patent*, L. R. 1 P. C. 399, 401.

(*u*) *Mackintosh's Patent*, 1 Webst. 739, n.

(*x*) *Ibid.*

(*y*) 5 & 6 Will. 4, c. 83, s. 4; 2 & 3 Vict. c. 67, s. 2. *Bodmer's Patent*, 1 Webst. 740.

(*z*) *Ledsam* v. *Russell*, 1 H. L. C. 687.

(*a*) Compare *Somerset and Walker's Patent*, 13 Ch. D. 397; *Johnson's Patent*, *Ibid.* 398, n.

Rules III., IV.

III.

A party presenting a Petition under Section 25 of the Act must lodge at the Council Office eight printed copies of the Specification: but if the Specification has not been printed and if the expense of making eight copies of any Drawing therein contained or referred to would be considerable the lodging of two copies only shall be deemed sufficient.

The Petitioner shall also lodge at the Council Office eight copies of the balance sheet of expenditure and receipts relating to the Patent in question which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance sheet for the use of the Solicitor to the Treasury and shall upon receiving two days' notice give the Solicitor to the Treasury, or any person deputed by him for the purpose reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet at the hearing or from which the materials for making up the said balance sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing.

"**Copies of the specification.**"—See *In re Bell's Patent* (*b*).

"**He shall also,**" **etc.**—This and the following provisions as to inspection, etc., by the Solicitor to the Treasury are new.

"**Not less than fourteen days.**"—The time in the corresponding provision of the old Rules was one week. The reason for the Rule so far as it refers to copies of the balance sheet is that it is necessary that the Attorney-General should have the power of inspecting the accounts and making inquiries; and where the accounts had only been filed on the morning of hearing the Judicial Committee refused to go into the accounts, but allowed the hearing to be postponed (*c*).

IV.

A party intending to oppose a Petition under Section 25 of the Act must enter a Caveat at the Council Office before the day on which the Petitioner applies for a time to be fixed for hearing the matter thereof and having entered such Caveat shall be entitled to have from the Petitioner four weeks' notice of the time appointed for the hearing.

The Petitioner shall serve copies of his Petition on all parties entering Caveats in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

(*b*) 2 Webst. 159.

(*c*) *Johnson's and Atkinson's Patents*, L. R. 5 P. C. 88; following *Chatwood's Patent*, *Ibid.* 88, n

All parties intending to oppose a Petition shall within three weeks after such copies are served on them respectively lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the Petition. Rules V., VI.

"**Must enter a caveat.**"—In the absence of special circumstances, the time for entering a caveat will not be extended (*d*). The caveat must be entered in the name of the actual opposer, not in that of his agent (*e*).

An alien resident abroad who was interested in an English patent by a foreign inventor, and who had had considerable dealings in this country in respect of sales of the patented machine and in granting licences, was held to have sufficient *locus standi* to oppose the extension of an English patent which would interfere with the first-mentioned patent. But it was not decided whether without such an interest he would have been entitled to inform the Crown in any matter touching letters patent (*f*).

"**Shall serve copies of his petition on all parties entering caveats,**" **etc.**—The Rule extends to cases of applications to correct an irregularity in the service of the petition. In such a case a person who has entered a caveat must be served with notice of the application (*g*).

"**Within three weeks.**"—This is an extension of the time for lodging objections. Under the old Rules the time was "within a fortnight" after service of a copy of the petition.

Grounds of their objections."—Under this Rule it is sufficient to state the grounds of objections without stating the particulars of those objections (*h*).

For forms of objections, see Appendix, *post*, p. 616.

V.

Parties shall be entitled to have copies of all papers lodged in respect of any Petition under Section 25 of the Act at their own expense.

All such Petitions and all statements of grounds of objection shall be printed in the form prescribed by the Rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance sheets of expenditure and receipts shall be printed in a form convenient for binding along with such Petitions.

VI.

Costs incurred in the matter of any Petition under Section 25 of the Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any Petition, and the Registrar or such other officer shall have

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(*d*) *Hopkinson's Patent*, 13 R. P. C. 114.

(*e*) *Loue's Patent*, 8 Moo. 1.

(*f*) *Re Schlumberger*, 9 Moo. P. C. 1.

(*g*) *Hutchinson's Patent*, 14 Moo. P. C. 364.

(*h*) *Ball's Patent*, 1 App. Cas. 171.

Rules VII., VIII.

authority to allow or disallow in his discretion all payments made to persons of science or skill examined as Witnesses.

"**Payments to persons of science or skill.**"—See *ante*, p. 242.

VII.

The Lords of the Committee may excuse Petitioners and Opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under Section 25 of the Act as they shall consider to be just and expedient.

Under the old practice the Rules might be relaxed in a proper case (*i*).

And in the case of a patent granted under the present Act, when by an oversight the parties had delayed issuing the preliminary advertisements so long that if the Rules were insisted on it would be impossible to comply with the requirement of section 25 (1), that the petition should be presented six months before the expiration of the patent, the Judicial Committee allowed the petition to be received before the insertion of the advertisements, the parties undertaking to insert before a named day the advertisements required, and the order to be served on the Attorney-General and to be subject to any objection he might make (*k*).

VIII.

The Lords of the Committee will hear the Attorney-General or other Counsel on behalf of the Crown on the question of granting the prayer of any Petition under Section 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Lords of the Committee.

The Attorney-General (see *ante*, pp. 103, 117).

"**On the question of granting,**" **etc.**—The corresponding words in the old Rules were "*against granting* any application made," etc.

"**Is not required,**" **etc.**—This is a formal enactment of the old practice under which the Attorney-General was always allowed to adduce evidence impeaching the patent irrespective of any notice of objections (*l*).

(*i*) *Jablochkoff's Patent*, 1891, A. C. 293, 294.

(*k*) *Lindon's Patent*, 14 R. P. C. 643.

(*l*) *Ball's Patent*, 4 App. Cas. 173, 174; *Stewart's Patent*, 3 R. P. C. 7; *Church's Patents*, 3 R. P. C. 101; *Liret's Patent*, 9 R. P. C. 327.

DESIGNS RULES, 1890.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Designs Rules, 1890, and shall come into operation from and immediately after the 31st day of March, 1890.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

3. The fees to be paid under the said Act, so far as it relates to applications for and registration of designs, shall be the fees specified in the First Schedule hereto. Fees.

Forms.

4. (*m*) An application for the registration of a design for articles not being lace shall be made in the form E or form O in the Second Schedule hereto. An application for one design to be applied to lace shall be made in the form E1 in the Second Schedule hereto, and for one design to be applied to a set of lace articles shall be made in the form O1 in the Second Schedule hereto. A request for registration of the name of any subsequent proprietor of a lace design or set of lace designs shall be made in the form K1 in the Second Schedule hereto. The remaining forms in such Schedule may be used in all cases to which they are applicable. Forms.

Classification of Goods.

5. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

This is a re-enactment, with considerable alterations, of the classes contained in section 3 of the Act of 1842.

(*m*) Substituted for original Rule 4 by Designs Rules, 1893. These latter rules, and also the Designs Rules, 1898, having been embodied in the Designs Rules, 1890, as here printed, see *post*, pp. 556, 558, 560, and 561, are not printed separately in this book.

Rule 6. APPLICATION FOR REGISTRATION.

Agents.

6. (*n*) All communications between an applicant for the registration of a design and the Comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, but the Comptroller shall not be bound to recognise as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

Address of Comptroller.

7. An application for the registration of a design shall, with the prescribed fee, be left at the Patent Office, Designs Branch, or be sent prepaid by post, addressed to the Comptroller at the Patent Office (Designs Branch), 25, Southampton Buildings, Chancery Lane, London.

Size of papers.

8. An application for the registration of a design, and all drawings, sketches, photographs, or tracings of a design, and all other documents sent to or left at the Patent Office (Designs Branch), or otherwise furnished to the Comptroller or to the Board of Trade, shall be written, printed, copied, or drawn upon strong wide-ruled foolscap paper (on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand.

The Comptroller may in any particular case vary the requirements of this Rule as he may think fit.

Sketches and drawings.

Nature of design.

9. An application for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design, and shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

When sketches, drawings, or tracings are furnished they must be fixed.

When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs shall be furnished.

"**Nature of the design.**"—See *ante*, p. 355.

"**Shape or configuration.**"—See *ante*, pp. 373, 374.

(*n*) Substituted by Designs Rules, 1898, for original Rule 6.

10. If the Comptroller determines to register a design, he shall as soon as may be send to the applicant a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office. **Rule 10.** Notice of registration.

Rule 11 *is the same as P. R.* 16A. Applications may be sent by post.

Exercise of Discretionary Powers.

Rules 12, 13, 14, *are nearly the same as P. R., rr.* 11, 12, 14, *ante*, pp. 524, 525.

Appeal to the Board of Trade.

15. Where the Comptroller refuses to register a design, and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Designs Branch, a notice of such his intention. Notice of appeal to Board of Trade.

16. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof. Statement on appeal.

17. The applicant shall forthwith on leaving such notice send a copy thereof to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London. Notice to Secretary of Board of Trade.

18. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal for the Board of Trade. Directions by Board of Trade.

"For the Board of Trade."—Proceedings under the Acts, by or before the Board of Trade, are now regulated by the Act of 1888, s. 25, *ante*, p. 521.

19. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the Comptroller and the applicant. Notice of time of hearing.

Register of Designs.

20. Upon the sealing of a certificate of registration the Comptroller shall cause to be entered in the register of designs the name, address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller, which day shall be deemed to be the date of the registration. Registering design.

Rules 21, 22, 23, *relating to entry of names of subsequent proprietors are practically the same as P. R., rr.* 68, 69, 70, *ante*, p. 536. Subsequent proprietors.

Rule 24.

Statutory declaration with request.

24. Every such request shall be accompanied by a statutory declaration to be thereunder written verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

Proof of title if required.

Rules 25 *and* 26 *are practically the same as P. R., rr.* 71, 73, *ante, pp.* 536, 537.

Corporate name.

Notice to Comptroller of application to rectify register.

27. Four clear days' notice of every application to the Court under section 90 of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, for rectification of the Register of Designs, shall be given to the comptroller.

Notice of order of Court.

Rule 28 *is practically the same as P. R.* 74, *ante, p.* 537.

Power to Dispense with Evidence.

Rule 29 *is same as P. R.* 80, *ante, p.* 538.

Amendments.

Rule 30 *is substantially the same as P. R.* 16, *ante, p.* 525, *and is extended to "drawings, sketches, or tracings."*

Enlargement of Time.

Rule 31 *is substantially the same as P. R.* 51, *ante, p.* 533.

Marking Goods.

Registration mark.

32. (*a*) Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall if such article is included in Class 13 or Class 14 in the Third Schedule hereto cause each such article to be marked with the abbreviation Regd., and shall, if such article is included in any of the Classes 1 to 12 in the Third Schedule hereto, cause each such article to be marked with the abbreviation Rd., and also, in the case of articles other than lace, with the number appearing on the certificate of registration.

A re-enactment, with modifications simplifying details, of s. 4 of the Act of 1842. See *ante*, p. 359.

Putting "Regd." on an article which ought to be marked "Rd." does not invalidate the registration (*o*).

(*a*) Substituted for original Rule 32 by Designs Rules, 1893.

(*o*) *Heinrichs* v. *Bastendorff*, 10 R. P. C. 160.

INSPECTION. Rule 33.

33. On such days and during such hours as the Comptroller shall from time to time determine and notify by a placard posted at the Patent Office any person paying the prescribed fee may, on production of the number of any design of which the copyright has ceased, inspect such design, and any person paying the prescribed fee may take a copy or copies of such design. Office hours.

Inspection is now, by the Act of 1888, s. 6, also allowed where registration is refused on the ground of identity with a design already registered. See *ante*, p. 514.

CERTIFICATE BY COMPTROLLER.

34. Where a certificate is required for the purpose of any legal proceeding or other special purpose as to any entry, matter, or thing which the Comptroller is authorised by the said Act or these Rules to make or do, the Comptroller may, on a request in writing and on payment of the prescribed fee, give such certificate, which shall also specify on the face of it the purpose for which it has been requested as aforesaid. Certificate, legal proceeding.

SEARCHES ON PRODUCTION OF SKETCH OF DESIGN.

35. The comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office, and inform any person requesting him so to do whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing. Search.

A letter from the comptroller giving this information is not evidence in an action for infringement (*p*).

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

Rule 36 *is substantially the same as P. R.* 15, *ante*, p. 525.

REPEAL.

37. All general rules as to the registration of Designs heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be, and they are hereby, repealed, as from that date, without prejudice, nevertheless, to any proceeding which may have been taken under such Rules. Repeal of previous Rules.

M. E. HICKS-BEACH,
31*st March*, 1890. *President of the Board of Trade.*

(*p*) *Smith* v. *Hope*, 6 R. P. C. 200, 204.

SCHEDULES.

FIRST SCHEDULE

Fees.

	£	s.	d.
1. On application to register one design to be applied to single articles in each class not being lace and except articles in classes 13 and 14*	0	10	0
2. On application to register one design to be applied to lace, or to single articles in classes 13 and 14*	0	1	0
3. On application to register one design to be applied to a set of articles, not being lace, for each class of registration*	1	0	0
3a. On application to register one design to be applied to a set of lace articles*	0	2	0
4. On notice of appeal to Board of Trade against refusal of Comptroller to register	1	0	0
5. Copy of certificate of registration, each copy	0	1	0
6. On request for certificate of Comptroller for legal proceedings or other special purpose	0	5	0
7. On request to enter name of subsequent proprietor ...	same as registration fee.		
8. On notice to Comptroller of intended exhibition of an unregistered design	0	5	0
9. Inspection of design in any case in which inspection is permitted by the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and the Designs Rules thereunder, for each quarter of an hour	0	1	0
10. Copy of one such design	cost according to agreement.		
11. On request to correct clerical error	0	5	0
12. On request for search under section 53	0	5	0
13. On request to enter new address	0	5	0
14. For office copy, every 100 words	0	0	4 (but never less than 1s.)
15. For certifying office copies, MSS. or printed	0	1	0

NOTE.—The term "set" to include any number of articles ordinarily on sale together irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,
R. E. WELBY,
For the Lords Commissioners of Her Majesty's Treasury.

31*st March*, 1890.

* Substituted for original fees, 1, 2, 3, by Designs Rules, 1893.

SECOND SCHEDULE. Schedule 2.

FORMS.

E.—Form of Application to Register, p. 561.
F.— ,, Appeal to Board of Trade.
G.— ,, Certificate of Registration.
H.— ,, Application for Copy of Certificate of Registration.
I.— ,, Request for Certificate for use in Legal Proceedings.
J.— ,, Certificate for use in Legal Proceedings.
K.— ,, Request to enter Name of Subsequent Proprietor.
L.— ,, Notice of intending Exhibition of Unregistered Design.
M.— ,, Request for Correction of Clerical Error or for entry of New Address.
N.— ,, Request for Search under Section 53.
O.— ,, Application to Register for a set of Articles.
E1.— ,, Application for Registration of a Lace Design in Class 9, p. 562.
O1.— ,, Application for Registration of a Lace Design to be applied to a Set.
K1.— ,, Request to enter name of subsequent Proprietor of a Lace Design or Set of Lace Designs.

Forms E1, O1, K1, were added by Designs Rules, 1893.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

(DESIGNS.) Form E.

Application for Registration of a Design in Classes _____.

You are hereby requested to register the accompanying design in Class , in the name of* , of , who claims to be the proprietor thereof, and to return the same to .

Statement of nature of design† .

(Signed)‡ .

Dated the day of , 189 .

To the Comptroller, Patent Office, Designs Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

* Here insert legibly the name, address, and description of the individual or firm.

† Such as whether it is applicable for the pattern or for the shape.

‡ To be signed by the applicant.

Schedule 2. PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

(DESIGNS.) Form E1.

Application for Registration of a Lace Design in Class 9.

You are hereby requested to register, without search, the accompanying Design in Class 9 in the name of* who claims to be the proprietor thereof, and to return the same to .

The nature of the design is the pattern.

(Signed)† .

Dated the day of 189 .

To the Comptroller, the Patent Office (Designs Branch),
25, Southampton Buildings, London, W.C.

* Here insert legibly the name, address, and description of the individual or firm.

† To be signed by the applicant or his agent duly authorised. When signed by an agent there should be added to the signature "Agent duly authorised by authorisation dated the day of 189 ."

THIRD SCHEDULE.

CLASSIFICATION OF ARTICLES OF MANUFACTURE AND SUBSTANCES.

Classes.

1. Articles composed wholly or chiefly of metal, not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, papier maché, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware, or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including bookbinding, of all materials.
7. Paper hangings.
8. Carpets and rugs in all materials, floorcloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework on muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece goods.
14. Printed or woven designs on handkerchiefs and shawls.

M. E. HICKS-BEACH,
President of the Board of Trade.

31*st March*, 1890.

Goods divided in pattern by cross lines, showing they would be sold not by measurement but by number, such as dusters woven in sets of 12, ought to be registered in class 14. (*Hotherall* v. *Moore*, 9 R. P. C. 27, 38.)

TRADE MARKS RULES, 1890.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules :—

Preliminary.

1. These Rules may be cited as the Trade Marks Rules, 1890, and shall come into operation from and immediately after the 31st day of December, 1889.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade marks, shall be the fees specified in the First Schedule hereto. Fees.

Forms.

4. The Form F in the First Schedule to the Patents, Designs, and Trade Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the Second Schedule to these Rules. Forms.

5. (1) An application for registration of a trade mark shall be made in the Form F in the Second Schedule to these Rules; (2) the remaining forms in such Schedule may be used in all cases to which they are applicable.

Classification of Goods.

6. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

Rule 6. If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

"**Classified.**"—Applications for the registration of the same mark in different classes are to be treated as separate and distinct applications. See T. M. R. 1897, r. 13, *post*, p. 585.

Application for Registration.

Application by firm.

7. An application for registration of a trade mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be.

If the application be made by a body corporate it may be signed by the Secretary or other principal officer of such body corporate.

Address of application.

8. Where a trade mark for registration of which application is made is in classes 23, 24 or 25 of the Third Schedule to these Rules, the applicant shall address and send his application to the Manchester Trade Marks Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under Section 81 of the said Acts should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

Agency.

9. An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.

Acknowledgment of application.

10. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

11. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

Size, etc., of documents.

12. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Rules 13, 14 *and* 15 *relating to "Representations of Trade Marks," "Representations of a series of Trade Marks," and "Translation of Foreign Characters," are repealed and re-enacted with additions and modifications by T. M. R.*, 1897, *post, p.* 584. Rules 13-15.

16. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. Mode of sending notices, etc.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Exercise of Discretionary Powers.

Rules 17 *and* 18 *are practically the same as P. R., rr.* 11, 12, *ante, pp.* 524, 525.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant. Notification of decision.

Appeal to the Board of Trade.

20. When any person intends to appeal to the Board of Trade from a decision of the Comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade Marks Branch, a notice of such his intention. Notice of appeal.

21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof. Grounds of appeal to be stated.

22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and where there has been an opposition before the Comptroller to the opponent or applicant as the case may be. Transmission of notice.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same. Directions by Board.

24. Where the Board of Trade intend to hear the appeal seven days' notice, or such shorter notice as the Board of Hearing of appeal.

Rule 24. Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and to the appellant, and where there has been an opposition before the Comptroller to the opponent or applicant as the case may be.

No appeal unless notice duly given.

25. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

Evidence on appeal.

26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the Comptroller.

Advertisement of Application.

Advertisement of application.

27. Every application shall be advertised by the Comptroller in the official paper, during such times, and in such manner as the comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade mark be inserted in the official paper in connexion with the advertisement of an application, the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

Definition of official paper.

28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade mark to be supplied to official paper.

29. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

Advertisement of series.

30. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 66 of the said Acts, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the Comptroller may, if he thinks

fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another. Rule 30.

Opposition to Registration.

31.—(1.) A notice of opposition to the registration of a trade mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the Second Schedule to these Rules, with such variations as circumstances may require. Notice of opposition.

(2.) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the register of such trade mark already on the register. Opposition of the ground of trade mark already on the register.

(3.) Within two months after the expiration of one month or such further time not exceeding three months as the Comptroller may allow from the date of the advertisement of the application, the opponent shall leave at the Patent Office, Trade Marks Branch, such evidence by way of statutory declaration as he may desire to adduce in support of his opposition and deliver to the applicant copies thereof. Opponent's evidence.

(4.) (*a*) Within one month from the delivery of the opponent's copies of his statutory declarations the applicant shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery the opponent shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply. Applicant's evidence. Evidence in reply.

(5.) No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller given on an application made to him. Closing of evidence.

(*a*) The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition.

Rule 31.

Applications for leave to adduce further evidence.

(6.) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Appointment of time for hearing.

(7.) On the completion of the evidence the Comptroller shall, upon application by either party, upon Form E in the Second Schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Disallowance of opposition in certain cases.

(8.) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the register of the said trade mark already on the register have been duly specified in the notice of opposition.

Decision to be notified to parties.

(9.) The decision of the Comptroller in the case shall be notified to the parties.

Register of Trade Marks.

Time of registration of trade marks.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the Comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description of the applicant in the Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

33. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in register.

34. Upon registering any trade mark the Comptroller shall enter in the register the date on which the application for

registration was received by the Comptroller, and such other particulars as he may think necessary. Rule 34.

35. The Comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper. Notice of registration.

Rules 36, 37, *registration of subsequent proprietors, are substantially the same as P. R., rr.* 68, 69, *ante, p.* 536. Request by subsequent proprietor. Signature of request.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered. Contents of request.

39. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request. Declaration to accompany request.

40. The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction. Further proof of title if required.

41. A body corporate may be registered as proprietor by its corporate name. Body corporate.

42. The term "applicant" in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark. Definition of applicant.

43. Whether all such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by section 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require. Comptroller may require statement from rival claimants.

44. Where each of several persons claims to be registered as proprietor of the same trade mark, and the Comptroller refuses to register any of them until their rights have been Submission to court of conflicting claims.

Rule 44. determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the Comptroller, or if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

Settlement of special case.

45. Where the special case is to be submitted by the parties it may be agreed to by them, or if they differ, may be settled by the Comptroller on payment of the prescribed fees.

Order of Court.

46. Where an order has been made by the Court in either of the following cases, viz.: —

(a) allowing an appeal under section 62 of the said Acts;
(b) disallowing an opposition to registration under section 69; or,
(c) under the provisions of sections 72, 90, or 92 of the said Acts,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office, Trade Marks Branch, an office copy of such order. The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Removal of mark from register.

47. Where a trade mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of section 79 of the said Acts, the Comptroller shall cause to be entered in the register a record of such removal and the cause thereof.

Alteration of address in register.

48. If the registered proprietor of a trade mark send to the Comptroller, together with the prescribed fee, notice of an alteration in his address, the Comptroller shall alter the register accordingly.

Notice to Comptroller of applications to rectify register.

49. Four clear days' notice of every application to the Court under section 90 of the said Acts, for rectification of the register, shall be given to the Comptroller.

Publication of rectification or variation of register.

50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register.

51. Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark, under section 92 of the said Acts, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the Comptroller such a number of representations of the trade mark as altered as he may deem sufficient.

Rule 51. Notice to Comptroller of order of Court for alteration of trade mark under s. 92 of Acts.

The marginal note does not agree with the Rule.

Inspection of Register.

Rule 52 is the same as P. R. 78, ante, p. 537, except that r. 52 provides for the payment of a fee on inspection. See First Schedule, post, p. 573.

Power to Dispense with Evidence.

Rule 53 is the same as P. R. 80, ante, p. 538.

Amendments.

Rule 54 is the same as P. R. 16, ante, p. 525, and is extended to any "drawing or other representation of a trade mark."

Enlargement of Time.

Rule 55 is the same as P. R. 51, ante, p. 533.

Cutlers' Company.

56. All applications to the Cutlers' Company for registration of a trade mark, under section 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

Sheffield applications in duplicate.

57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Notice to Comptroller.

58.—(1.) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said Company shall be one month from the date of the receipt by the Comptroller of the notice from the said Company of the making of the application.

Time within which Comptroller may object to application made at Sheffield.

Rule 58. Advertisement of application made at Sheffield.

(2.) If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotype as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

Manner of notifying to Cutlers' Company application received by Comptroller.

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-section (8) of section 81 of the said Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings at London and at Sheffield.

59. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

Certificates.

Rule 60 *is substantially the same as D. R.* 34, *ante, p.* 559.

Declarations.

Rule 61 *is the same as P. R.* 17, *ante*, p. 526.

Notice of seal of officer taking declaration to prove itself.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Repeal.

Previous rules repealed.

63. All general rules as to the registration of trade marks heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application pending at the said date.

M. E. Hicks-Beach,
President of the Board of Trade.

SCHEDULES.

FIRST SCHEDULE.

FEES.

	£	s.	d.
1. On application to register a trade mark for one or more articles included in one class	0	5	0
2. For registration of a trade mark for one or more articles included in one class	1	0	0
3. For registering a series of trade marks, for every additional representation after the first in each class	0	5	0
4. On appeal from Comptroller to Board of Trade—by appellant	1	0	0
5. On notice of opposition for each application opposed—by opponent	1	0	0
6. On hearing by Comptroller—by applicant and by opponent respectively	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time...	0	2	0
9. For continuance of mark at expiration of 14 years	1	0	0
10. Additional fee where fee is paid within three months after expiration of 14 years	0	10	0
11. Additional fee for restoration of trade mark where removed for non-payment of fee	1	0	0
12. For altering address on the register, for every mark ...	0	5	0
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
14. For cancelling the entry or part of the entry of a trade mark upon the register, on the application of the owner of such trade mark	0	5	0
15. On request to Comptroller to correct a clerical error, or permit amendment of application under section 91...	0	5	0
16. For certificate of refusal to register a trade mark under section 77...	1	0	0
17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first	0	10	0
18. For certificate of registration to be used in legal proceedings	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20. For certificate of Comptroller under section 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country	0	5	0
21. For copy of notification of registration	0	2	0
22. Settling a special case by Comptroller	2	0	0
23. For inspecting register, for every quarter of an hour ...	0	1	0
24. For making a search amongst the classified representations of trade marks, for every quarter of an hour	0	1	0
25. For office copy of documents, for every 100 words (but never less than one shilling)	0	0	4
26. For certifying office copies, MS. or printed	0	1	0

Schedule 1.		£	s.	d.
	27. In cases where the wood-block or electrotype of the trade mark exceeds 2 inches in breadth or depth, or in breadth and depth—For every inch or part of an inch over 2 inches in breadth	0	2	0
	For every inch or part of an inch over 2 inches in depth ...	0	2	0
	28. Manchester Trade Marks Office	Same as above		
	29. Sheffield Marks	Same as above		
	30. On appeal from Cutlers' Company, Sheffield, to Comptroller	1	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,
FRANK MOWATT,
Assistant Secretary
for the Lords Commissioners of Her Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

E.—Form of Application for Hearing by Comptroller.
F.— ,, Application for Registration. See *post*, p. 575.
G.— ,, Additional Representation of Trade Mark.
H.— ,, Appeal to Board of Trade.
I.— ,, Transmission of Registration Fee.
J.— ,, Notice of Opposition.
K.— ,, Request to Enter name of Subsequent Proprietor of Trade Mark. See *post*, p. 576.
L.— ,, Request for Certificate of Refusal.
M.— ,, Notice of Application for Alteration of Address.
N.— ,, Notice of Order of Court for Rectification of Register.
O.— ,, Application to Cancel Entry on Register.
P.— ,, Declaration in support of Application to Cancel Entry.
Q.— ,, Request to Comptroller for Correction of Clerical Error, or for Permission to Amend Application under section 91.
R.— ,, Request for Certificate of Registration for use in obtaining Registration Abroad.
S.— ,, Request for Certificate of Registration for use in Legal Proceedings.
T.— ,, Application for Settlement of a Special Case.
Tl.— ,, Request for General Certificate of Comptroller.
U.— ,, General Certificate of Comptroller.
V.— ,, Request for Copy of Notification of Registration.
W.— ,, Appeal from Cutlers' Company.
X.— ,, Application for Continuance on Register.
Y.— ,, Transmission of Additional Fee.
Z.— ,, Application for Restoration to Register.
— ,, Application for Registration of old Corporate Trade Mark.

Schedule 2.

(TRADE MARKS.)

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form F.

Application for Registration of Trade Mark.

One representation to be fixed within this square, and two others to be sent on separate half sheets of foolscap.
Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

You are hereby requested to register the accompanying trade mark in class in respect of * in the name of † who claims to be the proprietor thereof ‡.

The essential particulars of the trade mark are the following § and disclaim any right to the exclusive use of the added matter.

(Signed) ——— ‖

Dated the day of , 18 .

To the Comptroller, Patent Office, Trade Marks Branch,
25, Southampton Buildings, London.

[Or where the application is for a mark in classes 23, 24, or 25,]

To the Comptroller, Manchester Trade Marks Branch,
48, Royal Exchange, Manchester.

NOTE.—If the trade mark has been in use in respect of the goods since before August 13th, 1875, state length of such user (*b*).

* Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

† Here insert legibly the full name, address and description of the individual firm or company. Add trading style (if any).

‡ Alter to "claim to be the proprietors thereof" in the case of a firm or company.

§ See sub-sections (2) and (3) of section 64 of the Acts.

‖ To be signed by the applicant or by an agent duly authorised.

(*b*) The Comptroller may require proof of the time of user of the old mark. See *ante*, p. 386, and form of declaration, Appendix, *post*, p. 606.

Schedule 2.

(TRADE MARKS.)

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form K.

Request to Enter Name of subsequent Proprietor of Trade Mark upon the Register, with Declaration in support thereof.

I * hereby request that you will enter † name ‡ in the Register of Trade Marks as proprietor of the Trade Mark No. in Class .

§ entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered.

‖ .

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said trade mark as above claimed.

¶ And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

** _____

Declared at , this day of , 18 .

Before me,

†† _____

To the Comptroller, Patent Office, Trade Marks Branch, 25, Southampton Buildings, London.

* *Or* we. Here insert name, full address, and description.

† My *or* our.

‡ *Or* names.

§ I am *or* We are.

‖ Here state whether trade mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof as, *e.g.*, "by deed dated the day of . 18 , made between so-and-so of the one part."

¶ This paragraph is not required when the declaration is made out of the United Kingdom.

** To be signed here by the person making the declaration.

†† Signature and title of the authority before whom the declaration is made.

THIRD SCHEDULE. Schedule 3.

General Note.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the Comptroller may desire.

CLASSIFICATION OF GOODS.

	Illustrations.
	Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.
Class 1.	
Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.	Such as— Acids, including vegetable acids. Alkalies. Artists' colours. Pigments. Mineral dyes.
Class 2.	
Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure. Cattle medicines. Deodorisers. Vermin destroyers.
Class 3.	
Chemical substances prepared for *use in medicine and pharmacy.*	Such as— Cod liver oil. Medicated articles. Patent medicines. Plasters. Rhubarb.
Class 4.	
Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.	Such as— Resins. Oils used in manufactures and not included in other classes. Dyes, other than mineral. Tanning substances. Fibrous substances (*e.g.*, cotton, hemp, flax, jute). Wool. Silk. Bristles. Hair. Feathers. Cork. Seeds. Coal. Coke. Bone. Sponge.

Schedule 3.

	Illustrations.
CLASS 5. Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast. Iron, rough. ,, bar and rail, including rails for railways. ,, bolt and rod. ,, sheet, and boiler and armour plates. ,, hoop. Lead, pig. ,, rolled. ,, sheet. Wire. Copper. Zinc. Gold, in ingots.
CLASS 6. Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.	Such as— Steam engines. Boilers. Pneumatic machines. Hydraulic machines. Locomotives. Sewing machines. Weighing machines. Machine tools. Mining machinery. Fire engines.
CLASS 7. Agricultural and horticultural machinery, and parts of such machinery.	Such as— Ploughs. Drilling machines. Reaping machines. Thrashing machines. Churns. Cyder presses. Chaff cutters.
CLASS 8. Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.	Such as— Mathematical instruments. Gauges. Logs. Spectacles. Educational appliances.
CLASS 9. Musical instruments.	
CLASS 10. Horological instruments.	
CLASS 11. Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.	Such as— Bandages. Friction gloves. Lancets. Fleams. Enemas.

	Illustrations.	Schedule 3
CLASS 12.		
Cutlery and edge tools.	Such as— Knives. Forks. Scissors. Shears. Files. Saws.	
CLASS 13.		
Metal goods not included in other classes.	Such as— Anvils. Keys. Basins (metal). Needles. Hoes. Shovels. Corkscrews.	
CLASS 14.		
Goods of precious metals (including aluminium, nickel, Britannia metal, etc.) and jewellery, and imitations of such goods and jewellery.	Such as— Plate. Clock cases and pencil cases of such metals. Sheffield and other plated goods. Gilt and ormolu work.	
CLASS 15.		
Glass.	Such as— Window and plate glass. Painted glass. Glass mosaic. Glass beads.	
CLASS 16.		
Porcelain and earthenware.	Such as— China. Stoneware. Terra Cotta. Statuary porcelain. Tiles. Bricks.	
CLASS 17.		
Manufactures from mineral and other substances for building or decoration.	Such as— Cement. Plaster. Imitation marble. Asphalt.	
CLASS 18.		
Engineering, architectural, and building contrivances.	Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric and pneumatic bells.	

Schedule 3.

	Illustrations.
Class 19.	
Arms, ammunition, and stores not included in Class 20.	**Such as—** **Cannon.** **Small-arms.** **Fowling pieces.** **Swords.** **Shot and other projectiles.** **Camp equipage.** **Equipments.**
Class 20.	
Explosive substances.	**Such as—** **Gunpowder.** **Gun-cotton.** **Dynamite.** **Fog-signals.** **Percussion caps.** **Fireworks.** **Cartridges.**
Class 21.	
Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	**Such as—** **Boats.** **Anchors.** **Chain cables.** **Rigging.**
Class 22 (*o*).	
Carriages.	**Such as—** **Railway carriages.** **Waggons.** **Railway trucks.** **Bicycles.** **Bath chairs.**
Class 23.	
(a) Cotton yarn and sewing cotton not on spools or reels. **(b) Sewing cotton on spools or reels.**	
Class 24.	
Cotton piece goods of all kinds.	**Such as—** **Cotton shirtings.** **Long cloth.**
Class 25 (*p*).	
Cotton goods not included in Classes 23, 24, or 38.	**Such as—** **Cotton lace.** **Cotton braids.** **Cotton tapes.**

(*o*) In certain classes four representations of each mark must be supplied by the applicant, three only being required in other cases (R. 13, *post*, p. 584).

(*p*) The late Manchester Committee of Experts, which was formed under the Act of 1875 to divide old cotton marks into two classes, viz., such as were, and such as were not, in the opinion of the committee, trade marks within the Act, was not a judicial tribunal, and its decisions are not conclusive upon the court (*Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479).

	Illustrations.	Schedule 3
CLASS 26. Linen and hemp yarn and thread.		
CLASS 27. Linen and hemp piece goods.		
CLASS 28. Linen and hemp goods not included in Classes 26, 27, and 50.		
CLASS 29. Jute yarns and tissues, and other articles made of jute not included in Class 50.		
CLASS 30. Silk, spun, thrown, or sewing.		
CLASS 31. Silk piece goods.		
CLASS 32. Other silk goods not included in Classes 30 and 31.		
CLASS 33. Yarns of wool, worsted, or hair.		
CLASS 34. Cloths and stuffs of wool, worsted, or hair.		
CLASS 35. Woollen and worsted and hair goods not included in Classes 33 and 34.		
CLASS 36. Carpets, floor-cloth, and oil-cloth.	Such as— Drugget. Mats and matting. Rugs.	
CLASS 37. Leather, skins unwrought and wrought, and articles made of leather not included in other classes.	Such as— Saddlery, Harness. Whips. Portmanteaus. Furs.	
CLASS 38. Articles of clothing.	Such as— Hats of all kinds. Caps and bonnets. Hosiery. Gloves. Boots and shoes. Other ready-made clothing.	

Schedule 3.

	Illustrations.
CLASS 39.	
Paper (except paperhangings), stationery, and bookbinding.	Such as— Envelopes. Sealing wax. Pens (except gold pens). Ink. Playing cards. Blotting cases. Copying presses.
CLASS 40.	
Goods manufactured from india-rubber and gutta-percha not included in other classes.	
CLASS 41.	
Furniture and upholstery.	Such as— Paper hangings. Papier-mâché. Mirrors. Mattresses.
CLASS 42.	
Substances used as food, or as ingredients in food.	Such as— Cereals. Pulses. Olive oil. Hops. Malt. Dried fruits. Tea. Sago. Salt. Sugar. Preserved meats. Confectionery. Oil cakes. Pickles. Vinegar. Beer clarifiers.
CLASS 43.	
Fermented liquors and spirits.	Such as— Beer. Cyder. Wine. Whisky. Liqueurs.
CLASS 44.	
Mineral and aërated waters, natural and artificial, including ginger-beer.	
CLASS 45.	
Tobacco, whether manufactured or unmanufactured.	
CLASS 46.	
Seeds for agricultural and horticultural purposes.	

Schedule 3.

	Illustrations.
CLASS 47.	
Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches, and starch, blue, and other preparations for laundry purposes.	Such as— Washing powders. Benzine collas.
CLASS 48.	
Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).	
CLASS 49.	
Games of all kinds and sporting articles not included in other classes.	Such as— Billiard tables. Roller skates. Fishing nets and lines. Toys.
CLASS 50.	
Miscellaneous— (1.) Goods manufactured from ivory, bone, or wood, not included in other classes. (2.) Goods manufactured from straw or grass, not included in other classes. (3.) Goods manufactured from animal and vegetable substances, not included in other classes. (4.) Tobacco pipes. (5.) Umbrellas, walking sticks, brushes, and combs. (6.) Furniture cream, plate powder. (7.) Tarpaulins, tents, rickcloths, rope, twine. (8.) Buttons of all kinds, other than of precious metal or imitations thereof. (9.) Packing and hose of all kinds. (10.) Goods not included in the foregoing classes.	Such as— Coopers' wares.

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

TRADE MARKS RULES, 1897.

By virtue of the provisions of the Patents, Designs, and T. de Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

(1.) These Rules may be cited as the Trade Marks Rules, 1897, and shall come into operation from and immediately after the date hereof.

(2.) Rules 13, 14 and 15 of the Trade Marks Rules, 1890, are hereby repealed and instead thereof there shall be substituted the following:—

13. Every application for registration of a Trade Mark shall contain a representation of the mark affixed to it in the square which the Form F contains for that purpose.

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth or other material that the comptroller may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded over.

With every application for registration sent to the Manchester Trade Marks Branch, there shall be supplied four additional representations of each mark on the Form G, exactly corresponding with that on the application Form F, and noted with all such particulars as may from time to time be required by the Comptroller or by the Keeper of Cotton Marks at Manchester. Such particulars shall, if required, be signed by the applicant or his agent.

In the case of marks applied for in any of the Classes 5, 6, 7, 11, 12, 13, 14, 22, 26, 27, 28, 29, 30, 31, 32, 33, 34 and 35, there shall be sent with the application four additional representations of each mark on the Form G, exactly corresponding with that affixed to the application in Form F, and noted with all such particulars as may from time to time

be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent. Rule 13.

In the case of marks applied for in any other Class there shall be sent with the application three additional representations of each mark on the Form G, exactly corresponding to that affixed to the application Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

All representations of marks must be of a durable nature, but the applicant may in case of need supply in place of representations on the Form G, half sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

The Comptroller, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the Trade Mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any Trade Mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

"Particulars."—The requirement as to particulars is new.

14. When application is made for the registration of a series of Trade Marks under Section 66 of the Patents, Designs, and Trade Marks Act, 1883, a representation of each Trade Mark of the series shall be affixed, as aforesaid, to the application upon Form F, and to each of the accompanying Forms G.

15. When a Trade Mark contains a word or words in other than Roman characters, there shall be endorsed on the application in Form F, and on each of the

Rule 15.

accompanying representations in Form G, a sufficient transliteration and translation to the satisfaction of the Comptroller of each of such words, and every such endorsement shall be signed by the applicant or his agent.

Where a Trade Mark contains a word or words in a language other than English, the Comptroller may ask for an exact translation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.

Dated this thirty-first day of December, 1897.

CHAS. T. RITCHIE,
President of the Board of Trade.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

Signed at Paris, March 20, 1883.

[*Ratifications exchanged at Paris, June 6, 1884.*]

I.

International Convention (*q*).

(Translation.)

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say :—[*Here follow the names*]

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles :—

Article I.

The governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

To this Convention Her Majesty's Government acceded on March 17, 1884.

The following governments are now parties to the Convention :—

Belgium.	East Indian Colonies of the Netherlands.	Netherlands.	Servia.
Brazil.		New Zealand.	Spain.
Curaçoa and Surinam.	France.	Norway.	Sweden.
	Great Britain.	Portugal.	Switzerland.
Denmark.	Italy.	Queensland.	Tunis.
		Santo Domingo.	United States.

(*q*) The original French of the most important Articles of the Convention and Final Protocol is given under each Article.

Article I.

Similar arrangements, for the mutual protection of inventions, designs, and trade marks, have been made between Great Britain on the one side, and each of the following states and colonies on the other :—

Ecuador (Designs and Trade Marks only). Greece (Designs and Trade Marks only). Mexico. Paraguay. Roumania (Designs and Trade Marks only). Tasmania. Uruguay. Western Australia (*r*).

And by various Orders in Council, the Act of 1883 has been declared applicable in the case of the above countries. See s. 103 (4), *ante*, p. 493.

"**Industrial Property.**"—By clause 1 of the final protocol (*post*, p. 595), the words "industrial property" in this article are to be understood in their broadest sense ; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, etc.), and to mineral products employed in commerce (mineral waters, etc.).

"1. Les mots 'Propriété Industrielle' doivent être entendus dans leur acception la plus large, en ce sens qu'ils s'appliquent non seulement aux produits de l'industrie proprement dite, mais également aux produits de l'agriculture (vins, grains, fruits, bestiaux, etc.), et aux produits minéraux livrés au commerce (eaux minérales, etc.)."

See *post*, Art. VII.

Article II.

The subjects or citizens of each of the contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

"Les sujets ou citoyens de chacun des États Contractants jouiront, dans tous les autres États de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

"En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque État."

"Patents."—By clause 2 of the final protocol (*post*, p. 595), the word "patents" includes the various kinds of industrial patents, recognized by

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(*r*) See Circular of Information issued by the Patent Office, 1897, p. 8.

the legislation of each of the contracting States, such as importation patents, improvement patents, etc. Article II.

"2. Sous le nom de 'Brevets d'Invention' sont comprises les diverses espèces de brevets industriels admises par les législations des États Contractants, telles que brevets d'importation, brevets de perfectionnement, etc."

"Provided they observe the formalities," etc.—By clause 3 of the final protocol the last paragraph of this article "does not affect the legislation of each of the contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals."

"3. Il est entendu que la disposition finale de l'Article II de la Convention ne porte aucune atteinte à la législation de chacun des États Contractants, en ce qui concerne la procédure suivie devant les Tribunaux et la compétence de ces Tribunaux."

Article III.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the contracting States.

"Sont assimilés aux sujets ou citoyens des États Contractants les sujets ou citoyens des États ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des États de l'Union."

Article IV.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

"Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des Etats Contractants,

Article IV.

jouira, pour effectuer le dépôt dans les autres États, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

"En conséquence, le dépôt ultérieurement opéré dans l'un des autres États de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

"Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outremer."

Applications in the United Kingdom under this article for patents are to be made in accordance with the provisions of the Patents Rules, 1890 (*s*), rr. 25—27, and by r. 29 of these Rules the patent is to be entered in the Register of Patents as dated of the date on which the first foreign application was made.

Article V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

"L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des États de l'Union, n'entraînera pas la déchéance.

"Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés."

Article VI.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

"Toute marque de fabrique ou de commerce régulièrement déposé dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

(*s*) *Ante*, p. 528.

"Sera considéré comme pays d'origine le pays où le déposant son principal établissement. **Article VI.**

"Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

"*Le dépôt pourra être refusé, si l'objet pour lequel il est demandé* est considéré comme contraire à la morale ou à l'ordre public."

This article is modified by clause 4 of the final protocol (*post*, p. 595), which is as follows:—

"Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

"To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI."

"4. Le paragraphe 1er de l'Article VI. doit être entendu en ce sens qu'aucune marque de fabrique ou de commerce ne pourra être exclue de la protection dans l'un des États de l'Union par le fait seul qu'elle ne satisferait pas, au point de vue des signes qui la composent, aux conditions de la législation de cet État, pourvu qu'elle satisfasse, sur ce point, à la législation du pays d'origine et qu'elle ait été, dans ce dernier pays, l'objet d'un dépôt régulier. Sauf cette exception, qui ne concerne que la forme de la marque, et sous réserve des dispositions des autres Articles de la Convention, la législation intérieure de chacun des États recevra son application.

"Pour éviter toute fausse interprétation, il est entendu que l'usage des armoiries publiques et des décorations peut être considéré comme contraire à l'ordre public, dans le sens du paragraphe final de l'Article VI."

Notwithstanding this article, the provisions of sect. 103 of the Act of 1883 (*t*), must be complied with; and where a foreigner, subject of a State which had acceded to the Convention, did not apply for registration in England of his trade mark within four months of his applying to register in the foreign State, it was held under that section that registration must be refused (*u*).

(*t*) *Ante*, p. 492.

(*u*) *Re The Californian Fig Syrup Co.*, 6 R. P. C. 126. See also *Carter Medicine Co.'s Trade Mark*, [1892] 3 Ch. 472.

Article VII.

ARTICLE VII.

The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

"La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque."

ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

"Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce."

See *ante*, p. 393 and notes under s. 77 of the Act of 1883, *ante*, p. 441.

ARTICLE IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

"Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des États de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

"La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque État."

ARTICLE X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

"Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

"Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance."

Article XI.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognized International Exhibitions.

"Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions Internationales officielles ou officiellement reconnues."

See *ante*, pp. 341 and 363.

Article XII.

Each of the High Contracting Parties agrees to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

Article XIII.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the governments of all the contracting States, shall be placed under the high authority of the Central Admistration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

By the final protocol (*post.* p. 595), a periodical paper in the French language "dealing with questions regarding the objects of the Union" is to be published. This paper is "La Propriété Industrielle," published at the Bureau International de la Propriété Industrielle, Berne, Switzerland.

Article XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

Article XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial

Article XV. Property, in so far as such arrangements do not contravene the provisions of the present Convention.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

ARTICLE XIX.

The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

[*Here follow the signatures of the Plenipotentiaries.*]

II.

Final Protocol. (Translation.)

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador,

Servia, and Switzerland, for the protection of Industrial Property, the undersigned Plenipotentiaries have agreed as follows :— Final Protocol.

1. The words "Industrial Property" are to be understood in their broadest sense; they are not to apply simply to industrial products, properly so called, but also to agricultural products (wines, corn, fruits, cattle, etc.), and to mineral products employed in commerce (mineral waters, etc.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, etc.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the Tribunals, and the competence of those Tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organization of the special Department for Industrial Property mentioned in Article XII., shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. [*Here follow provisions as to the expenses of the International Office instituted under Article XIII.* (*ante*, p. 593), *and other provisions for the working of the Convention.*]

The official language of the International Office will be French.

7. The present Final Protocol, which shall be ratified together with the Convention concluded this day shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof the undersigned Plenipotentiaries have draw up the present protocol.

[*Here follow the signatures.*]

APPENDIX.

(*See* **TABLE OF CONTENTS.**)

ORDERS.

CONSOLIDATION OF SEVERAL ACTIONS BY SAME PLAINTIFF ON SAME PATENT AGAINST DIFFERENT CLASSES OF INFRINGERS. ORDER FOR INJUNCTION MEANWHILE. *Bovill* v. *Ainscough* (and other actions). Wood, V.-C. A. 1867, fo. 224i.

Upon motion this day made unto this Court by counsel for the defendants in all the above-mentioned causes, and upon hearing counsel for the plaintiff: This Court doth order that the several defendants in all the above-mentioned causes do, on or before the day of , deliver to the solicitors for the plaintiff a written statement of the names of such of the said defendants, and of their respective mills, and the number of pairs of stones at the said mills respectively, in respect of which the defendants mentioned in such statement admit that the mode of working, as regards the alleged infringement of the plaintiff's patent of 1849 in the bills mentioned, is the same as that adopted by A. C. , the defendant in the cause of *Bovill* v. *C.* , and that the defendants in such respective causes do enter into such admissions accordingly. And it is ordered that such of the defendants as shall not admit that their mode of working is the same as that adopted by the said A. C. , do severally, within the time aforesaid, make an affidavit or affidavits disclosing their mode of working in all particulars respecting which they severally have, or but for this order might have, been interrogated by the plaintiff as to the infringement of his patent; and that the plaintiff be at liberty at all seasonable times, upon giving reasonable notice, to inspect the machinery and mode of working of the several above-mentioned defendants' machinery. And it is ordered that the plaintiff do, within three weeks from the day on which the last of such admissions or of such affidavits respectively shall have been made, select one cause, representing each

Orders.

different class of infringement, in which he will proceed to decree, and give notice in writing thereof to the defendants' solicitors; and if the plaintiff shall select more than one cause in which he will proceed to decree, he is to give notice in writing to the defendants' solicitors in which of the said causes he will try the validity of the said patent; and the defendants by their counsel submitting to be bound in all respects by the ultimate decision of this Court in such selected cause or causes, subject only to appeal in such selected cause or causes, both as regards the validity of the plaintiff's patent and as regards the infringment thereof, so far as the infringement established in such selected cause or causes coincides with the admissions and affidavits to be entered into and made as hereinbefore directed, and the plaintiff by his counsel undertaking to abide by any order this Court may make as to damages in case the Court shall hereafter be of opinion that the defendants or any of them shall have sustained any by reason of this order which the plaintiff ought to pay, and also undertaking to accept short notice of motion to discharge this order, this Court doth order that the several above-named defendants, their respective servants, agents, and workmen, be restrained until the hearing of the said cause or causes so to be selected from in any manner exercising or putting in practice, or continuing to use, exercise, or put in practice, at their respective mills in the several above-mentioned bills respectively described or elsewhere, the inventions and improvements for which the letters patent of 1849 and 1863 in the said bills respectively mentioned were granted, or any material part thereof, or any means, apparatus, or arrangement merely colourably differing therefrom. And it is ordered that all further proceedings in these causes, except for the purpose of carrying out this order, and except in regard to such selected cause or causes as aforesaid, be stayed until the hearing of such selected cause or causes, or until further order, with liberty to the plaintiff and any of the defendants to apply before the hearing of such selected cause or causes, and generally as they may be advised. And any of the defendants, in any suits commenced by the plaintiff against the members of the Manchester Association of Millers in the said bills mentioned in respect of infringement of the said patent, are to be at liberty to apply to be made parties to this order.

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CONSOLIDATION OF SEVERAL ACTIONS ON SAME PATENT AGAINST DIFFERENT PERSONS INFRINGING IN SAME MANNER—OWNER OF PATENT BEING PLAINTIFF IN ALL THE ACTIONS, AND JOINED IN SOME OF THE ACTIONS WITH A DIFFERENT CO-PLAINTIFF. PROVISION IN CASE DEFENDANT IN ONE ACTION SUBMITS BEFORE TRIAL. *Plimpton* v. *Spiller*. 1876, P. 69. Jessel, M.R., at Chambers. B. 1876, fo. 1495 (five actions).

Between J. L. P. (*w*), Plaintiff,
A. F. S. and T. C., Defendants.
And between the L. and S. Skating Rink Co., and J. L. P. } Plaintiffs,
and
E. B. C., Defendant,
and three other actions.

Upon the application of the defendants in the above-mentioned actions other than the said action of *P.* v. *The H. R. B., etc. Co.*, and upon the application of the defendants in the last-mentioned action, and upon hearing the solicitors for the respective applicants and for the plaintiffs in the said several actions, and the respective applicants by their solicitors admitting that they have, for their own profit and without the licence of any of the above-named plaintiffs, made or sold, or let for hire, or used skates being the same as the skates the manufacture, sale, or user of which is complained of in the first above-mentioned action: It is ordered that all proceedings in the four lastly above-mentioned actions be stayed, except for the purpose of enforcing the injunctions which have been already granted in the same actions, and of enforcing this order until judgment be obtained in the first above-mentioned action, the defendants in the several other actions hereby undertaking to be bound and concluded by the judgment after trial (subject to appeal) of the first above-mentioned action, both as regards the validity of the letters patent of A B mentioned in the several statements of claim delivered in the four firstly above-mentioned actions, and as regards the infringement thereof, so far as such infringement may consist in making, selling, using, or letting for hire the skates complained of in the first above-mentioned action, and in case the defendants in the first above-mentioned action shall submit to judgment in favour of the plaintiff without proceeding to trial, the defendant or defendants in the other actions shall be at liberty to set up the same defence as (but except by leave of a judge no other defence than) that set up by the defendants in the said first-

(*w*) J. L. P. was the patentee.

mentioned action, and shall deliver the statement of such defence within seven days after notice by the plaintiff or plaintiffs requiring him or them to deliver such statement of defence, and the defendants to the remaining actions are to be in like manner bound and concluded by the judgment (subject to appeal) which may be obtained in the action in which proceedings may be resumed, and so from time to time. And it is ordered that the costs of this order be costs in the first above-mentioned action. Orders.

CONSOLIDATION OF SEVERAL ACTIONS BY SAME PLAINTIFFS ON SAME PATENT AGAINST DIFFERENT PERSONS INFRINGING IN SAME MANNER. PROVISION IN CASE DEFENDANT IN ONE ACTION SUBMITS BEFORE TRIAL. *Johnasson* v. *Palgrave.* 1880, J., 1079, 1166, 1167.—Jessel, M.R., at Chambers. A. 1880, fo. 2619 (three actions).

Upon the application of the defendants in all the above-mentioned actions, and upon hearing counsel for the applicants and for the plaintiffs in the said actions, and the applicants by their counsel admitting that they have, for their own profit and without the licence of any of the above-named plaintiffs, made or used machines similar to that inspected by the plaintiffs on board the ship M., and complained of in the statement of claim in the first-mentioned action: It is ordered that all proceedings in the second and third mentioned actions be stayed, except for the purpose of enforcing this order, until judgment be obtained in the first-mentioned action, the defendants in the said second and third-mentioned actions by their counsel undertaking to be bound and concluded by the judgment after trial (subject to appeal) of the said first-mentioned action, both as regards the validity of the letters patent of A. B. and C. D., mentioned in the statement of claim in the first-mentioned action, and in the several writs of summons in the second and third-mentioned actions, and as regards the infringement thereof, so far as such infringement may consist in making or using the said machines complained of in the said statement of claim, and in case the defendants in the said first-mentioned action shall submit to judgment in favour of the plaintiffs without proceeding to trial, the defendants in the other actions are not to be at liberty to set up any defence thereto respectively without the leave of the Judge, and the costs of this application are to be costs in the said first-mentioned action.

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ORDER REFERRING QUESTIONS AND ISSUES OF FACT TO OFFICIAL REFEREE UNDER JUDICATURE ACT, 1873, SECTION 57. *Saxby* v. *Gloucester Wagon Co.* December 15, 1879.

HIGH COURT OF JUSTICE, EXCHEQUER DIVISION.

(Middlesex to wit.)

At a sitting held at Westminster on Wednesday, the day of November, before the Honourable Sir Henry Hawkins:

It is ordered that this being an action requiring a prolonged scientific investigation, which cannot, in the opinion of the Judge, conveniently be made before a jury or conducted by the Court through its other ordinary officers, that the questions and issues of fact and of account (if any) arising herein be tried before one of the official referees, who shall inquire and report upon such questions and issues. It is further ordered that if the parties agree upon a special referee, instead of an official referee, such special referee be substituted for an official referee.

ORDER FOR FURTHER PARTICULARS OF OBJECTIONS. *The London and Leicester Hosiery Co. Limited* v. *Higham.* Queen's Bench Division. 1882, L. No. 2680. July 3, 1883, T. 83/7.

Upon reading the order of the Honourable Mr. Baron Huddleston, dated June 25th, 1883, and upon hearing counsel, etc., on defendant's notice of motion, dated, etc., that the order of the Honourable Mr. Baron Huddleston, made herein on June 25th, 1883, whereby it is ordered that the defendant do, within seven days, deliver further and better particulars of objections in this action, by stating what portions of the specifications in the particulars already delivered referred to are alleged to anticipate the plaintiffs' inventions, with a reference to pages and lines of such specifications, and also what portions of the plaintiffs' inventions are alleged to have been published or used prior to the dates of the several letters patent therefor with reference to the claiming clauses of the specifications of such letters patent, and that the plaintiffs should have fourteen days' time to reply after delivery of such particulars, may be rescinded, and that the plaintiffs may be ordered to pay to the defendant his costs of and incident to the said order, and also his costs of and incident to this application: It is ordered that the defendant's application herein be dismissed, with costs, to be taxed by one of the masters, and paid by the said defendant to the said plaintiffs or their solicitor (*x*).

(*x*) See also a like form of order under the present practice: *Harris* v. *Rothwell*, Griffin P. C. 110.

ORDER FOR INSPECTION OF MACHINERY AND APPLIANCES ALLEGED TO BE TRADE SECRETS. *Hill* v. *Tombs.* 1880, H. 105. Jessel, M.R. November 26, 1880.

Upon motion, etc.: This Court doth order that the plaintiff and two of his scientific witnesses be at liberty, upon giving three days' notice, to inspect (but only one inspection of *each machine*) all the machinery and appliances, except as to those parts of such machinery and those appliances alleged by the defendants to be trade secrets, used by the defendants in the manufacturing pleats, frills, ruchings, and fancy trimmings, and to see the products manufactured by the machinery and appliances, and to take specimens of the manufactured products generally produced, and as to those parts of such machinery and those appliances alleged to be trade secrets, it is ordered that the same be inspected by A. B., of, etc., and the said A. B. is, within seven days from the completion of such inspection, to report to the Court, firstly, whether, in his opinion, such machinery or appliances, or any of them, are trade secrets; secondly, whether, in his opinion, they or any of them infringe (*y*) the plaintiff's patents: and it is ordered that the defendants do pay to the plaintiff his costs of this application, such costs to be taxed by the taxing master, and that the plaintiff's costs of the former inspection be plaintiff's costs as against the defendants in any event.

ORDER FOR INSPECTION OF DEFENDANT'S PROCESS ALLEGED TO BE TRADE SECRET. *The Plating Co.* v. *Farquharson.* 1879, P. 264. Jessel, M.R. B. 1880, fo. 460.

Upon motion, etc.: This Court doth order that A. B. be appointed analyst for the purposes hereinafter mentioned, and be allowed access to the works of the defendants, situate at, etc., at all reasonable times upon giving the defendants two days' previous notice, to see the defendants' method of making their solutions and materials used, and also to see the defendants' method of using their solutions in the process of nickel plating, as ordinarily used by them, and also to be allowed to take samples of the solutions, and thereupon to report to the Court upon the facts, and his opinions founded upon them, but the said A. B. is not to disclose his report on the facts or opinion obtained or arrived at by him without the leave of this Court or the Judge: and the costs of the plaintiff's application by motion on the of , and of this motion, are to be costs in the action.

(*y*) These words have not been inserted in later orders. See the following order in *The Plating Co.* v. *Farquharson.*

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JUDGMENT FOR INJUNCTION TO RESTRAIN INFRINGEMENT OF PATENT, AND FOR REFERENCE TO ASSESS AND DIRECTION TO PAY DAMAGES. *Otto* v. *Linford*. 1880, O. 207. Court of Appeal, January 27, 1882. 46 L. T. (N.S.) 35.

(After reversing Judgment of the Court below, which dismissed the action with costs)

It is ordered and adjudged that the defendant C. L., his servants, agents, and workmen, be restrained during the continuance of the letters patent granted to A. B., dated, etc., in the statement of claim mentioned, from using or exercising, or causing or permitting to be used or exercised, the invention described in the specification and drawings of the said A. B., and from selling or making any profitable use, or permitting the sale or profitable use, of any gas motor engines not made by the plaintiff or his licensees, and arranged or constructed in manner described in the said specification and drawings, or differing therefrom only colourably and by the substitution of mere mechanical equivalents. And it is ordered that it be referred to X. Y., as special referee, to inquire and report what sum of money is fit to be awarded to the plaintiff in respect of any damage sustained by the plaintiff from the sale or use by the defendant of the said invention, or any apparatus in imitation of or being only a colourable deviation from the said invention; and it is ordered that the defendant C. L. do, within seven days after the adoption by the Judge of said special referee's report, pay to the plaintiff the sum so awarded. And (after directing defendant to pay costs of action and of appeal, and to refund costs paid by the plaintiff under the judgment of the Court below) the plaintiff is to be at liberty to apply to the Vice-Chancellor for a certificate that the validity of his patent came in question in this action, and that the plaintiff proved the breaches alleged in the particulars of breaches in this action. Liberty to either party to apply.

APPORTIONMENT OF COSTS. *Simmonds* v. *Hitchman*. 1879, S. 453. Bacon, V.-C. February 4, 1881.

This action coming on for trial, etc., in the presence of counsel, etc., and upon hearing, etc.: This Court doth order and adjudge that this action and the counterclaim of the defendants respectively do stand dismissed out of this Court.

And it is ordered that it be referred to the taxing master to tax the costs of the plaintiff of this action, so far as they have been occasioned by the issues raised by the defendants impeaching the validity of the plaintiff's patent, and the costs of the plaintiff occasioned by the counterclaim of the defendants,

and also the costs of the defendants of this action, so far as they have been occasioned by the issue raised by the plaintiff as to the infringement of the said patent by the defendants. And the taxing master is to set off such costs of the plaintiff and of the defendants when so taxed, and certify to whom after such set-off, the balance is due. Orders.

And it is ordered that the party from whom such balance shall be certified to be due do pay the amount thereof to the other party.

ORDER OF THE MASTER OF THE ROLLS TO AMEND A CLERICAL ERROR IN A SPECIFICATION. *Johnson's Patent*, 5 Ch. D. 503.

Upon the petition of the above-named, on the day of preferred unto the Right Honourable the Master of the Rolls, having the consent of Her Majesty's Attorney-General written on the said petition, and upon hearing counsel for the petitioner, and upon reading the said petition, the letters patent referred to in the title of this petition, a Queen's printers' copy of the specification filed in the Great Seal Patent Office pursuant to the said patent, an affidavit of the petitioners and the exhibits and therein referred to, an affidavit of and the exhibit therein referred to, his Lordship doth order that the proper officer of the Great Seal Patent Office do amend the said specification by inserting in the said specification, after the words occurring in line , page , of *the Queen's printers' copy of the said specification*, the words .

And notice of this Order is to be given to the Commissioners of Patents, in order that the said specification may be reprinted.

ORDER OF BOARD OF TRADE ON REFERENCE TO THE COURT, UNDER SECTION 62 (5), OF APPEAL FROM COMPTROLLER'S REFUSAL, UNDER SECTION 72 (2), TO REGISTER MARK BY REASON OF EXISTENCE OF IDENTICAL MARKS ON THE REGISTER. *H. J. Neill's Trade Mark* (No. 1), September, 1893.

For the purposes of the within reference the Board have, pursuant to rule 23 of the Trade Marks Rules, 1890, directed the appellants to make application by motion, summons, or otherwise, as they may be advised, to the Chancery Division of the High Court of Justice to hear and determine the said appeal, and that notice of such application be served upon the Comptroller-General of Patents, Designs, and Trade Marks, and upon of in the county of (trading as) and , and that upon the hearing and determination

Orders.

of the said appeal, the appellants, the comptroller, and , be respectively at liberty to adduce such evidence as they respectively may be advised.

CONSENT ORDER FOR THE COMPTROLLER TO PROCEED WITH REGISTRATION OF OLD MARK WITH NOTE DISCLAIMING EXCLUSIVE USE OF PARTICULAR DEVICES IN USE BY OTHER PERSONS. *Re application of H. J. Neill, Limited.* (No. 2.) North, J. March 9th, 1894. A, 427.

Upon motion this day made unto this Court by counsel for the above-named applicants, H. J. N. Limited, and upon hearing counsel for the respondents, the Comptroller-General of Patents, Designs, and Trade Marks, and for J. T., and upon reading an affidavit of filed the day of 18 (*inter alia*) of service of notice of the said motion personally on the respondents T. A. S. and J. D., and upon J. P. B., in Inverness, Scotland, by sending him copy of the notice of motion in a registered letter, an affidavit of filed the day of 18 of service of notice of the said motion on the respondent A. C. P., and the exhibit therein referred to, the following evidence filed on behalf of the applicants, viz., affidavits of, etc., and the following evidence filed on behalf of the respondent J. T., viz., an affidavit, etc.

And the applicants, H. J. N., Limited, by their counsel, undertaking to apply to the comptroller to amend their application so as to claim registration of mark No. as an old mark, and to submit to the registration thereof with a note to the effect that they make no claim to the exclusive use of the device of the crest consisting of or of the harp because these are in use by other persons, and undertaking not to make any application to rectify the register in respect of the respondent J. T.'s mark No. or to oppose the registration of the said J. T.'s old marks containing the crest, if application be made to register the same as old marks with a similar note to that above mentioned so far as the device of a crest is concerned, And the respondent, J. T., by his counsel, undertaking not to oppose the applicant's mark as an old mark, with a similar note to that above mentioned: This Court doth by consent order that the Comptroller-General of Patents, Designs, and Trade Marks, do forthwith proceed with the registration of the trade mark mentioned in the above-mentioned application, No. notwithstanding the existing registration of the trade marks numbered respectively and *(four trade marks)*.

And it is ordered that the applicants, H. J. N., Limited, do pay to the said comptroller his costs of this application, and to the respondent, J. T., his costs of appearing in Court this day, including the evidence filed in respect of the said application, *such costs to be taxed by the taxing master.* **Orders.**

The following is an extract from the "INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS," issued by the Patent Office, May, 1897:—

RESTRICTIONS ON REGISTRATION (*z*).

28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a Mark unless such groundwork be included within the Mark by some border or lines.

29. The words "Registered," "Registered Design," "Copyright," "Entered at Stationer's Hall," "To counterfeit this is Forgery," will not be registered under the Acts, and should not, therefore, appear upon the Representations of Trade Marks forming part of an application.

30. The following will not be registered as Trade Marks, or as *prominent parts of Trade Marks*, unless the Marks have been used since before August 13th, 1875:—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of Her Majesty the Queen, or of any member of the Royal Family.

Representations of the Royal Crown (*a*).

The National Arms or Flags of Great Britain.

31. When there appears on the face of a Trade Mark an indication of the goods to which the Mark is applied, the claim for its registration must be in respect of *those goods only.*

(*z*) Whether these instructions are or are not absolutely binding, the court will be very slow to depart from the practice established by them. *König and Ebhardt's Trade Mark.* 13 R. P. C. 449.

(*a*) The crown which appears upon the Royal Arms. The instructions do not extend to crowns and coronets of all shapes and forms. *König and Ebhardt's Trade Mark, ubi supra.*

FORMS.

Declaration by Applicant for Registration of an old mark as to time and mode of user.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

In the matter of A. B. & Co.'s application for registration of a Trade Mark, No. in Class 43 in respect of whisky.

I, A. B., of the firm of A. B. & Co., do hereby solemnly and sincerely declare as follows:

The mark on the exhibit marked "A," shown to me at the time of making this declaration and exactly as shown upon the application forms, has been used within the United Kingdom of Great Britain and Ireland by my firm and their predecessors in business absolutely by itself as a Trade Mark in respect of whisky continuously since about 23 years before August 13th, 1875, and I declare that save the said mark there did not appear upon the bottles containing the whisky any device, words, figures, letters or any other particulars whatsoever.

And I make this solemn declaration, etc., etc.

Form of Counter-Statement.

(From the "Instructions" issued by the Patent office.)

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Trade Marks.

In the Matter of an Application No.
and of the Opposition thereto No.

In reply to the Notice of Opposition in this matter by of , I give notice by way of Counter-statement that I rely for my application on the following grounds:—

(To be dated and signed by the *Applicant* or his *Solicitor*.)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London.

Reasons for Proposed Amendments of Specification.

(See Act of 1883, section 18 (1), *ante*, p. 67.)

That there are doubts whether the Letters Patents are not at present invalid in consequence of a prior publication of that portion of the specification which is covered by the first claiming clauses which I therefore desire to disclaim.

That the portion of the specification beginning line p. and ending line , p. is unnecessary and I desire to excise the same from the specification.

That the claim might be held to be too general and to claim more than is described in the specification, and I am therefore desirous of limiting it so as to make it claim only what is described in the specification. **Forms.**

That it might be supposed that the specification and claim are not sufficiently precise and may be extended to claim beyond what I desire, I desire to make the specification more clear and precise.

To define more clearly the scope of the invention and to remove ambiguity in the specification (*b*).

That there are doubts whether the claim of the specification can be supported, and I am therefore desirous of disclaiming it.

That there are clerical errors in the specification which I am desirous of correcting.

That the other alterations are rendered necessary or convenient by the proposed amendments.

That the title should be amended in accordance with the proposed amendments in the specification.

Objections to Amendment of Specification.

(See P. R., r. 53.)

That the proposed amendment will make the specification as amended claim an invention substantially larger than [and substantially different from] the invention claimed by the specifiation as it now stands. (See *ante*, p. 80.)

That the proposed amended claim is an extension of the original claim, in that it embraces the subject of the whole specification which the original claim did not.

That the object of the proposed amendment is to make a subordinate and accessory claim into the main subject of the patent, and thereby to alter the nature of the grant and extend its operation.

That the proposed amended claim is indefinite and unintelligible, and that it would prevent the public from ascertaining exactly what the alleged novelty of invention is. (See *ante*, p. 73).

That the specification as proposed to be amended would not disclose any fit subject matter for letters patent.

That if the specification be amended as proposed the letters patent will be invalid on account of want of novelty of the invention and otherwise.

That the alleged invention as described and claimed in the specification as proposed to be amended is not the same as the invention described in the provisional specification (*c*).

That in the specification as proposed to be amended, the claims would not be for any invention the nature of, and the mode of carrying which into effect, are sufficiently ascertained and described in the specification.

That the parties applying for leave to amend are not the persons entitled so to do.

That the proposed amendment is not a correction or explanation within the meaning of section 18 of the Patents, Designs, and Trade Marks Act, 1883. (See *ante*, pp. 71, 72.)

That the opponents are makers of and that it would be unjust to allow the amendment proposed so as to affect their rights and interests, and if leave to amend be given at all, it should be upon such terms as will sufficiently protect the rights and interests of the opponents (*d*).

(*b*) See *Johnson's Patent*, 13 R. P. C. 659, 662, *ante*, p. 71.

(*c*) See *Gaulard and Gibbs' Patent*, 6 R. P. C. 215; 7 R. P. C. 367; and *ante*, p. 83.

(*d*) *Ainsworth's Patent*, 13 R. P. C. 76. See *ante*, p. 79.

Forms.

Particulars of Breaches in Patent Action.

In the High Court of Justice.
(Chancery Division.)
Mr. Justice .
[*or* Queen's Bench Division.]
Between A. B. - - - - - - - - *Plaintiff*;
and
C. D. - - - - - - - - *Defendant.*

Particulars of Breaches

Delivered with the Statement of Claim the day of by Messrs. of solicitors for the Plaintiff.

The following are particulars of the breaches complained of by the Plaintiff in this action that is to say:

That the Defendant has at divers times previously to the commencemen of this action [and subsequently thereto] infringed the letters patent granted to the Plaintiff as in the Statement of Claim mentioned and dated the day of and numbered by using or applying in or to certain mechanism being the same as the mechanism described in the Queen's printers' copy of the specification filed under the said letters patent and claimed by the and claims thereof and by manufacturing or selling for his own profit having therein the mechanism aforesaid.

The Plaintiff complains of certain sold by the Defendant to one E. F. of on the day of .

The precise numbers dates and amounts of the Defendant's infringements are not at present known to the Plaintiff but the Plaintiff will claim to recover from the Defendant full compensation in respect of all such infringements.

For form of particulars of breaches in a chemical case see *Casella* v. *Levinstein*, 8 R. P. C. 473, *ante*, p. 163.

Particulars of Objections in Patent Action.

In the High Court of Justice.
(Chancery Division.)
Mr. Justice .
[*or* Queen's Bench Division.]
Between A. B. - - - - - - - - *Plaintiff*;
and
C. D. - - - - - - - - *Defendant.*

Particulars of Objections

Delivered with the Defence, the day of by Messrs. of solicitors for the Defendant.

The Defendant relies in support of his defence to this action on the following objections to the validity of the said letters patent:—

Patentee not inventor.

I. That the Plaintiff was not the true and first inventor of the alleged invention comprised in the said letters patent (*e*).

(*e*) This objection ought not to be taken unless the defendant is prepared to prove that whether the invention be a proper subject-matter of a patent or not the plaintiff did not discover it. *Thomson* v. *Macdonald*, 8 R. P. C. 5; *Morgan* v. *Windover* (2) 7 R. P. C. 446, 449.

2. That the said alleged invention is the mere application to means previously well-known for and is not the proper subject-matter of letters patent; *or* Forms. —— No subject-matter.

That having regard to the knowledge [of] existing at the date of the said Letters Patent, the alleged invention was not proper subject-matter of letters patent.

3. That the said alleged invention is not useful. No utility.

4 (*f*). That the alleged invention described and claimed in the complete specification alleged to have been filed in respect of the said letters patent is not the same as the alleged invention described in the provisional specification left on the application for the said letters patent, and differs therefrom in the following particulars, that is to say:— Disconformity of provisional and complete specifications.

(*State points of difference.*)

5. That the said complete specification does not sufficiently describe and ascertain the nature of the said alleged invention, and in what manner the same is to be performed, inasmuch as— Specification insufficient.

(*State reasons.*)

6. That the last-mentioned complete specification is ambiguous and misleading inasmuch as—

(*State reasons.*)

(*Add other objections to the specification.*)

[The old form of objection to the specification was as follows (*g*):

That the specification alleged to have been filed by the plaintiff under the said letters patent does not sufficiently describe and ascertain the alleged invention, and in what manner the same is to be performed, and does not sufficiently distinguish which of the matters and things therein described the last-named plaintiff claims to have invented, and which of the same he does not claim to have invented and admits to be old. And that in other respects the said specification is insufficient, ambiguous, and framed so as to mislead.]

(*State here other objections.*)

7. (*Where the specification has been amended, and the provisions of the Act of* 1883, *s.* 18 (8), *have not been complied with.*) That the specification as amended, claims an invention substantially larger than, or [and] substantially different from, the alleged invention claimed by the specification as it stood before amendment (*h*). Amended specification bad within sect. 18 (8).

8. That the said alleged invention was not new at the date of the said letters patent, having been previously published in the specifications hereinafter mentioned (*or* in the manner hereinafter appearing). Invention not new.

9. That the said alleged invention was previously to the date of the said letters patent published within this realm in the following specifications respectively filed in the Patent Office as hereinafter mentioned, and in the following printed books (reference in the case of the same specifications Prior specifications and books.

(*f*) This and the two following objections are framed so as to comply with the rules laid down in *Anglo-American Brush, etc. Corporation* v. *Crompton*, 34 Ch. D. 152; and *Crompton* v. *Anglo-American Brush, etc. Corporation*, 35 Ch. D. 283, *ante*, p. 175.

(*g*) This form is printed here as showing the several objections which may be raised on the specification.

(*h*) See, however, *Moser* v. *Marsden*, 13 R. P. C. 24, 31, 32, 33; cited *ante*, p. 85.

Forms.

being made to the Queen's printers' copies thereof, and to the drawings therein referred to), that is to say:

The specification of G. H. filed under letters patent dated , No. , page , lines , and .

Page , lines , are relied on as anticipating the claiming clause of the plaintiff's specification (*i*); *or*

The parts of figure which show and the parts of the complete specification which describe the construction and arrangement of the said parts of figure are relied on; *or*

The shown in figure and the parts of the specification which describe the construction and operation thereof are relied on.

The specification of I. K., No. of A.D. 18 .

The whole specification is relied on as anticipating the and claiming clauses of the plaintiff's specification; *or*

The parts of the specification relied on are those parts which refer to the A. shown in figures 1, 2, etc., of the drawings.

(*Add other specifications.*)

(*Title of book*) , page , lines , relied on as anticipating the claiming clause of the plaintiff's specification.

(*Add other books.*)

[When there are several specifications and books, it is often convenient to arrange them in a schedule thus:—

Name.	Date and Number.	Pages and Lines relied on.	Claiming Clause alleged to be anticipated (*j*).

Prior publication by drawings publicly made and explained.

10. That the said alleged invention and the several parts thereof were, prior to the date of the said alleged letters patent, further published within this realm as follows: A. B., of , in the county of , the defendant's Superintendent, did, in the offices of the Railway Company at , in the year , publicly in the presence of C. D. of in the county of , E. F. of , in the county of , and G. H, of , in the county of , and of other clerks of the said company, disclose and publish the said alleged invention by causing under his direction drawings of the same to be made by the said C. D., and traced by the said E. F., and by exhibiting and explaining verbally the said drawings to the said G. H. and the other clerks before mentioned.

(*Add other alleged instances of prior publication.*)

Prior user.

11. That the said alleged invention was previously to the date of the said letters patent published within this realm by the manufacture and

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(*i*) In this form the objection complies with the order in *The London and Leicester Hosiery Co.* v. *Higham* (*ante*, pp. 600, and 172). Where several specifications are relied on they must be stated in such a manner as not to be oppressive, and publications showing mere general knowledge need not, and should not, be included. See *Holliday* v. *Heppenstall*, 41 Ch. D. 109, *ante*, p. 174.

(*j*) See preceding note.

sale [*or* use *or* public exhibition] by the persons or firms following, at their places of business hereinafter mentioned, in the years hereinafter set forth, of made according to the alleged invention, [*or* of machinery or apparatus for making , being the same or substantially the same as the machinery or apparatus described and claimed in the plaintiff's specification (*k*)], that is to say: Forms.

By I. K. of , at , in the county of , in the year .

(*Add other prior users*) (*l*).

[For Forms of Statement of Claim and Statement of Defence in patent actions, see Supreme Court Rules, 1883, Appendix C., section VI., Form No. 6, and Appendix D. section VI.]

Petition for Revocation of Patent where the authority of the Attorney-General is required.—See *ante*, pp. 122, 127.

In the High Court of Justice,
(Chancery Division).
Mr. Justice .

In the Matter of the Patents, Designs and Trade Marks Acts, 1883—1888,

and

In the Matter of Letters Patent, No. , of the year , granted to A. B. of , for an invention of dated the day of .

To Her Majesty's High Court of Justice.

The humble petition of ,

SHEWETH *as follows:*

(*State grant of patent and the circumstances justifying the presentation of the petition.*)

The said letters patent are invalid on the grounds stated in the particulars of objections delivered herewith.

Your petitioner has been authorized by the Attorney-General to present this petition—

Your petitioner therefore humbly prays that the said letters patent, No. , of the year , may be revoked. And that the said A. B. may be ordered to pay the costs of this petition.

And your petitioner will ever pray, etc.

Particulars of objections are delivered herewith.

It is intended to serve this petition on A. B.

Proceedings to obtain the fiat of the Attorney-General.—In applications to the Attorney-General for the grant of his fiat to petitions for the revocation of letters patent under section 26 of the Act of 1883 (*ante*, p. 122), the petitioner is required to present a memorial to the Attorney-General, setting out therein the material facts relied on. The memorial

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(*k*) The machinery should be identified. See *Boyd* v. *Farrar*, 5 R. P. C. 33, 35; *Law* v. *Ashworth*, 7 R. P. C. 86.

(*l*) If the patentees under the prior specifications are relied on as prior users in respect of their use of their own inventions, they should be mentioned here.

Forms.

should be signed by the petitioner, or in the case of a corporation sealed with the corporate seal.

The memorial should be accompanied by—

(a.) A statutory declaration verifying the allegations in the memorial, and containing a statement that no legal proceedings are pending in the United Kingdom whereby the questions proposed to be raised by the petition and particulars of objection, upon which the revocation of the letters patent is sought, can be raised.

(b.) Two copies of the proposed petition.

(c.) Two copies of the particulars of objections.

(d.) Certificate of counsel that the proposed petition is proper for the allowance of Her Majesty's Attorney-General.

(e.) Certificate of the solicitor that the proposed petitioner is a proper person (or body) to present a petition to the court for the purpose of revoking the letters patent in question, and that the petitioner is competent to answer the costs of all proceedings in connection with the petition.

(f.) Prints of specifications and copies of documents referred to in the memorial, petition, and particulars of objections.

The above documents must be lodged at the Law Officers Department, No. 549, Royal Courts of Justice. Certain fees are payable in connection with the application.

The fact that proceedings are pending in which the issues of fact or law raised by the petition for revocation can be determined is not an absolute bar to the granting of the fiat, but it is only under very special circumstances that the Attorney-General will grant his fiat for the presentation of a petition for revocation where proceedings in which the validity of the letters patent is in question are pending (*m*).

Clauses in Petition for Revocation where the authority of the Attorney-General is not required.

See section 26 (4) (c), (d), (e), *ante*, pp. 122, 129, 130.

1. Your petitioners' are and their said firm are the successors in business of your petitioner C. D., who carried on for many years prior to the date of the above-mentioned letters patent the trade or business now carried on by your petitioners' said firm. Your petitioner, C. D., prior to the date of the said letters patent, manufactured and sold and other vessels intended to be subjected to heat.

2. In such and vessels your petitioner, C. D., for the purpose of increasing, etc., etc., adopted and used within this realm, and before the date of the said letters patent, certain well-known expedients, that is to say, etc., etc.

3. The above-mentioned letters patent were granted to the above-named A. B. for an alleged invention for, etc., etc.

4. The alleged invention, as claimed in the complete specification filed by the said A. B. in respect of his application for the said letters patent, was, etc., etc.

5. The alleged invention is precisely the same contrivance for increasing, etc., etc., as was adopted by your petitioner C. D. as hereinbefore mentioned.

6. Under the circumstances aforesaid, your petitioner C. D. (under or through whom your petitioners claim their interest in the trade

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(*m*) See Griffin P. C. 320 and *ante*, pp. 128, 129.

or business now carried on by them as aforesaid) publicly manufactured, used, and sold within this realm before the date of the said letters patent, the contrivance or method claimed by the said A. B. as his invention. For the reason last aforesaid the said letters patent are invalid for want of novelty in the alleged invention comprised therein (*n*).

7. The said letters patent are also invalid on the further grounds stated in the particulars of objections delivered herewith.

Particulars of Objections on Petition for Revocation.

In the High Court of Justice,
(Chancery Division).
Mr. Justice .

(*Title of petition*).

Particulars of Objections.

At the hearing of the petition presented in the above matters by the petitioners will rely on the following objections.

(See *ante*, p. 608).

Petition for Extension of Term of Patent.

In the Privy Council.

Presented the day of .

To the Queen's Most Excellent Majesty in Council.

In the Matter of Letters Patent granted to A. B., of, etc., for the invention of (*title of invention*), dated the day of , .

No. .

The humble petition of X. Y., of, etc.,
and of the above-named A. B.

SHEWETH,

That your petitioner, the above-named A. B., previously to the grant of the letters patent hereinafter mentioned, invented after considerable personal application and cost certain improvements in, etc. (*title of invention*) (hereinafter called "the said invention"), which invention was, and is, of great utility, and greatly beneficial to the public.

That your Majesty was graciously pleased, by royal letters patent, under the Seal of the Patent Office, bearing date the day of , to grant unto your petitioner, A. B., his executors, administrators, and assigns, the sole privilege and authority to use the said invention within the United Kingdom of Great Britain and Ireland, and the Isle of Man, for the term of 14 years from the date of the said letters patent.

That your petitioner, A. B., in compliance with the provisions of the Patents, Designs, and Trade Marks Act, 1883, duly left at the Patent Office a specification particularly describing and ascertaining the nature of his said invention, and in what manner it was to be performed.

That your petitioner, A. B., also obtained letters patent or brevets

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(*n*) See s. 26 (4) (e), *ante*, p. 130.

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d'invention for his said invention in France, dated the day of

(Add other foreign patents with dates and numbers, and state whether they are in force or expired. Sometimes it is convenient to state these in a tabulated form as below)—

Country.	Number.	Date.	Name of Patentee.	Remarks.

That the said invention relates to improvements in the means of consuming smoke, and of effecting combustion in steam boilers, as also improvements in the means of supplying furnaces with fuel.

That your petitioner, A. B., is a civil engineer, and he has for more than 30 years past devoted his attention to smoke-consuming apparatus, and has given much time and labour, and expended very considerable sums of money in conducting experiments relating to the subject-matter of the said invention, and either alone or with his then partner, one , he obtained letters patent for apparatus relating thereto, all of which last-mentioned letters patent have expired or become void.

(Add statements showing by specifications and otherwise the state of knowledge existing at the date of the patent) (o).

(Add statements showing nature and advantages of the invention.)

(Add statements showing interest of co-petitioner.)

That your petitioner, A. B., has expended large sums of money and devoted great pains and labour in endeavouring to introduce the said invention to the public, and to bring the same into use.

(State what was done by petitioner.)

(If the petitioners are a company, state whether any, and if any, what dealings have taken place in the shares (p).)

That although under the circumstances aforesaid considerable numbers of fire doors made according to the said invention comprised in the said letters patent of the day of , were sold, yet the necessary expenses of introducing the said invention as aforesaid were so great, that it was only during the last year and nine months, or thereabouts, that is to say the years and , that any profit was made from the said invention. In all other years since the date of the said letters patent, the working of the said letters patent and the manufacture and sale of fire doors made according to the said invention resulted in losses which far more than counterbalanced the profit of the years and aforesaid, and, on the whole, your petitioner, A. B., instead of obtaining any profit from the said invention, has sustained a very considerable loss.

That only one licence has ever been granted for the use of the said invention

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(o) See *Livet's Patent*, 9 R. P. C. 327, 331, 332. It is incumbent on the petitioner that the whole history, everything bearing on the matter, should be stated on the face of the petition. See *Standfield's Patent*, 15 R. P. C. 17.

(p) See observations of Lord WATSON, *Barff's and Bower's Patent*, 12 R. P. C. 383, 385.

in the United Kingdom, that is to say, a licence to one C. D., of Manchester and Oldham, which was granted by your petitioner, A. B., in or about the month of , 18 .

(State whether any profit arose from licence.)
(Add circumstances, if any, showing difficulty of introducing invention to the public.)

That of late years the utility of the said invention has been generally acknowledged.

(Add other circumstances, if any, to show the invention is coming into use.)

That under the circumstances aforesaid, your petitioner, A. B., has, notwithstanding his considerable outlay upon the said invention, been unable to obtain any profit thereupon, nor has he obtained any remuneration for his expense and labour in perfecting the same; but on the contrary, he has sustained considerable loss in relation to the said invention, and it is only now, when the letters patent are about to expire, that the use of the said invention is becoming fully established and extending.

That your petitioners have no doubt that if the term of the said letters patent should be extended, the said letters patent will now become productive, and your petitioner, A. B., will be able to obtain a fair reimbursement and remuneration commensurate with the great public value and importance of the said invention.

That your petitioners humbly submit that under the circumstances of the case an exclusive right of using and vending the said invention for the further period of seven years will not sufficiently reimburse and remunerate your petitioner, A. B.

That your petitioners have given public notice by advertisements caused to be inserted the requisite number of times in the "London Gazette," and in metropolitan and country newspapers, pursuant to the rules in that case made and provided, that it is their intention to present a petition to your Majesty in Council that their said letters patent may be extended for a further term.

Your petitioners therefore humbly pray that your Majesty will be graciously pleased to take the case of your petitioners into your Royal consideration, and to refer the same to the Judicial Committee of your Majesty's Most Honourable Privy Council, and that your petitioners may be heard before such Committee by their counsel and witnesses, and that your petitioners' letters patent may be extended for the further and additional term of fourteen years, or for such other term as to your Majesty shall seem fit.

And your petitioners will ever pray, etc.

Paragraph in Petition for Extension presented by the Patentee and a Company formed for working the Patent.

That except as last aforesaid your petitioner E. D.'s said invention has, ever since the said patent was taken out, been worked by your petitioners, the company, and your petitioner E. D. owns more than half the shares in your petitioners the company, and has devoted to the working of the invention and introducing the same to the public a very considerable amount of his time. Since the year 18 he has been chairman of your petitioners the company. He has been referred to, ever since the invention was patented, by the manager of your petitioners the company on all questions of any importance in connection with his said invention. Your

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petitioner E. D. has received no compensation whatever for the time devoted by him to the said invention, no fees whatever having been paid to him as director of the said company or otherwise. Your petitioners the company and their directors and managers have done all in their power to push the said invention, and the sale of made according to your petitioner E. D.'s said invention has constituted nearly two-thirds of their whole business. The greater part of the capital of your petitioners the company has been employed for the purpose of developing the last-mentioned invention.

Caveat against Extension of Term of Patent.

In the Privy Council.

In the Matter of the Petition of .

Caveat against the extension of the term of the letters patent granted to and dated No. without notice to A. B. of in the city of London.

Dated this day of .

Solicitors for the above-named A. B.

Objections to Extension of Term of Patent.

In the Privy Council.

In the Matter of Letters Patent granted to A. B., of, etc., , for the invention of, etc., dated No.

and

In the Matter of the Petition of the company and A. B. (*the patentee*), for an extension of the term of the said letters patent.

Objections.

The grounds of the objections of of to the granting of the prayer of the said petition are as follows :—

That the part of the alleged invention claimed in the second claiming clause of the said letters patent (hereinafter referred to as the said alleged invention) was not new within this realm at the date of the above-mentioned letters patent, in proof whereof leave is craved to refer to the following documents published in England prior to the date of the said letters patent that is to say :—

Specification to X. Y.'s patent No. of A. D. .

Add other specifications and documents.

That having regard to the general public knowledge existing at the date of the said letters patent (whether derived from the said specifications or otherwise) the said alleged invention is not of sufficient public utility or merit to entitle the petitioners to any prolongation of the term or privileges granted by the said letters patent (*q*).

That the petitioner A. B. (*the patentee*) has now no interest in the said letters patent and has been adequately remunerated and rewarded for his alleged outlay, expense, and labour, respecting the said invention and letters patent (*r*).

(*q*) See *ante*, p. 103.

(*r*) See *Bower - Barff Patent*, [1895] A. C. 675, and *ante*, p. 113.

That the petitioners the company are merely assignees of the said letters patent and have been adequately remunerated and rewarded for all their alleged outlay, expense, and labour, respecting the said invention and letters patent.

That if the petitioners or their predecessors in title have failed to obtain a sufficient remuneration or reward, their failure has been caused by the mode in which their business has been carried on, and the negligence and default of the petitioners and their respective predecessors in title (*s*).

That until the year no endeavours were made by any of the owners for the time being of the said letters patent to introduce the said alleged invention to the public, or to find persons willing to take licences to use the said alleged invention.

That the licensees under the licences granted as in the petition mentioned have made considerable profits by reason of the said licences (*t*).

That the monies received in the United Kingdom of Great Britain and Ireland in respect of the said letters patent by the petitioners or their predecessors in title and their licensees, have been full and adequate remuneration for the said alleged invention (*u*).

That the petition does not give the dates or state sufficiently the particulars of the foreign patents and colonial patent mentioned in the petition, and that the petition does not state whether all or any of the said foreign patents and colonial patent are in force (*x*).

That these opponents are informed that certain of the said foreign patents or brevets d'invention have expired, and these opponents submit that any prolongation of the said letters patent would be improper on the ground of public policy (*y*).

That it does not appear on the petition whether the petitioners the company are the owners of or in any way interested in the said foreign patents or colonial patent (*z*).

That it does not appear on the petition whether the petitioner A. B. (*the patentee*), or the petitioners the company, or their predecessors in title have derived any profits from the said foreign patents and colonial patent, and that in fact the said A. B. and the petitioners the company or their predecessors in title have been adequately remunerated by the amounts received in respect of the sale of, or the licences under, the said foreign patents or brevets d'invention.

That taking into account the monies received by the said A. B. (*the patentee*) or the petitioners the company, or their predecessors in title in respect of the use of the alleged invention in foreign countries and in the colony of Canada, the monies received in respect of the letters patent have been a full and adequate remuneration for the said alleged invention (*a*).

That the various companies mentioned in the petition, who from time to time purchased the said letters patent, purchased the same as a mere trading speculation, and not under circumstances in which any profit or benefit could accrue to the said A. B. (*the patentee*) (*b*).

That the petition does not state whether there have been any dealings in the shares of the petitioners the company (*c*).

That the said alleged invention as described in the said specification would not work satisfactorily and could not be carried into effect so as to be a commercial success, and is of no practical utility (*d*).

(*s*) See *ante*, p. 111.
(*t*) See *ante*, p. 107.
(*u*) See *ante*, pp. 106, 115.
(*x*) See *ante*, pp. 100, 107.
(*y*) See *ante*, p. 112.
(*z*) See *ante*, p. 100.
(*a*) See *ante*, p. 107.
(*b*) See *ante*, p. 114.
(*c*) See *ante*, p. 114.
(*d*) See *ante*, p. 104.

Forms.

That the allegations contained in the said petition are in many respects untrue in substance and in fact.

Dated this day of 18 .

Solicitors for the above-named Objectors.

Advertisement of Intention to present Petition for Extension of Term of Patent.

In the Matter of Letters Patent granted to E. D. of in the county of for an "invention of " bearing date the day of 188 No. .

Notice is hereby given that it is the intention of the said E. D. and of the P. E. S. I. Co., Ltd., who are [the equitable owners] of the said letters patent (*e*), to present a petition to Her Majesty in Council praying that the said letters patent may be extended for a further term (*f*); and notice is hereby further given that on the day of next or on such subsequent day as the Judicial Committee of Her Majesty's Privy Council shall appoint for that purpose, application will be made to the said Committee that a time may be fixed for hearing the matter of the said petition; and any person desirous of being heard in opposition to the said petition must enter a caveat to that effect in the Privy Council on or before the said day of next.

Dated this day of 189 .

(Signed) X. and Y.,
(*Address*)
Solicitors for the petitioner.

Advertisement of Time of Hearing.

In the Matter of Letters Patent granted to J. G. H. of in the county of gentleman, for the invention of , dated the day of 188 No .

Notice is hereby given that upon a motion this day made by counsel before the Judicial Committee of Her Majesty's Honourable Privy Council praying that a day might be appointed for hearing the matter of the petition of of in the county of , who are [the assignees and proprietors] of the said letters patent, for the extension of the term of the letters patent granted to the said J. G. H. on the day of 188 for No. , it was ordered by their lordships that the matter of the said petition be heard before this Committee on Tuesday the day of 189 at half-past ten o'clock A.M.

(Signed) X. and Y.,
(*Address*)
Solicitors for the above-named petitioners.

Forms of Accounts on Applications for Extension of Term of Patent.

[The following forms are forms of accounts which have been actually used in the Privy Council, and on which the Judicial Committee have recommended extension of the terms of the patents.]

(*e*) The title of the petitioners should appear in the advertisement. See also form of Advertisement of Time of Hearing.

(*f*) The petition must be presented within one week, and the day of application to fix hearing must be not less than four weeks, from date of publication of last advertisement in the "London Gazette." See Judicial Committee Rules, rr. II. and I., *ante*, pp. 551, 550.

FORM No. 1.

ACCOUNTS when the Patent was worked through Manufacturers to whom Patentee had granted sole right of manufacture, the Patentee himself forwarding the Invention and selling the Patented Articles.

In the Privy Council.

A. B.'s Patent, No. , a.d. , Improvments in .

PETITION FOR PROLONGATION.

Account of Expenditure and Receipts.

Account of the Expenditure and Receipts of the Petitioner (the Patentee).

FIRST YEAR.

	Expenditure.	£	s.	d.
18 . Mar. 2nd to Dec. 31st.	At and prior to this date Petitioner had expended various sums for models and other expenses of which he kept no account and is unable to specify them, but subsequently paid following:—			
	Journey to London			
	W. X. & Co. for models			
	Sundry expenses—trials			
	Total expenditure 18 . . £			

Receipts.
Nil.

FORM No. 1—*continued.*

_____YEAR.

	Expenditure.	£	s.	d.	£	s.	d.
18 . Jan. 1st to Dec. 31st.	To travelling expenses as per book						
	,, patent duty (three years) and expenses - - - -						
	,, advertising and printing - -						
	,, cost of models - - - -						
	,, expenses at trials, etc. - -						
	,, legal expenses - - - -						
	,, commission paid agents - -						
	,, [*patented articles*] not paid for -						
	General Expenses.						
	To rent of offices and wharf - -						
	,, rates and taxes - - -						
	,, salaries - - - - -						
	,, travelling and general trade expenses - - - -						
	,, bank interest and commission -						
	£						
	Half to Patent Account* -						
	Total expenditure for 18 £						

	Receipts.	£	s.	d.
18 . Jan. 1st to Dec. 31st.	By amount paid by Messrs. to Petitioner , *to enable him to devote* his time specially to forwarding the invention, and to be accepted in lieu of royalty during 18 - - - -			
	(*g*) 10 [*Patented articles*] sold during 18 -			
	Total weight of same cwts. qrs. lbs.			
	Total value of [*patented articles*] received by Petitioner, and by him paid to the manufacturers Messrs. £			
	Total receipts for 18 . . £			

* *Memo.*—The Petitioner also carried on at the same offices, and with the assistance of the same staff, his business of a civil and consulting engineer, in which was included several agencies for manufacturing engineers and tool makers. At this date the patent business took up at least one-half of the time of Petitioner's assistants.

YEAR.

EXPENDITURE.		£ s. d.	£ s. d.
18 .	To balance—Exhibition expenses -		
Jan. 1st	,, advertising and printing -		
to	,, expenses at trials, etc. -		
Dec. 31st.	,, commission paid agents -		

GENERAL EXPENSES.	
To rent of offices and wharf -	
,, salaries - - - -	
,, travelling and general trade expenses - - - -	
,, bank interest and commission -	
	£
One-third to Patent Account* -	
Total expenditure for 18 - - £	

RECEIPTS.		£ s. d
18 .		
Jan. 1st	By royalty received during 18 , as per	
to	book - - - - - - -	
Dec. 31st.		

(g) 10 [*patented articles*] sold during 18 -
Total weight of same, cwts. qrs. lbs.
Total value of [*patented articles*] sold by Petitioner, and by him paid to Messrs. , less above royalty £ - - - £

Total receipts for 18 - - £

* *Memo.*—At this date the Petitioner's general business had increased, and the profits derived from it seemed to demand that a larger share of the expenses should be charged to that business, and therefore from this date Petitioner has only charged to this business one-third of the general expenses.

(g) See note (i), *post*, p. 623.

[*Similar Accounts for each year of the Patent.*]

FORM No. 1—*continued.*

IN THE PRIVY COUNCIL.

A. B.'S PATENT, [*date*], No. , IMPROVEMENTS IN .

Summary of Petitioner's Accounts.

LOSS. £ s. d.		PROFIT. £ s. d.	£ s. d.
	First year—		
	Receipts - - - - - - - -	Nil.	
	Expenditure - - - - - - -		
	Second year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Third year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Fourth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Fifth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Sixth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - -		
	Seventh year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Eighth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Ninth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Tenth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Eleventh year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Twelfth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - -		
	Thirteenth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
	Fourteenth year—		
	Receipts - - - - - - -		
	Expenditure - - - - - - -		
£			
	Deduct loss - - - - -		
	Total profit - -	£	

FORM No. 1—*continued.*

IN THE PRIVY COUNCIL.

A. B.'s PATENT [*date*], No. , IMPROVEMENTS IN .

PETITION FOR PROLONGATION.

MANUFACTURER'S ACCOUNTS (*h*).

Profit and Loss Account from 18 , *to* 18 .

DR.	£ s. d.	CR.	£ s. d.
[*Patented articles*] manufactured and sold from to , 18 :		Sale of [*patented articles*] as per contra :	
(*i*) 10 [*patented articles*] cwts. qrs. lbs. .		(*i*) 10 [*patented articles*] cwts. qrs. lbs. .	
Patentee for sole right of manufacture			
Royalties			
Railway and other carriages :			
£1 per ton on quantity invoiced, viz., tons cwts. qrs. lbs.			
Discounts and commissions			
£		£	

(*h*) See *ante*, pp. 108, 109.

(*i*) The number of the patented articles must be inserted on both sides of the account, in order that the Judicial Committee may be able to see whether there has been any extravagance in the manufacture, or any unfair demand of profit on the sales, and the fullest detail should be given, the various charges being taken out as far as possible as separate items. See Form No. 2, *post*, p. 625. See, as to stating expenses in a lump sum, *Thomas and Gilchrist's Patent*, 9 R. P. C. 367.

[*Similar Accounts for each year of the Patent.*]

FORM No. 1—*continued.*

MANUFACTURE OF A. B.'s [*Patented Article*].

SUMMARY OF PROFIT AND LOSS ACCOUNT ANNUAL TOTALS

For the Years from , 18 , *to* , 18 .

	Debits.	£ s. d.	£ s. d.
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
			£
	To balance down, being loss on manufacturing to date		£

Note.—This amount is exclusive of any charge for capital expenditure on machinery, put down exclusively for the manufacture of [*patented articles*], and also for any depreciation or interest on value of [*patented articles*] now in stock which have been made at various periods.

	Credits.	£ s. d.	£ s. d.
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
18			
	Balance down	£	
		£	

FORM No. 2.

ACCOUNTS when Patentee himself Manufactured and Sold the patented Article.

[*Heading as in Form No. 1*, p. 619.]

.... YEAR.

EXPENDITURE.	£ s. d.	£ s. d.	RECEIPTS.	£ s. d.	£ s. d.
18 . By purchases of raw material for (*k*) {*patented articles*} as per vouchers			18 . To sale of (*k*) {*patented articles*} as per press copy book		
,, trade expenses as per cash book, being one year's travelling			Less discount		
Expenses of several travellers			To royalties—		
Patent expenses (stamp)			England		
Stationery			Austria (*l*)		
Bricklayers' work			To balance, being loss		
Law expenses incurred in recovering several debts					
Charges for patterns, oil, and other trade expenses					
,, commission as per cash book					
,, advertising					
,, wages of workmen					
,, rent, taxes, and lighting					
	£			£	

(*k*) Insert number. See *ante*, p. 623, note (*t*).
(*l*) See *ante*, p. 107, as to the necessity of including accounts relating to foreign patents.

[*Similar Accounts for each year of the Patent.*]

[*Summary to be added as in Form No. 1*, p. 624.]

FORM No. 3.

ACCOUNTS in Petition by a Company, Assignees of the Patent, when there have been various dealings with the Patent.

IN THE PRIVY COUNCIL

A. B.—PATENTS, [*date*], NOS. AND , IMPROVEMENTS IN

PETITION FOR PROLONGATION

ACCOUNT OF EXPENDITURE AND RECEIPTS.

FIRST PART.—*Account of Expenditure and Receipts of A. B., the Patentee.*

FIRST YEAR.

EXPENDITURE.	£ s. d.	£ s. d.	RECEIPTS.
18 :			
To C. D. & Co.—Fitting up office, at			*Nil.*
" E. F. & Co.—Gas fittings, ditto			
" office furniture			
" trade expenses			
" salaries draughtsman and housekeeper			
" [ ]—stationery			
" advertising			
" offices: To for rent			
" " " for gas			
" cost of Letters Patent and Specification, No. A.D.			
" G. H. & Co., Consulting Engineers for opinions			
" patentee allowance for his time			
Total expenditure for 18		£	

* NOTE.—The patentee from the date of the patents to the present time has devoted his whole time and given his constant and undivided attention to the introduction of his invention to the public, and working the same, and has had no other employment. The sum charged is measured by the amounts actually paid to him for his time and attention in subsequent years of the patents (*m*).

(*m*) See *ante*, p. 108.

PART OF THE YEAR.

EXPENDITURE	£ s. d.	£ s. d.	RECEIPTS	£ s. d.
18 , to .				
To { } three quarters' rent . . .				
,, { } for gas				
,, patentee allowance for his time (see note, p. 1 of accounts) . . .				
,, cash for patentee's share of partnership with X., hereafter mentioned .			By cash from X	
Total expenditure to 18 .	£			£

NOTE. At this period the patentee entered into partnership with X. for the purpose of working the patents, and received from him the above sum of £ , out of which he paid to the partnership account the above sum of £ .

SECOND PART.—*Account of Expenditure and Receipts of the Patentee and X.*

FURTHER PART OF THE ____ YEAR.

EXPENDITURE.	£ s. d.	£ s. d.	RECEIPTS.	£ s. d.
18 , from .				
To { } Gas fittings at . . .				
,, carpets, matting, and more furniture for do.				
,, trade expenses				
,, salaries Patentee				
,, ditto Draughtsman and housekeeper .				
,, { }—Stationery				
,, { }—Models				
,, { } Quarter's rent, in lieu of notice				
,, G. H. Consulting engineer, for opinions .				
,, law charges Mr. , Mr. X.'s solicitor .				
,, ditto Mr. , patentee's solicitor				
,, ditto as to negotiations for capitalist				
Total expenditure from 18 .	£			

FORM No. 3—*continued.*

YEAR

18 . Expenditure.	£ s. d.	£ s. d.	18 . Receipts	£ s. d.
To salary—Patentee			By royalties (*a*) received from M. & Co.	
,, travelling expenses—Patentee at			,, ditto ditto N. & Co.	
,, ditto ditto at			,, ditto ditto O. & Co.	
,, ditto ditto at				
,, trade expenses				
,, Income Tax				
,, K. & L., re M.'s infringement . . .				
,, ditto ditto				
,, charges re removing machines from , re M.'s infringement				
,, law charges re [*name*] infringements, M.'s licence, N.'s licence, and . .				
Total expenditure for 18 . .	£		Total receipts for 18 . .	£

PART OF THE YEAR TO .

(About this time the Petitioning Company was formed.)

18 . Expenditure.	£ s. d.	£ s. d.	18 . Receipts.	£ s. d.
To cash to[ ] Deposit of £ to X. . .			Royalties received from O. & Co. . .	
,, ditto X. Balance				
,, K. & L. Patent agents' charges re Patentee & X.				
,, P. & Q. Law charges ditto .				
,, R. & S. Ditto ditto ..				
,, Law charges re Assignment of Patents to the Company, re X. and M.'s infringement .				
,, Patentee—Salary for first five weeks of the year				
,, ditto Allowance for his time (See Note, p. 1 of accounts)				
Total expenditure to , 18 .	£		Total receipts to . 18 . .	£
			After :—	
			By cash paid to patentee by the Y. Z. Company, Ltd.	
			Ditto paid to X. by the above named company .	

Note.—The patentee also received £ in shares of the Company, upon which no dividend has ever been declared.

(*a*) The licensees' accounts should be furnished. (*See ante*, p. 107.)

PART OF AND PART OF YEARS.

EXPENDITURE. 18 , , to 18 , ,	£ s. d.	£ s. d.
To [ ] Fitting up offices at		
.. office furniture		
.. expenses at Exhibition		
.. ditto stand at cattle show		
.. rent of stand at engineering exhibition		
.. general trade expenses		
.. [ ] Seal of company, books, etc.		
.. advertising		
.. travelling and hotel expenses — (two of the directors) to [*certain places named*]		
.. ditto, ditto Patentee to [*places named*]		
.. carriage of models, etc.		
.. salaries Patentee		
.. ditto Draughtsman and housekeeper		
.. [ ] Models		
.. [ ] Rent of to , 18		
.. ditto ditto 18		
.. law charges—Formation of the company, assignment of patents, etc.		
Total expenditure to , 18	£	

RECEIPTS 18 , , to 18 , ,	£ s. d.
By royalties received from C. & Co.	
.. ditto ditto P. & Co.	
Total receipts to , 18	£

[Similar Accounts to the above for each year of the Patent.]

APPENDIX.

FORM No. 3—*continued.*

FURTHER PART OF YEAR TO PRESENT TIME.

LIST OF ORDERS *for which Payment has not yet been received, but for which the Royalties mentioned below will be due.*

Makers.	Royalties Payable.		
	£.	*s.*	*d.*
(*Names*)			
. . . . .			
. . . . .			
. . . . .			
. . . . .			
. . . . .			

IN THE PRIVY COUNCIL.

A. B.'s PATENTS [*date*], NOS. AND , IMPROVEMENTS IN

SUMMARY OF ACCOUNTS.

FIRST PART.—*From* 18 *to* 18 , *while the Patents were in Possession of the Patentee.*

EXPENDITURE.

	£	*s.*	*d.*
A. First year, 18			
Second year, 18			
Part of third year to September, 18 . . .			
	£		

RECEIPTS.

	£	*s.*	*d.*
First year, 18			
Second year, 18			
Part of third year to September, 18 . . .			
	£		

SECOND PART.—*From* , 18 , *to* , 18 , *during Patentee's Partnership with X.*

EXPENDITURE.	£	s.	d.	RECEIPTS.	£	s.	d.
B Further part of third year, from October, 18				Further part of third year, from October, 18			
Fourth year, 18				Fourth year, 18			
Fifth year, 18				Fifth year, 18			
,, 18				,, 18			
Sixth year, 18				Sixth year, 18			
Seventh year, 18				Seventh year, 18			
Eighth year, 18				Eighth year, 18			
Ninth year, 18				Ninth year, 18			
Tenth year, 18				Tenth year, 18			
Part of eleventh year, to August, 18				Part of eleventh year, to August, 18			
	£				£		

THIRD PART.—*From* , 18 , *to* , 18 , *while the Patents were in the Possession of the Petitioning Company.*

EXPENDITURE.	£	s.	d.	RECEIPTS.	£	s.	d.
C. Part of eleventh year and part of twelfth year, September, 18 , to September, 18				Part of eleventh year and part of twelfth year, September, 18 , to September, 18			
Part of twelfth year and part of thirteenth year, October, 18 , to September, 18				Part of twelfth year and part of thirteenth year, October, 18 , to September, 18			
Part of thirteenth year and part of fourteenth year, October, 18 , to September, 18				Part of thirteenth year and part of fourteenth year, October, 18 , to September, 18			
Further part of fourteenth year, October, 18 , to Christmas, 18				Further part of fourteenth year, October, 18 , to Christmas, 18			
	£				£		

FORM No. 3—*continued.*

TOTAL EXPENDITURE AND RECEIPTS FROM PATENTS.

Expenditure.	£ s. d.	Receipts.	£ s. d.
Summary **A.**		Summary **A.**	
Summary **B.**		Summary **B.**	
Summary **C.**		Summary **C.**	
		Payment to patentee (see *ante*, p. 628)	
		Payment to X. (see *ante*, p. 628)	
		Further royalties which will become payable (see *ante*, p. 630)	
	£		£

COMPULSORY LICENSES.

Scheme of Procedure under Section 22, and the Patents Rules 60—66, 1890 (*m*).—(*Ante*, pp. 95, 534, 535.)

1. The Board of Trade on receiving petition and evidence (if any) will refer them to a legal expert in Patent Law.

2. Counsel will thereupon report to the Board of Trade whether in his opinion the Order should at once be refused.

3. If the Order is not at once refused, the Board of Trade will, upon counsel's report, require the petitioners to appear before him to receive his directions as to further proceedings.

4. After the attendance of the petitioner before counsel he will further report to the Board of Trade whether in his opinion a *primâ facie* case has been made out.

5. If a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade the Board will call upon the petitioners to deliver to the patentee, on or before a day to be named by them, copy of the petition and evidence in support.

6. When the evidence is complete under Rules 63—65, a copy of the petition and evidence will be submitted to counsel to advise as to further directions, or the hearing of the petition under the provisions of Rule 66.

7. Counsel will thereupon advise the Board of Trade whether any further directions are necessary, or whether the petition may be at once heard, fixing a time convenient to him, and the Board of Trade will direct the parties accordingly.

8. The hearing to take place at the Board of Trade or elsewhere as may be arranged.

The parties should be required to inform the Board beforehand whether they intend to appear in person, or, if not, what counsel or patent agent will represent them.

9. A shorthand note of the proceedings at the hearing to be taken.

10. All evidence prior to the hearing to be by affidavit.

(*m*) This scheme of procedure is understood not to be final, but it has been adopted by the Board of Trade in some recent cases.

Appendix.

LICENSES.

Order of the Board of Trade under s. 22 for Compulsory License with License annexed.

Patents, Designs and Trade Marks Act, 1883.

In the Matter of the Letters Patent, Nos. of
and of
and

In the Matter of the Petition of and to the Board of Trade (hereinafter called the Petitioners) for an Order for Compulsory Licenses under the said Patents.

WHEREAS by s. 22 of the Patents, Designs, and Trade Marks Act, 1883, it is enacted:—(*recites the section*).

And whereas on the day of 18 a patent numbered was granted to of for an invention communicated to him by (hereinafter called the Patentees) relating to .

And Whereas on the day of 18 , the said patent was duly assigned by the said to the patentees, which said assignment was on the day of 18 , duly registered at the Patent Office.

And Whereas on the day of 18 , another patent numbered was also granted to the said for an invention in like manner communicated to him by the patentees relating to .

And Whereas on the day of 18 , the said patent was duly assigned by the said to the patentees, which said assignment was on the day of 18 , duly registered at the Patent Office.

And Whereas the petitioners presented a petition to the Board of Trade under the said section for an order that the patentees under the said letters patent No. of and No. of , should grant to the petitioners a license under or in respect of the inventions described and claimed in and by the specifications of the said respective letters patent.

And Whereas on consideration of the said petition and of the matters therein mentioned it has been proved to the Board of Trade that the said petitioners are persons interested in the matter of the said petition, and that by reason of the default of the patentees to grant licenses on reasonable terms the said patents are not being worked in the United Kingdom, and that by reason of the default aforesaid the said petitioners are being prevented from working and using to the best advantage certain inventions of which they are possessed.

Now, Therefore, the Board of Trade, in exercise of the power conferred upon them by s. 22 of the Patents, Designs, and Trade Marks Act, 1883, and of all other powers enabling them in this behalf do hereby order as follows:—

1. That a license to take effect from the date of this order and in the form set forth in the schedule hereto be forthwith granted by the patentees to the petitioners to make use, exercise, and vend within the United Kingdom the inventions described and claimed in and by the specifications of the said letters patent No. of and No. of for the unexpired residues of the respective terms of the said letters

patent at a royalty of for each of made by the licensees under the said letters patent or either of them, but so that in each year a minimum royalty of £ per annum shall be paid by the licensees, and the patentees shall forthwith deposit such license duly executed by them with the Board of Trade.

The said petitioners before the day of 18 , shall execute and deposit with the Board of Trade a counterpart license in the form aforesaid, and in default of their doing so this Order shall be of no effect.

Dated this day of , 18 .

Copy of Schedule referred to.

This Indenture, made the day of 18 , between of (hereinafter called the patentees) of the one part and of (hereinafter called the licensees) of the other part. Whereas by an Order of the Board of Trade dated the day of 18 , and made under s. 22 of the Patents, Designs, and Trade Marks Act, 1883, it was ordered that a license to take effect from the date of the said order should be granted by the patentees to the licensees to make, use, exercise, and vend the inventions described in the letters patent hereinafter mentioned (to the benefit of which the patentees are entitled) in the form set out in the Schedule to the said Order being the form of these presents.

Now this Indenture Witnesseth that in pursuance of the said Order the patentees do hereby grant to the licensees license within the United Kingdom to make, use, exercise, and vend the inventions described and claimed in and by the specifications of the letters patent No. of and No. of , mentioned in the said Order. To hold, exercise, and enjoy the said license for and during all the residues now to come and unexpired of the respective terms of the said letters patent and during any further term for which the said letters patent or either of them may be extended. And the licensees hereby covenant with the patentees that the licensees will during the continuance of this license pay to the patentees half-yearly on every day of and day of royalties at the rate of for each of made by the licensees under the said letters patent or either of them in the half years then ending respectively.

Provided always that if the royalties payable in any year ending on the day of shall not have amounted to the sum of £ the licensees shall on such day of pay to the patentees such further sum as with the said royalties shall amount to the said sum of £ hereinafter called the yearly rent. The licensees do hereby also covenant with the patentees that the licensees will during the continuance of the license keep proper accounts in separate books containing full particulars of all made by them under this license, and of all other things which may be material for the purpose of showing the amounts payable to the patentees by way of royalty, and will at any time produce the same for the inspection of the patentees or any person appointed by them, who shall be at liberty to make copies from or extracts from any of the accounts or matters therein contained, and that the licensees will, within ten days after each of the half-yearly days aforesaid, deliver to the patentees an account in writing, showing all the particulars and matters aforesaid with respect to the made during the preceding half-year.

Appendix.

LICENSES.

And it is hereby agreed and declared that the patentees shall be at liberty at any time during the continuance of this license to enter upon any factory or place of business of the licensees in which the manufacture of the said shall be carried on at any reasonable hour with a view of obtaining all such information as may be material for the purpose of ascertaining the amount of royalty payable to them under this license.

And it is hereby also agreed and declared that if any payment of royalties or yearly rent under this license shall be in arrear for one month after the same shall have become due (whether payment thereof shall have been demanded by the patentees or not), or if the licensees shall make default in the performance of any obligation on their part herein contained and shall not have made good the same within fourteen days after the patentees shall have by notice in writing required them to do so, then the patentees may with the consent of the Board of Trade, by notice in writing to the licensees, revoke this license as from the date of such notice without prejudice to the right of the patentees to recover any moneys then due hereunder.

And it is hereby agreed and declared that if the said letters patent or either of them shall become void, or shall be declared by a Court of Law to be void, the licensees may with the consent of the Board of Trade by notice in writing to the patentees revoke this license.

INDEX.

NOTE.—The figures with the prefix (S.) refer to the sections of the Act of 1883. The abbreviations P.R., L.O.R., J.C.R., D.R., T.M.R., refer to the Patents Rules, Law Officers' Rules, Judicial Committee Rules, Designs Rules, and Trade Marks Rules respectively, and the numbers appended to these abbreviations refer to the numbers of the Rules. The other figures refer to the pages of this book.

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